

20
178

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT.

No. 2195.

H. J. HEINZ COMPANY,

Appellant,

VS.

MAX M. COHN,

Appellee.

BRIEF AND ARGUMENT FOR APPELLANT.

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For Appellant

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H. J. HEINZ COMPANY,

Appellant,

vs.

MAX M. COHN,

Appellee.

BRIEF AND ARGUMENT FOR APPELLANT.

May it please the Court:

This is a suit in equity under letters patent No. 835,850, issued November 13, 1906, to Max M. Cohn, for improvements in Envelopes, and letters patent No. 824,908, issued July 3, 1906, to Max M. Cohn, for improvements in Envelopes.

The patent No. 835,850, issued November 13, 1906, was applied for first, and so throughout the record it has been designated as the first Cohn patent, while the patent No. 824,908, applied for last, has been designated as the second Cohn patent. For convenience, we will discuss the Cohn patents under these names or designations. For a like reason we will refer to the appellant as the defendant and to the appellee as the complainant.

General Statement of the Matter in Controversy.

The two Cohn patents sued on relate to what are known, in popular language, as one-piece transparent window envelopes—envelopes made of one piece of paper by applying a grease or oily preparation to the spot where the address of the enclosure is to appear so as to render it transparent, and allow the address to appear through the transparent portion or window—to distinguish them from two-piece transparent window envelopes—envelopes where the portion over the address of the enclosure is cut out and a piece of oiled or transparent paper pasted in.

The improvement of the first Cohn patent consists in printing a border around the window, either in the form of a ring or large enough to cover the entire face of the envelope outside of the transparent space, so as to cover up and conceal any running of the oily preparation in the fibre of the paper and give a sharp or definite outline to the window. The improvement of the second Cohn patent consists in the envelope of his first patent when the window is made in the form of an article of manufacture or symbol of trade, with permanent advertising matter printed on the face of the envelope in juxtaposition to the window.

Everything was old in the envelopes of the Cohn patents, as the defendant contends, except printing a ring around the grease spot, as such rings had been printed around grease spots on paper used for other purposes. The whole controversy, as the defendant contends, so far as the envelope of the first Cohn patent is concerned, is as to whether it involved invention to print a ring around a grease spot.

Facts Conceded and Disputed.

On behalf of the defendant, it is conceded:

1. That the defendant is an incorporation, as alleged in the bill.
2. That the respective letters patent were granted to the said Max M. Cohn, in due form, as alleged in the bill.
3. That the title to the patents was in the complainant at the time the bill was filed and at the date of which the decree was entered.

On behalf of the defendant it is contended that the following facts and conclusions of law are established by the evidence:

4. That the alleged invention claimed in each of the claims of the first and second Cohn patents involved no invention, in view of the state of the art, and nothing beyond the exercise of ordinary mechanical knowledge and skill.
5. That one-piece transparent window envelopes, made from opaque paper and with window spaces rendered transparent by the application of an oily or similar suitable preparation, are shown or described in the Brown 1862 patent, No. 36,399, in all substantial respects like the envelope of the first Cohn patent, except that the Brown envelope had no border printed around the transparent window or space.
6. That the "border" mentioned in the claim of the first Cohn patent, and in the claims of the second Cohn patent sued on, may be either a narrow ring around the transparent win-

dow, or it may extend solid from the window space to the edges of the face of the envelope, as expressed in the specification of the first Cohn patent, in describing Fig. 2, where he says that, “The *entire* face of the envelope around the window is assumed to have been imprinted or colored to give definition to the window opening and obliterate signs of ‘creep’ in the transparency producing preparation”; or, as expressed in the second Cohn patent, in describing the “border” produced by the coloring matter, where he says that, “This coloring matter may be applied *solid over the face* of the envelope.”

7. That one-piece transparent window envelopes, made from transparent paper or stock, and with borders printed around the space left for the window and extending out to the edges of the envelope face, as Cohn says above that his borders may extend, are shown or described in the Busch 1896 English patent, No. 11,876, as testified by defendant’s witnesses and admitted by Cohn.

8. That the printing on the Brown 1862 patented envelope, made from opaque paper with “only a transparent portion, large enough to exhibit the ‘direction’ through it,” as described in the Brown patent, of the border of the envelope described in the Busch 1896 English patent, made from transparent paper, produces the envelope described and claimed in the first Cohn patent sued on, and was merely a mechanical act, required merely the exercise of the knowledge and skill of the trade or calling of the printers’ craft, and nothing of the character of invention.

9. That for many years before the application for the first Cohn patent it was the common and universal practice in this country among the printers of three-color pictures, the printers of lithograph labels, and the printers of general

kinds of work, to print a border around their pictures or work, to give definition to the same and to cover up and conceal ragged, imperfect, or unsightly edges, resulting from the running of the ink or colors, or for other causes, the work done and the results secured by printing and using such border being in all respects similar in character and kind to the work done and the results secured by Cohn in printing the border on the envelope of his first patent.

10. That the printing on the Brown 1862 patented envelope made from opaque paper, with "only a transparent portion, large enough to exhibit the 'direction' through it," as described in the Brown patent, of the border used by the printers of three-color work, lithograph printers, or printers generally, produced the envelope described and claimed in the first Cohn patent, and was merely a mechanical act, and required merely the exercise of the knowledge and skill of the trade or calling of the printers' craft, and nothing of the character of invention.

11. That the use of "borders" around transparent spaces, both in the use of transparent paper or material, and of opaque paper where the transparent spaces are produced by the use of an oily preparation, or where the transparent space is formed by a separate piece of transparent material, are shown or described in the Tudor 1878 reissued patent, No. 7,514; the Leigh 1894 English patent or publication, No. 21,711; the Busch 1896 English patent, No. 11,876; and the Smith & Brown 1901 English patent, No. 25,532.

12. That the printing on the Brown 1862 patented envelope made from opaque material with "only a transparent portion, large enough to exhibit the 'direction' through it," as described in the Brown patent, of the border around the trans-

parent spaces shown or described in the Tudor, Leigh, Busch, and Smith & Brown patents above described, produced the envelope described and claimed in the first Cohn patent, and was merely a mechanical act, and required merely the exercise of the knowledge and skill of the trade or calling of the printers' craft, and nothing of the character of invention.

13. That the first envelopes made by Cohn out of opaque paper, with transparent windows produced by an oily preparation, and with a border printed around the transparent windows, were made in the Spring or Summer of 1904, and subsequent to May 9, 1904, on which date Cohn filed his first application for a patent, as appears not only from the evidence but from the envelopes offered in evidence themselves, which all contain the words "Patent Pending," or "Pat. Applied For," which was possibly true *after* May 9, 1904, but was not true *before* that date.

14. That in January, 1904, one-piece transparent window envelopes were made from opaque paper by Julius Regenstein and others, at Chicago, Illinois, by rendering the window space transparent by the use of an oily preparation, and then printing a border around the space to give definition to the window and to cover and conceal the creeping or bleeding of the oil, which envelopes were full sized and complete reduction to practice of the inventions of the first Cohn patent, and corresponded in each and every respect with the envelopes claimed in the first Cohn patent.

15. That the claims of the second Cohn patent are limited to envelopes containing a transparent window or space which, considered by itself alone and irrespective of the border, is in outline characteristic of some symbol of trade, or article of manufacture, and with permanent advertising matter placed

or printed on the border outside of the transparent window or space.

16. That envelopes with transparent windows in the shape of a trade-mark, article of manufacture, or symbol of trade, are shown and described in the Boldt 1897 English patent, No. 29,956, which patent also says that the transparent windows may have a trade-mark, name or other symbol or device upon the transparent window itself.

17. That to take the envelope of the first Cohn patent, with its transparent window and with its border printed around the window, and make the window in the form or shape of a trade-mark, symbol or device, as described in the Boldt 1897 English patent, and place permanent advertising matter on its border, produces the envelope of the second Cohn patent, and was merely a mechanical act, and required merely the exercise of the knowledge and skill of the trade or calling of the printers' craft, and nothing of the character of invention.

18. That only mechanical knowledge and skill and nothing of the character of invention were required to take the envelope claimed in the first Cohn patent, with its transparent window and border, and change the *form* of the window so as to make it in outline characteristics of some symbol of trade, in view of the Boldt 1897 English patent, and of the practice, from time immemorial, of printing permanent advertising matter on the face of envelopes outside of the space reserved for the address.

19. That the transparent *window* in the defendant's envelope charged to infringe is not in the shape or form of an article of manufacture, and is not in outline characteristic of some symbol of trade, but is simply in size and shape the

regular transparent window of the stock envelope made by the manufacturer of the defendant's envelope.

20. That the defendant's envelope contains neither permanent advertising or printed matter on the border or face of the envelope, as required by the claims of the second Cohn patent sued on, but simply the word "Heinz" on the inside back of the envelope opposite the transparent window or space, so as to be seen therethrough, similar to the use of a word, symbol or device on the transparent window or space, as the Boldt 1897 English patent describes, and the usual return card in the upper left-hand corner—neither of which constitute the permanent advertising matter "appearing on said printed border and related to and in juxtaposition with the outline of said window," as called for in the first claim, nor the "permanent printed matter on the face of the envelope related to and in juxtaposition with the outline of the window and co-operating with said outline to indicate a particular brand of goods," as called for in the second claim.

21. That the defendant's envelope does not infringe the claims of the second Cohn patent sued on.

Assignment of Errors.

The errors assigned on behalf of the appellant at page 671 are, That the court erred—

1. In finding and holding that letters patent No. 835,850 were good and valid in law, and in sustaining the same.

2. In finding and holding that letters patent No. 824,908 were good and valid in law, and in sustaining the same.

3. In holding that the defendant's envelopes were an infringement of said letters patent or either of them, and in ordering an injunction against the defendant.

4. In holding that said letters patents No. 835,850 and No. 824,908 involved novelty and invention, notwithstanding the state of the art as established in the evidence.

5. In not holding that said letters patents No. 835,850 and No. 824,908 were invalid and of no force or effect whatever as lacking novelty and invention, in view of the state of the art as established in the evidence.

6. In not holding that the said letters patent, No. 835,850, were anticipated by the one-piece transparent window envelopes made by Julius Regenstein and others in January, 1904.

7. In holding that Cohn conceived of the invention described and claimed in said letters patent No. 835,850 prior to January, 1904, and before the making of the January, 1904, envelopes by Julius Regenstein and others.

8. In not finding and holding that said letters patent, No. 835,850, were invalid and void and of no force or effect whatever, in view of the common and universal practice in this country, among the printers of three-color pictures and the printers of lithograph labels, and the printers of general kinds of work, of printing a border around their pictures or work to give definition to the same, and to cover up and conceal ragged, imperfect, and unsightly edges resulting from the running of the ink or colors or from other causes.

9. In not finding and holding that said letters patent, No.

835,850, were invalid and void and of no force or effect whatever, in view of the existence in the prior art of one-piece transparent window envelopes without a border around the transparent window, and of the common practice and expedient of printers, of printing a border around pictures and of other kinds of work to cover up and conceal, ragged, imperfect, and unsightly edges, resulting from any cause whatsoever.

10. In not finding and holding that said letters patent, No. 835,850, were invalid and void and of no force or effect whatever, in view of the Busch 1896 English patent, No. 11,876, which had borders printed around the space left for the transparent window.

11. In not finding and holding that said letters patent, No. 835,850, were invalid and void and of no force or effect whatever, in view of the use of borders around desired transparent spaces, produced in opaque paper by an oily preparation, as shown in the various letters patent offered in evidence on behalf of the defendant.

12. In not finding and holding that said letters patent, No. 835,850, were invalid and of no force or effect whatever, on the ground that the printing of the border around the transparent window of the envelope, described and claimed in such patent, was a mere printers' mechanical expedient, that had been practiced for many years in various kinds of printers' work, to cover up and conceal ragged, imperfect and unsightly edges, resulting from any cause whatsoever.

13. In not finding and holding that the envelope described and claimed in said letters patent No. 835,850, was first conceived of by the said Max M. Cohn in the Spring or Summer of 1904, and after the Regenstein 1904 envelope had been manufactured.

14. In not finding and holding that the envelope described and claimed in said letters patent, No. 824,908, was limited and confined to envelopes containing a transparent window or space which, considered by itself alone and irrespective of the border, was in outline characteristic of some symbol of trade or article of manufacture.

15. In not finding and holding that said letters patent, No. 824,908, were invalid and void and of no force or effect whatever, in view of the Boldt 1897 English patent, No. 29,956, offered in evidence by the defendant.

16. In not finding and holding that the envelope described and claimed in said letters patent, No. 824,908, involved only mere mechanical knowledge and skill to make, in view of the fact that envelopes with transparent windows, in various forms, and with borders around the same, were shown and described in the Busch English patent, No. 11,876; the Boldt English patent, No. 29,956, and other patents offered in evidence by the defendant.

17. In not finding and holding that only mechanical knowledge and skill were required to take the envelope described and claimed in said letters patent, No. 835,850, with its transparent window and border, and changing the form of the window so as to make it in outline characteristic of some symbol of trade, in view of the Boldt 1897 English patent, and of the practice, from time immemorial, of printing permanent advertising matter on the face of the envelope outside of the space reserved for the address.

18. In finding and holding that the transparent window in the defendant's envelopes charged to infringe was in outline characteristic of some symbol of trade or article of manufacture, as described and claimed in said letters patent, No.

824,908, and in finding and holding that the defendant's envelopes were an infringement of the claims of said letters patent, No. 824,908.

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As many of the facts specified in the contentions of the defendant, and many of the errors contained in the above enumeration, depend for their establishment upon considerations of testimony and principles of law applicable to several, we consider that it will conduce to clearness and brevity to consider them together, under appropriate headings, as far as applicable, and so we will proceed to consider them in connection with the patents to which they respectively relate.

The First Cohn Patent is Lacking in Invention in View of The State of the Art.

The learned judge below, in his opinion, beginning at page 32, discusses the defenses of *anticipation* and lack of *novelty*, but appears to have singularly failed to consider what we regard as one of the impregnable defenses in this case—the lack of *invention* in view of the state of the art. The Supreme Court has frequently held that the alleged invention of a patent may be *novel* in the sense of having never been made in the particular form shown or described in the patent, in which case, of course, it is not *anticipated* or precisely met, but that, if it lack *invention* over the state of the art, the patent cannot be sustained.

To refer to a case or two on this point—though there are many that could be cited:

In *Thompson v. Boisselier*, 114 U. S., 11, the Supreme Court said:

“It is not enough that a thing shall be new, in the

sense that in the shape or form in which it is produced it shall not have been before known, and that it shall be useful, but it must, under the Constitution and the Statute, amount to an *invention* or discovery."

The above language is quoted and the principle of law reiterated in *Gardner v. Herz*, 118 U. S., 191, where additional cases are cited; and after quoting the above language from the Thompson-Boisselier case, the Supreme Court, on page 192, said:

"A large number of cases in this court were there referred to, and one especially, where the thing claimed was new, in the sense that it had not been anticipated by any previous invention, and it was shown to have superior utility, yet it was held not to be such an improvement as was entitled to be regarded in the patent law as an invention."

It was not enough, therefore, for the learned judge below to find that the alleged inventions of the Cohn patents were novel and not anticipated, in the sense that the exact envelopes shown and described in the patents had not existed before, unless such envelopes contained *invention* over what existed in the prior art. The defense that we are now insisting upon, and which we think was practically overlooked by the court below, is that there was no *invention* in the envelopes of the Cohn patents, when what Cohn did, over what was known and existed before, is taken into consideration. To show this lack of *invention* we will take up and consider the state of the art as it was fully established in the proofs.

The State of the Art and in What it Consists.

The state of the art may be considered under six general divisions or propositions which may be briefly presented as follows:

First, one-piece window envelopes in every respect like the envelope of the Cohn patent, but without a border around the window, were old in the art.

Second, borders were old and had long been used by the printers of three color pictures, for the same purpose as they were applied and used by Cohn on his one-piece transparent window envelope—to cover up, conceal or obliterate irregular, ragged and unsightly edges on the work enclosed within the borders.

Third, borders were old and had long been used by the printers of lithograph picture labels, for the same purpose as they were applied and used by Cohn on his one-piece transparent window envelope—to cover up, conceal or obliterate irregular, ragged and unsightly edges on the work enclosed within the borders.

Fourth, borders were old and had long been used by printers generally around different kinds of work where the ink ran or spread, for the same purpose as they were applied and used by Cohn on his one-piece transparent window envelope—to cover up, conceal or obliterate irregular, ragged and unsightly edges on the work enclosed within the borders.

Fifth, borders were old and had been described as “printed” on one-piece transparent window envelopes around and outside of the space constituting the transpar-

ent window long before the date of the invention of the first Cohn patent.

Sixth, borders were old and described as printed around transparent spaces created in opaque paper by the application of a grease, varnish or oily preparation, where the transparent spaces were used for various purposes.

We will consider each of the foregoing phases of the state of the art and the evidence in support of the same, in the order enumerated above.

First Division of the Old Art.

The Brown 1862 patent, at page 695, describes one-piece window envelopes made from opaque paper, like those of the Cohn patent, and with the transparent portion produced in the opaque paper in the same way,—by the use of a material that makes the paper transparent where applied and only where applied—but without the border, were old in the prior art. They are fully disclosed in the Brown 1862 patent in evidence. After describing one part of the invention, the Brown specification says (*italics being ours*):

“The other part of my invention consists in an improved envelope, or wrapper, D. The improvement is, to make the envelope or wrapper, transparent, sufficiently to clearly show the cards of address through its face. There may be only a *transparent portion* B, large enough to exhibit the ‘direction’ through it; and this may be made either by *rendering a portion* of the envelope, or wrapper, itself, transparent, by the same means or substance as employed for making tracing paper or any other, in the process of manufacturing the paper or *the envelope*, leaving the remainder of the envelope *opaque*.”

The Brown patent says, “by rendering a portion of the envelope”—not the whole of it, but a *portion*—“trans-

parent, by the same means or substance as employed for making tracing paper or any other" transparent. What "means or substance" are used for making the tracing paper transparent? Oil or oily substances, as everybody knows. The tracing paper in children's picture tracing books used for forty years or more, as its very appearance shows, is rendered transparent by oils or oily preparations. The Century Dictionary, copyrighted in 1890, under the heading of oils, says: "Oiled paper, paper saturated with oil, either to render it transparent and thus fit for *tracing purposes*, or to make it waterproof." Brown speaks to those skilled in the art of making paper and making either the whole or a portion of it transparent and who knew that oily preparations were used in making "tracing" paper, and so he tells them that a *portion* of the envelope, "large enough to exhibit the 'direction' through it," was to be made transparent by using the appropriate "means or substances"—any suitable oily preparation.

The above quotation from the Brown patent clearly describes a one-piece transparent window envelope, made from opaque paper, with a desired transparent space or window in it, but without any border around the transparent portion. We offered in evidence an envelope that corresponds to the description of the Brown patent, and the same will be found in the defendant's typewritten record on file in the case, opposite page 372. The defendant's witness, Mr. Bond, at page 353, testifies that the envelope offered in evidence "embodies the invention of the Brown 1862 patent." The Primary Examiner, the Board of Examiners-in-Chief and the Commissioner of Patents, all considered and conceded that the Brown patent disclosed a one-piece transparent window envelope made from opaque paper like the Cohn envelope, but without the border. Indeed, the attorney for Cohn, in his argument filed with the Board of Examiners-in-Chief, con-

ceeded this at page 613, and among other things said (the italics being ours):

“The patent to Brown 36,393 is only cited to show a window which is made transparent by some substance such as is employed for making tracing papers. This we admit is old in an envelope, but it is this very method of making the transparent window which calls into play the border of contrasting color which is applied over and conceals the ragged lines left by reason of the oily matter creeping into the opaque stock of the envelope.

“Although we disclose new and useful advantages for this border and *we have made the Brown type of envelope* a success, so much so that the improved envelope is now being extensively made and sold,” etc.

Here Cohn, through his attorneys, claimed that by the use of the border he had made “*the Brown type of envelope* a commercial success—not some *other* kind of envelope, but the *Brown* type—thus conceding that the *type* of envelope was old and that the Cohn envelope differed from it simply by the application of a border around the window.

The Board of Examiners-in-Chief, in their opinion, after referring to the Busch 1896 English patent, and the Cohn and Shipp 1904 English patent, said, at page 618, in speaking of the Brown patent (the italics being ours):

“It is obvious that by following the directions first stated, an envelope of the same construction as the appellants is produced. The appellant has merely *added a colored border* for the purpose of ornamentation.

“In the patent to Cohn *et al.* is described an unpunctured envelope having a transparent window surrounded by a portion to which dark colored ink has been applied. This is also true of Busch. The border in this case seems to extend to the edge of the envelope but it is nevertheless a contrasting border. Its purpose is, like that in the appellant’s case, to have a transparent window regular in outline and of the shape desired. If the transparent material extends to the edge of the envelope it is neces-

sary to extend the ink covered surface to the edge, whereas if the transparent portion does not extend so far it is not necessary to extend the ink so far. It may then be applied in the shape of a border sufficiently wide to cover the edges of the transparent portion."

Indeed, as already pointed out, Cohn says in both of his patents that the border may extend to the edges of the envelope, his words, in describing Fig. 2, being that, "The entire face of the envelope around the window is assumed to have been imprinted or colored to give definition to the window opening and obliterate signs of creep in the transparency-producing preparation"; and in the second patent that, "This coloring matter may be applied solid over the face of the envelope." The Board of Examiners-in-Chief then proceeded by saying:

"The purpose, function and idea of means seems to be the same in both cases. The rough edges of the transparent portion would be concealed just as well by coating all of the balance of the envelope with dark colored ink, and the only purpose of substituting a narrower border seems to be to get a different artistic effect. There is no mechanical advantage or utility in it. It is a mere matter of design. The claims are lacking in patentable novelty, in view of the references cited."

Furthermore, while the matter was pending before the Primary Examiner, and before it was appealed to the Board of Examiners-in-Chief from the proceedings in which the above quotations were made, Cohn, at page 599, among other things, said:

"We admit that it is a matter of common knowledge to make envelopes of transparent material. We also admit that it is a matter of common knowledge, broadly, to make an envelope [with] a generally opaque body having a transparent window or opening. It is also not new to render paper transparent by treating it with grease, and which proposition is included in the one second above

noted. We therefore agree with the Examiners' holding as to such matters."

In view of the above findings of the Office, and the concessions of Cohn in the proceedings for the obtaining of the first Cohn patent, we submit that it is pretty late in the day, to put it mildly, to claim that the Brown 1862 patent does not disclose a one-piece transparent window envelope or transparent portion formed by an oily preparation—in short, the exact envelope of the Cohn patent, with the exception of the border around the transparent window.

It should be understood, of course, that the Brown 1862 patent discloses *three* kinds of envelopes—one where an opening or aperture is cut out of the envelope to display the address on the enclosure, and without any transparent covering over the opening,—another where an opening or aperture is cut in the envelope and a separate transparent covering piece applied over the opening so as to allow the address on the enclosure to show through—and one where the space or window is made transparent out of the integral opaque paper, just as is done in making the envelope of the first Cohn patent. It is, of course, the last or *third* kind of envelope disclosed in the Brown patent that corresponds with the envelope of the first Cohn patent, with the exception of the border around the transparent space or window.

The complainant, Cohn, in his testimony, sought to distinguish his envelope from the Brown envelope, notwithstanding his concessions in the Patent Office that it was the same thing, with the exception of the border, and mentioned various grounds on which he sought to base such distinction, but a reading of his answer will show that he confused the various kinds of envelopes disclosed in the Brown patent, instead of confining himself to the particular kind or type that is

germane to the real question involved. Various of his grounds also were frivolous and inconsequential, when we keep our minds on the particular kind of envelope disclosed in the Brown patent that we rely upon as showing that everything was old in the Cohn envelope, in view of the Brown patent, with the exception of the border around the window.

In X-Q. 159, at page 186 of the Record, we asked him, and he testified as follows:

“X-Q. 159. Let us compare the defendant’s exhibit envelope illustrating the Brown 1862 patent offered at page 372 of the D. R. and the envelope described in the Brown patent, and see how far they contain matter in common. First, they are both envelopes; second, both envelopes are made from opaque stock; third, both envelopes have transparent spaces or windows in their fronts or faces; fourth, both envelopes have these transparent spaces formed by some means or substances that are adapted to render paper transparent where the same is applied; fifth, both envelopes have the transparent windows of a size and shape to permit the address on the enclosure for which they were made to show through the windows; sixth, both envelopes have the remainder of the face or front opaque; and, seventh, both envelopes are one piece, transparent window envelopes. Are not the various features mentioned above common to the defendant’s exhibit under consideration and to the envelope disclosed in the Brown 1862 patent?”

The above question was intended, by comparison, to show that the exhibit offered by the defendant to illustrate one of the kinds of envelopes disclosed in the Brown patent was a correct illustration of the same, and, as the defendant’s expert, Mr. Bond, had testified, “embodies the invention of the Brown 1862 patent.” As Cohn, in his answer, took up the various numbered features mentioned in the question, we will quote his answer point by point, with such comment after each point of his answer as may be pertinent to show the inconse-

quential character of some of the distinctions which he attempted to draw. In answering the question, Cohn said:

“No, for the following reasons. First, the envelope used for illustrating the Brown 1862 patent is an envelope, whereas Brown in his specification says, ‘Envelope or wrapper D.’ By referring to diagram D of the Brown drawings you cannot tell whether he had in mind an envelope or a wrapper, there being no distinction in any of the drawings.”

What is the difference between an envelope and a wrapper? An envelope is a wrapper—something to cover up an enclosure. The specification of the Brown patent, at page 695, after describing the address cards which constituted “one part of my invention,” to use the words of the Brown specification, proceeds by saying that “The other part of my invention consists in an improved envelope of wrapper D,” and the drawings show the envelope or wrapper marked with the letter D. The specification repeatedly speaks of the “envelope or wrapper,” and frequently uses the term “envelope” alone, without the synonym “wrapper” or other equivalent word; and both of the claims of the patent use the term “envelopes” alone. The drawings show the conventional illustration of envelopes, but whether Brown calls them envelopes or wrappers is a matter of no importance, and, consequently, the attempted distinction of Cohn, in the portion of his answer quoted, between envelopes and wrappers, amounts to nothing. Brown shows and describes an *envelope*, and its pertinence and character are in no way modified by using the synonymous words, “envelopes or wrappers,” to describe what he is talking about. Hence, the Brown patent describes and the envelope illustrating it shows, envelopes as inquired about in the question, and the answer should have admitted the fact. Cohn then proceeded:

“Second, the so-called Brown exhibit, opp. page 372

D. R., is made from opaque stock. Brown's may or may not be made from opaque stock. His specifications call for both and his drawings describe neither."

Cohn here says that the Brown envelope may or may not be made from opaque stock, and that his specifications call for both. If this be so, then clearly there is a disclosure of the one—the envelope made from opaque stock, as asked about in the question,—and Cohn should have plainly admitted the fact instead of saying, in effect, that while the Brown envelope was made from opaque stock the specification also described *other* kinds. Cohn then proceeded:

"Third, the so-called Brown exhibit has a transparent space or window in its face, while the Brown patent may have a space or hole, covered or uncovered by transparent material, the drawings and specifications in the Brown patent being silent as to the method of construction."

This part of Cohn's answer only mentions the first and second styles of envelopes described by Brown, and omits the statement in the Brown specification that "There may be only a transparent portion B, large enough to exhibit the 'direction' through it; and this may be made either by rendering a portion of the envelope, or wrapper, itself transparent." His answer in this respect, therefore, fails to respond to the third mentioned similarity between the Brown envelope and the defendant's exhibit illustrating it, which asked whether "both envelopes have transparent spaces or windows in their fronts or faces," and did not ask him about the first and second types of envelopes described by Brown, in which a hole or aperture may be cut and left unclosed, or cut and closed with transparent material. The specification of the Brown patent, however, shows what the fact is, and what the answer should have been. Cohn should have answered with an un-

qualified affirmative, according to the facts inquired about. Cohn then proceeded:

“Fourth, the so-called Brown exhibit has been rendered transparent by the use of an oily preparation. The Brown patent mentions no such method.”

The fourth particular mentioned in the question was as to whether “Both envelopes have these transparent spaces formed by some means or substances that are adapted to render paper transparent where the same is applied.” Nothing was said in the question about an oily preparation or what the constituents of the “means or substances” were, so long as they were “adapted to render paper transparent where the same is applied.” The Brown specification says that the transparent portion “may be made either by rendering a portion of the envelope, or wrapper, itself transparent, by the same means or substances as employed for making tracing paper or any other,” transparent. Brown was speaking to those familiar with paper and the “means or substances” by which the paper, or a *portion* of the paper, could be made transparent, without attempting to define what particular means or substances should be used. In like manner, the first Cohn patent defines no special means or substances, but simply says to apply to one side of the paper “a preparation which has the property of rendering transparent the portion to which it is applied,” leaving the constructor of the envelope at liberty to employ *any* known preparation he might desire, so long as it has “the property of rendering transparent” the portion of paper to which it is applied. Notwithstanding this similarity in the Brown and Cohn patents, of non-definition of the *particular* means or substances that should be employed, it is plain, we think, that the Brown patent covers *any* oily or greasy preparation, as such preparations, long before the application for the Cohn patent, were employed for making

“tracing paper,” as shown from our quotation from the Century Dictionary of the Edition of 1900, not to refer to the common knowledge, which everybody has possessed ever since paper has been made, that paper could be made transparent by the application of a greasy or oily preparation to it, or to any desired portion of it. Cohn then proceeded:

“Fifth, the Brown so-called exhibit has a transparent window of a size and shape to permit the address on the enclosure to show through, while the Brown patent only calls for a small, oval-shaped opening to permit a finely printed card to show through, according to the drawings shown.”

This portion of the answer draws a fictitious distinction, as well as incorrectly states the fact. The drawings of the Brown patent show a desired window for the address to be seen and read, and the specification says that there may be “a transparent portion B, *large enough* to exhibit the ‘direction’ through it.” The Brown patent left the *size* of the window to the constructor of his envelopes, and in that respect he did precisely as Cohn did in his first patent, where he specified no *form or size* for the transparent window, but simply said that he applied the transparency-producing preparation, so that “it may cover a larger or a lesser space, according to the *desired* size of the transparency or window.” The question merely asked him whether the envelope of the Brown patent and the defendant’s exhibit illustrating it did not both have the transparent windows “of a size and shape to permit the address on the enclosure for which they were made to show through the windows.” Cohn’s definition is frivolous and inconsequential. He should have answered the question by a direct affirmative. Cohn then proceeded:

“Sixth, the so-called Brown exhibit has the remainder of the face or front opaque, while the Brown patent may be either transparent or opaque, the specifications calling

for either construction, and it is impossible to tell from the drawings whether they were intended to be opaque or transparent."

The question asked Cohn whether the envelope of the Brown patent and the defendant's exhibit illustrating it did not both have the face or front of the envelope outside of the window opaque. He admits that the envelope of the Brown patent "may be either transparent or opaque," which, of course, includes the opaque form about which he was asked. The specification of the Brown patent, after saying that the envelope may have a portion made transparent, says, "leaving the remainder of the envelope opaque." He should have answered the question with a direct affirmative. Cohn then proceeded:

"Seventh, the so-called Brown exhibit is a one-piece transparent window envelope, while the envelope described in the Brown patent may be either a one or two-piece envelope; it being impossible to tell from the drawings whether the same is a one or two-piece envelope."

The question asked Cohn whether the envelope of the Brown patent and the defendant's exhibit illustrating it were not both "one-piece transparent window envelopes"; and in saying that the Brown envelope "may be *either* a one or two-piece envelope," Cohn necessarily assented to the conditions of the question. The specification of the Brown patent describes a one-piece transparent window envelope, as well as a two-piece envelope, and Cohn should have answered the question by a direct affirmative.

We have quoted the entire answer of Cohn to our question, and it will be apparent that the envelope of the Brown patent and the defendant's exhibit envelope illustrating it both contain every single one of the seven common points of construction specified in the question, so that we say that defendant's

expert, Mr. Bond, was exactly correct and right when he testified that the illustrative envelope “embodies the invention of the Brown 1862 patent.” We also insist that an analysis of Cohn’s answer to our cross-question 159 fully and exactly corroborates Mr. Bond, and that the exhibit envelope offered in evidence by the defendant to illustrate the envelope of the Brown 1862 patent fully and correctly does so.

We have dwelt on the construction of the pertinent Brown 1862 patented envelope,—the particular one of the *three* kinds that the patent discloses—so that there can be no question that the Brown patent does disclose a *one-piece transparent window envelope made from opaque stock*, with the transparent portion made by applying *some* oily material that would render the desired space or window transparent—exactly like the one-piece transparent window envelope of the first Cohn patent, with the exception of the border which Cohn printed around the window. We may have been tedious in our analysis and presentation of this contention, but we desired to establish beyond question that Cohn, in his *admissions* in the Patent Office in prosecuting his application, and the *officials* of the Patent Office in considering it, and the *witnesses* in discussing it, all were right in their understanding of the envelope disclosed in the Brown 1862 patent, because we take such envelope as a *starting point* in considering what Cohn did and what addition he made to the Brown envelope, in considering whether what he did involved the exercise of invention or amounted to anything more than the exercise of mechanical knowledge and skill.

Having shown, as above, that the envelope of the first Cohn patent was old *in every respect* except a border around the desired portion or space constituting the window, we will now take up and show that the use of borders around desired por-

tions or spaces of paper to give definition to the same and to cover up and conceal irregular, ragged or unsightly edges, just like the Cohn border, was an old and common practice in the various branches of the printers' art, and had been used for such purposes by printers of different work for many years before Cohn printed the borders on the envelope of his first patent. This involves a consideration of the second and following phases of the state of the art as detailed in our enumeration of what was old and well known, and so we proceed to consider them seriatim, as follows:

Second Division of the Old Art.

It appears from the evidence that it had been a common practice and expedient among three-color picture printers, and printers of lithograph labels, and printers generally, for many years, to print borders around the different kinds of work that they were doing, in order to give definition to the work and to cover up defects or imperfections in the edges of the work, caused by the overlapping of the colors or the running or spreading of the ink, wherever they desired to give the matter enclosed within a border a finished or ornamental appearance, just as Cohn printed the border on the envelope of his first patent, and for the same purpose.

Mr. Regenstein, who for many years had been assistant manager of the American Colortype Company, whose business was that of printing three-color pictures, on page 280, describes the method of printing such pictures, and from his testimony it appears that in three-color printing the paper is run through the press and one color printed on it. After the ink for this color has dried, the paper is again run through the press and printed with another color. After this second impression has dried, the paper is again run through the press and the third color printed. Owing to the imperfect or care-

less registration of the plates for printing the three colors, it often happens that the colors around the edges or margins of the pictures appear ragged and unsightly. To conceal this irregular and ragged appearance, and to give definition to the picture, a border was printed around so as to cover, conceal or obliterate the ragged and unsightly appearance presented at the edges. Examples of three-color pictures, both with borders and without borders, are shown in the Osborne 1900 art calendar in evidence, which fully serve to illustrate the use of borders with three-color pictures.

On page 280 we asked Mr. Regenstein and he testified as follows:

“Q. 91. Give us briefly a statement as to how three-color work is printed. I am only asking as to the printing end of the operation, and am not specially asking about the preparation of the plates to secure three-color effects.

“A. Three-color printing is done or printed from three half-tone plates or duplicates of such half-tone plates. The first impression is made from the plate with yellow ink; after the yellow impression is made, in some cases within four hours, and in other cases within twelve hours, the next plate is printed with red ink over the yellow; then the sheet is left unprinted for twelve hours and then finished up by printing the third plate with blue ink over the yellow and red.

“Q. 92. Then, as I understand you, the paper is passed three times through the press?

“A. That is correct.

“Q. 93. In case there is not a perfect registration in running the paper through the press for the different colors, or in case the plates vary in size, what condition is the margin or edge of the picture or whatever the three-color work represents, left in?

“A. In case the three plates are not absolutely of one size, or that the feeding of the printing press is done poorly, or in cases where the paper, on account of atmospheric conditions, changes its size, the colors used will overlap on the edges of the picture.

"Q. 94. You may state whether or not that overlapping or irregular registration of the colors at the edges is a matter of indifference or an objectionable thing.

"A. It is objectionable.

"Q. 95. What, if anything, was done in the three-color printing, where, owing to the causes you have mentioned, the edges or margins of the picture were left in an unsatisfactory or objectionable condition, to remove or cover up or conceal the irregularities of the picture?

"A. Where the customer is particular and is willing to pay the price in order to make it a first class job, a border is printed around such imperfect three-color picture, and, invariably, this border is made deliberately of such a size that part of the border will cover the spreading or bleeding of the three colors.

"Q. 96. How long has that, to your knowledge, been the practice in three-color printing?

"A. To my personal knowledge this has been done for the last twenty years, and I believe I can say that this idea of printing borders to cover up imperfections in printing was known to the old wood engravers two hundred years ago.

"Q. 97. Of what utility was this border that was printed on three-color pictures beyond covering up and concealing and giving a definite outline?

"A. The purpose is a useful and ornamental one.

"Q. 98. In what way did the border on color pictures serve the purpose that the border serves on these one-piece transparent window envelopes?

"A. For the same purpose stated before—useful and ornamental.

"Q. 99. In what way, in the case both of the three-color pictures and these one-piece transparent window envelopes, is the border useful and ornamental?

"A. In one case, the one-piece envelope, the oil is creeping, bleeding, and overlapping, and in the other case the colored inks are creeping, bleeding, and overlapping.

"Q. 100. In both cases, the objection to the creeping, bleeding, or overlapping, is removed by the use of the border, is it?

"A. In the case of the three-color work, the creeping, bleeding, and overlapping, is removed, but not in all cases,

as far as the one-piece transparent window is concerned.

"Q. 101. What difference is there in the purpose or object for which the border is used, in the three-colored pictures and in the one-piece transparent window envelopes?

"A. None whatsoever.

"Q. 102. In both cases, as I understand, it is to cover up and conceal what might otherwise be an unsightly or objectionable margin; is that correct?

"A. That is correct.

"Q. 103. Three-color work is done by printing presses and printing operations, is it?

"A. It is.

"Q. 104. Is that also true in applying the border or ring around the transparent portion of these envelopes?

"A. That is true.

"Q. 105. And in both cases the border is formed with some kind of an ink, is it?

"A. The border is printed with ink.

"Q. 106. If you have present here any samples of three-color work that will illustrate or show the use of the border, as you have described, please produce the same.

"A. I have.

"Q. 107. This book which you have handed me is entitled on the outside of the front cover: 'Osborne Art Calendars for 1900,' and on the first page I find at the top 'Annual Catalogue, 1900,' and at the bottom of the page I find 'Copyright, 1899, The Osborne Company, 253 Broadway, New York.' What do you know about the publication of this book or calendar?

"A. This book was published in 1899 by the Osborne Company, of New York."

"Q. 110. If you know, please tell us how long the Osborne Company has been publishing art calendars similar to the one we are discussing.

"A. I cannot state definitely, but I believe about fifteen years.

"Q. 111. Please point out some representative picture in this book or Art Calendar that will illustrate the use of a border for covering up and concealing imperfect or objectionable margins, and giving definite outline or definition to the picture; and also some picture that will il-

illustrate the objectionable margins of the pictures, which have been left exposed or uncovered by the non-application of a border to cover them.

"A. A specimen in which the plates overlap appears in the plate No. 4654 opposite page 16; and a plate on which the olive green tint border is printed over the margin appears on page 38, Continental Building & Loan Association Calendar.

"Q. 112. You have pointed out two illustrations in this Osborne Art Calendar for 1900, opposite page 16 and on page 38, to illustrate the running or overlapping of the colors at the edges or margins of the picture, and the covering and obliteration of such ragged or objectionable edges, by printing a border around and over the same. In selecting these two illustrations, have you meant that they were the only illustrations of such work in the book?

"A. In this book are a number of prints or subjects representing both kinds.

"Q. 113. I notice in this picture on page 38 that the olive green tint, if that is a correct description of it, appears darker in a narrow strip or border around the colored portion of the picture. Why is there this difference in appearance of the tints, if you know?

"A. This line in question is darker than the balance of the border on account of printing the tint over the three colors."

"Q. 119. How generally has it been the practice in three-color printing, to use borders printed around the margin of three-color pictures, to cover up or conceal irregularities or objectionable appearances in the edges, due to imperfect registration or other causes?

"A. It is the universal practice.

"Q. 120. And for how long a time has such been the practice, to your personal knowledge?

"A. To my personal knowledge, it is the practice, so far as three-color printing is concerned, for the last sixteen years, and, as far as color printing from plates, which are not three-color plates, is concerned, for the last twenty years.

"Q. 121. I notice in this book, on page 7, a cut numbered 4514, 'Tales of Chivalry'; another cut on page 20, numbered 2024, 'The Bride and the Fortune Teller'; and another cut on page 32, numbered 2603, 'A Florentine

Girl'; which appear to have a gilt or golden colored border. What is that color termed in the art?

"A. Gold border.

"Q. 122. Is it printed on?

"A. It is.

"Q. 123. What is the object of that printed gold border, such as I have called your attention to?

"A. It is done to beautify the job.

"Q. 124. In beautifying the job, what, if any, effect, does it have on the concealing or covering up of imperfections or objections in the border of the picture?

"A. The gold band or border around the colored print is made deliberately wider, in order to cover up the bleeding of the three-color work, and the ornamental feature of the design beautifies the job.

"Q. 125. I think you spoke yesterday of some cases where, through using a border too narrow, the imperfection in the edge or margin of the picture or other work, was not properly covered. I will ask you to look at this picture on page 23, 'The Florentine Girl,' and tell us whether it illustrates such careless or imperfect work.

"A. The subject, 'A Florentine Girl,' illustrates distinctly careless plate making. The mistake was made by the engravers, who made the oval gold plate.

"Q. 126. I call your attention to the picture on page 8 of this book, numbered 4504, 'A Connoisseur,' and the plates on page 12, numbered 4113, 'Knickerbocker Times,' and numbered 4154, 'An Old Road in Virginia—Sunset,' and the plate on page 36, numbered 6024, 'Under the Willows,' not to mention other plates or pictures, and ask you whether they afford illustrations of objectionable edges or margins in the pictures, due to the overlapping or running of the colors, where, to save expense or for other causes, no border was printed on.

"A. They do."

Gustaf Olson, who had worked some sixteen years for the American Colortype Company, on page 374, after describing his work as an engraver, was asked and testified:

"Q. 11. What, if anything, was done to give the margin or edges of the pictures a finished or ornamental appearance?

"A. We must necessarily engrave a plate that will constitute a line covering over any defects that are left in between edges or borders.

"Q. 12. Did you make such plates in your work as an engraver?

"A. Yes; often.

"Q. 13. How long have you made plates for printing a border or ring around and over the edges of colored pictures, to cover up defects, such as you have mentioned?

"A. Off and on for seventeen or eighteen years; as I was a wood engraver before working for this company.

"Q. 14. Look at this book which I now show you, which has been offered in evidence as 'Defendant's Exhibit Osborne Art Calendar for 1900,' and state how long you have known of Osborne Art Calendars showing pictures of the general character of those contained in this book shown you.

"A. Sixteen years back, I have seen work of this kind; and Osborne work about ten years.

"Q. 15. Please indicate some pictures in this Osborne Art Calendar shown you, which show or illustrate borders around the pictures, such as you say you have made, if you find any such pictures.

"A. I call your attention to the picture No. 4453, 'When the Frost is on the Pumpkin and the Fodder's in the Shock.' This picture shows a green border printed over and around the edges of the color reproduction. This leaves an unfinished effect, as will be noticed by a dark rim showing between the color illustration and border.

"Q. 16. What do you mean by saying, 'This leaves an unfinished effect'?

"A. It shows where color reproduction and tint join together in one edge unsuccessfully in this case; thereby leaving a dark green edge. This condition is overcome on page 20 in the same book in the plate No. 2024, 'The Bride and the Fortune Teller,' by printing a gold border, and thereby eliminating this dark green edge, which otherwise shows, by overlapping of colors. Also page 7, plate No. 4514, 'Tales of Chivalry.' This shows a printed colortype with gold border. This gold border is covering over edges, which would otherwise show in yellow, red or blue. There are also other illustrations in the book which demonstrate the same.

“Q. 17. What is the purpose or object of the ring or border around the pictures, such as you have called attention to and others in this book?

“A. Primarily, to cover defects; secondarily, to increase the beauty and value in some cases.

“Q. 18. I ask you to look at this book and point out two or three illustrations of pictures unprovided with borders, which illustrate the facts that you have reference to.

“A. Page 12, plate 4154, ‘An Old Road in Virginia—Sunset,’ shows a red and yellow discoloration on the bottom of the left-hand side of the picture. Plate 4654, ‘Among the Lillies,’ opposite page 16, the bottom right-hand side and top, show bad discolorations, due to the plates not being properly cut. Page 15, plate 4634, ‘A Venetian Girl,’ the right-hand side of the plate shows red and yellow extending below the blue, consequently giving a discoloration. The top and left-hand side also show ragged edges.

“Q. 19. How long do you say that you, yourself, have made plates for the printing of rings or borders around and over the edges or margins of the pictures, to cover up or conceal defects and to add a finished or ornamental appearance to the picture?

“A. About seventeen years.

“Q. 20. Did you ever make such plates for other kinds of pictures than color pictures?

“A. Yes.

“Q. 21. What kinds?

“A. Before I worked in color work, we often made what is called two-tone, as showing a green and orange, or red and blue, and when pictures would show bad edges, we were obliged to print borders around and over those edges.

“Q. 22. About how many years ago was that?

“A. About sixteen or seventeen years, and often in the intervals since then.

“Q. 23. What was the object or purpose of the borders around these green and orange, or red and blue pictures?

“A. They were to cover up defects.”

Emil A. LeGros, vice-president of the Franklin Company,

—an engraving and printing company—of Chicago, on page 406, was asked and testified:

“Q. 8. I show you a book that has been offered in evidence as ‘Osborne Art Calendar for 1900,’ and ask you to look at it and state, if you can, about how long you have been acquainted with the Osborne Art Calendars similar to the one shown you.

“A. I have been familiar with work of this character for about twelve years.”

In view of the foregoing, reinforced as it is by the Osborne Art Calendar in evidence, showing illustrations of three-color pictures, some of which are unprovided with borders, and in which irregular and ragged edges appear, and some of which are provided with borders covering up and concealing the ragged and irregular edges caused by imperfect registration of the plates, or the running of the colored inks, it must be considered as established and settled beyond question that it was old and common in the printing of three-color pictures to print a border around the picture to cover up, obliterate or conceal the ragged and unsightly edges resulting from different causes, and to give definition to the picture enclosed within the border, and that such had been the common practice of three-color printers for many years before the application for the first Cohn patent. Especially must this be considered as established and settled, in view of the fact that there is not a word of testimony in the record questioning or contradicting the correctness of the testimony of defendant's witnesses, or the authenticity of the Osborne Art Calendar for 1900, or of the existence and employment of the practice of printing borders around three-color work for the same purpose as Cohn printed the border around the transparent window of the envelope of his first patent.

The printing of borders around three-color pictures, for the same purpose as Cohn printed the border around the window or address space of the envelopes of his first patent, must, therefore, be considered as established and settled as a part of the prior art as it existed many years before the Cohn invention.

Third Division of the Old Art.

Furthermore, it was customary for many years prior to the invention of the first Cohn patent to print borders of bronze, gold, or other colored inks, around the colored lithographs used for making labels such as are applied to bottles, cans, and similar receptacles, in which perfumery, foods, and other articles, are contained, in order to define the work and cover up imperfections in the edges or margins and give them an ornamental and finished appearance. Illustrations of such lithograph printing were produced by the witness Sherwood, and were inserted at typewritten page 194 of the Defendant's Record as filed in the court below.

Alexander B. Sherwood, president of the Sherwood Lithograph Company, of Chicago, who had been in the business thirty odd years, at page 399 was asked and testified as follows:

“Q. 4. In doing lithographic printing, what is the custom or practice where the picture or design printed has defects or is objectionable in appearance around the edges or margins?

“A. I understand your question means the outer margin of the picture or design. It is always usual or customary to obliterate any of these ragged margins or inequalities, by covering with a suitable solid border to give or make a perfect printing edge for the whole design.

“Q. 5. How long has it been customary from your knowledge of the lithographic art to print a border around the outer edges or margins, as you have just explained?

“A. Ever since I have been identified with or have had knowledge of the business—thirty-four years.”

“Q. 11. How long, to your knowledge, has it been the custom or practice in the lithographic art, to make or apply the borders, as you have explained?”

“A. Always, for I know of no other method.

“Q. 12. What is the purpose or object of applying a border around a picture or design, as you have explained?”

“A. There are several; the first and primary object being that it covers up the inaccuracies of the register of colors where they are brought out to the edges of the design; second, it is often economical, rather than to take up the artist’s time or the transferrer’s time, or the plate maker’s time, in trying to do it by the other method, which would be one full of technical hard possibilities; third, it adds perhaps to the artistic appearance of the design. There are other minor reasons, perhaps, but these are the principal ones.

“Q. 13. I notice, on a part of this sheet, two designs with the words ‘Holman’s Perfume, Holman, Chicago,’ printed on them which do not have a border printed around them. Please look at these two particular designs, and state whether or not they illustrate the unfinished appearance around the outer edge or margin that you have mentioned.

“A. They do, sir, very well.”

There is not a word of testimony in the record questioning or disputing the testimony of Mr. Sherwood, as to the use of borders as described by him in the printing of lithographic pictures or labels, and therefore no foundation for questioning the absolute truth of his statements. He was a man of long experience in the art, and occupied a prominent position as the president of a large lithographing and printing company.

It must be taken as established and settled, therefore, that it was the old and common practice, in the printing of lithograph pictures or labels, existing for many years before the date of the Cohn invention, to print borders around such pictured labels to cover up and conceal or obliterate any ragged,

irregular, unsightly, or unfinished appearance, at the margins or edges of the work, the same as the border printed by Cohn around the edge or margin of the space or window of the envelope of the first Cohn patent. This was the state of the art as to this kind of printing for many years before Cohn entered the field.

Fourth Division of the Old Art.

Furthermore, it had been customary for many years before the Cohn invention for printers generally to print a border around different kinds of work where the ink would run or spread, in order to define the work and cover up and conceal imperfections and give the work a finished and desirable appearance. Illustrations of the kind of borders used by printers generally will be found in the deposition of Mr. Regenstein, at typewritten page 50 of the Defendant's Record, on file in the court below. The use of the ordinary printers' border now under consideration is shown by the depositions of many witnesses.

On page 291 of the Record, Mr. Regenstein was asked and testified as follows:

"Q. 127. Do you know what the practice has been in the printing art, distinct from the three-color art particularly, as to the use of means of any kind for covering up or concealing objectionable edges or margins, in the work being done?

"A. To my knowledge, the printing of borders and tints over overlapping or bleeding colors—this fact has been known to me for the last twenty years, and is common, so far as all color printing on printing presses is concerned, from printing plates; also color printing on lithographic presses, from stones, and other materials used.

"Q. 128. If you have made any samples to illustrate the printing of borders in the printing art, as referred to in your last answer, please produce them.

“A. The specimens which I hold in my hand were printed under my direction early this week.

“Q. 129. What do these two samples that you have produced illustrate or represent?

“A. These samples represent that, where an undersized paper is used, and the ink used is not sufficiently stiff, there is a likelihood that the edges of the print will appear unclean and ragged. In order to perfect the job, the printing of the border with stiff ink will do away with such imperfections.

“Q. 130. How long, to your knowledge, has it been the practice in the printing art to print borders to cover up imperfections in the edges of the work, as shown in these samples that you have produced?

“A. I have had such knowledge for the last twenty years.

“Q. 131. What kind of paper or quality of paper was the printing done on, in these samples that you have produced?

“A. The printing is done on an undersized paper, used by the Saturday Evening Post on its cover.

“Q. 132. If you made a batch of your one-piece transparent window envelopes without a border around the window what would a printer naturally do, in the exercise of his knowledge and skill in the printing art, to give a more finished or desirable appearance to the window, upon observing that the oil had run or crept into the paper around the margins or edges?

“A. A printer would print opaque ink over such imperfections. . . .

“Q. 133. In printing a border around the window, what if anything would he be doing different from or contrary to what he had been accustomed to do for the past twenty years, to your knowledge?

“A. Any printer would print a border of opaque ink—the thing he always does when he wants to cover imperfections.

“Q. 134. Is that a part of the knowledge and experience and expedients of the printers' art?

“A. It is.

“Q. 135. And has been, to your knowledge, for how many years?

“A. To my knowledge for twenty years.

"Q. 136. You yesterday identified some old one-piece transparent window envelopes as having been made as early as January, 1904, which showed a border printed around the transparent windows. Why did you not apply for a patent on that border, or the window of the envelope provided with it, if you did not?

A. I did not apply for a patent, because it seemed to me ridiculous to ask for a patent on a thing or operation which I and others had done and made for years, and I felt, if I should come to you and the Patent Office for such a patent, that you would give me the laugh.

"Q. 137. Did you see anything in what you had done in applying the border that you regarded as invention?

"A. I did not, since I had done the same thing which I was doing right along.

"Q. 138. When you saw that the oil ran or bled, into the paper, how long did it take you to know what to do to remove the difficulty?

"A. The time is so short that I cannot state the same, since it was simply a thought.

"Q. 139. Did you do anything more than apply the knowledge you had of the printing art, to the situation?

"A. I did not."

"Q. 142. How far, if at all, has your business for, say, the last twenty years, brought you in contact with printers and the printing art generally?

"A. For four years my business was the business of a photo-engraver making all kinds of printing plates. In addition to this business, I, in 1894, went into the business of making and printing three-color plates. Three gentlemen and myself started this art of three-color printing in this country in 1894. I supervised and criticized the work and was considered one of the foremost critics and experts on fine plate printing. Since 1905, I am actively engaged in the printing and manufacturing of envelopes, and late in 1903 and in 1904, in connection with my business as a color printer, I manufactured and experimented in the matter of Transo envelopes.

"Q. 143. Did these various businesses bring you in contact with printers and printers' art, so that you became acquainted with methods and practices of the same?

"A. They did.

"Q. 144. In the printing of your one-piece transparent

window envelopes, does the application of the border prevent the creeping or running of the oil, or simply cover up such creeping, as far as the border extends?

"A. The existence of the border does not prevent the creeping, and in many cases the oil will creep over or further than the border is indicated."

Gustaf Olson, an engraver by trade, on page 383, was asked and testified as follows:

"Q. 51. Prior to making the plates for the rings or borders for the envelope paper, as you have explained, had you seen work where the ink ran or spread at the borders?

"A. It does so in most every case where a solid plate is used. I have seen this as far back as I can remember being in business.

"Q. 52. In such cases as you have just mentioned, what was done, if anything, to cover up the running and spreading of the ink at the borders or edges?

"A. In the first place, the printer would thicken up his ink or use a different kind of ink to prevent this spreading or he would run something around the border or edge to hide this defect.

"Q. 53. Did you ever make any plates for the printing of a ring or border around the edges, to cover up the running or spreading of the ink as you have just mentioned?

A. Yes, just as often as the printer would decide that by printing a border he could eliminate the ragged appearance of the edges of the picture, I would have to make a plate for him.

"Q. 54. How long ago have you made plates for printing a border around work, where the ink ran or spread, so as to present ragged or unsightly edges or margins?

"A. About sixteen or seventeen years ago.

"Q. 55. How common a practice was it, to your knowledge, in the printers' art, to print rings or borders around different kinds of work, where the ink ran or spread, to cover up defects or unsightly appearances in the edges or margins of the work?

"A. It is so common that everybody in the printing establishment would be expected to know it.

“Q. 56. Was it a part of the common knowledge and practice of the printers’ art?

“A. Yes.”

Alexander B. Sherwood, president of the Sherwood Engraving Company, of Chicago, with thirty years’ experience in the printers’ art, on page 402, was asked and testified:

“Q. 14. Have you any knowledge or use of borders in the printing art generally, or distinct from the lithographic work?

“A. Yes, sir. The method in each kind of business is practically the same, and the result obtained, so far as that particular feature goes, is the same.

“Q. 15. How long have you known of the use of borders by printers, for either covering up unsightly edges or margins on the work being done, or for giving definition or sharpness of outline to the work included in the border, or for other purposes?

“A. It has always been the practical and common method of handling such work; to my knowledge for thirty-four years.

“Q. 16. If you had been printing a work or design or picture of any kind, for, say, the last thirty years, and you found that the ink or colors or whatever was used ran or spread, so as to create an objectionable or unsightly outer edge or margin, what, in the exercise of your knowledge of the lithographing and printing arts, would you have immediately done to cover up or obliterate such objectionable outer edges or margins of the work?

“A. The first thought that would occur to me, both from the economical and practical standpoints, would be to make a border which was sufficiently wide and solid to cover over and obliterate these unsightly edges, either by printing in a stronger color itself than the colors underlying, or by finishing with a bronze border, as on the sheet here before me.

“Q. 17. What would you say as to its requiring any invention on your part, or on the part of any other printer, to print a border in such a case?

“A. The question appears ridiculous to me, for the

proposition as you state it is so self-evident to any practical man that there could be no question about his being foolish enough, in view of that being the only way to get over the difficulty, and which is commonly and universally known.

"Q. 18. By 'foolish enough,' you mean simple enough?

"A. Yes, sir."

Emil A. LeGros, vice-president of the Franklin Company, —a large engraving and printing company—on page 404 was asked:

"Q. 2. How long have you been acquainted with the engraving business, and the printing business?

"A. About twenty-one years.

"Q. 3. In the engraving and printing business, what is the practice or custom, when a picture or piece of work of any kind shows defective, ragged, or unsightly edges or margins, to cover up or obliterate or conceal such unsightly or objectionable edges?

"A. It is customary to print a border of some kind around the picture.

"Q. 4. How long have you known of such custom or practice in the engraving or printing arts?

"A. As long as I have been in the business.

"Q. 5. From your knowledge and experience, what would a printer or engraver naturally have done if the work in hand showed a defective or unsightly appearance around the edges?

"A. Print a border around it.

"Q. 6. Has that been the case, to your knowledge, for, say, the last fifteen or twenty years?

"A. It has.

"Q. 7. What have you to say, from your knowledge and experience, as to whether or not the printing of a border around the work would have involved any invention?

"A. I shouldn't think it would be considered an invention, because it has been used in the regular course of business right along."

There is no testimony whatever in the record qualifying or

disputing the testimony of the witnesses as quoted above, so that it stands as established and settled by the evidence that it was a common custom and expedient on the part of printers generally, for many years before the date of the invention of the first Cohn patent, to print a border around various kinds of work to cover up, obliterate or conceal ragged, irregular, or unsightly edges caused by the spreading or running of the ink or whatever was used for the printing. Indeed, it would seem that no evidence, as to the custom of printers in this regard, was needed, as we have no doubt all seen such borders as long as we can remember. But, however, this may be, it is established by the evidence on the part of the defendant, and unquestioned and undisputed by any evidence on the part of the complainant.

Fifth Division of the Old Art.

Furthermore, borders were printed around the transparent windows of one-piece envelopes long prior to the date of the invention of the first Cohn patent. The Busch 1896 English patent, at page 716 of the Record, describes a one-piece window envelope with a border printed around the window or transparent portion or section. The specification of the Busch patent says (the italics being ours) :

“This invention relates to postal envelopes which differ from others by the fact that a *portion* or the whole of the envelope is transparent, so that the address of the letter may be read through the envelope, and need not, therefore, be written or printed on the same. . . .

“In some cases the front of the envelope is made of transparent material, while the back is opaque, or *vice-versa*; or a *portion* of the front may be transparent, while the rest of the envelope is opaque, or the back and a *portion of the front* may be transparent.

“The desired contrast or difference may be produced either by choosing two different kinds of paper, *or by*

printing with opaque coloring matter applied to a portion of the envelope."

It appears from the above that the Busch specification plainly discloses, among other things, a one-piece window envelope, in which a *portion* of the front forming the window or space for the address to show through, is to be transparent, while the remaining portion of the front is to be rendered opaque by printing an opaque coloring matter on the paper, thus constituting a border. It appears that the border in the envelope of the Busch patent is to extend from the window or transparent portion to the edges of the envelope, thus covering the entire front of the envelope, except the transparent window or space. As we have already pointed out, the first Cohn patent in suit contemplates this precise arrangement of border. The specification, in describing the drawings, says that "Fig. 2 represents an envelope with a different shaped opening from that of Fig. 1, and in which the *entire face of the envelope around the window* is assumed to have been imprinted or colored to give definition to the window opening and obliterate signs of 'creep' in the transparency-producing preparation." And, again, in line 46 of the first column, after describing the application of the transparency-producing preparation, the specification says that, "The *remaining portion, or a part of the remaining portion, of the blank which forms the face of the finished envelope A* is then imprinted with a suitable opaque coloring matter."

We introduced three illustrative envelopes showing the invention described and disclosed in the Busch patent, and they were offered in evidence at page 400 of the Defendant's Typewritten Record filed in the court below. Mr. Bond, the defendant's expert, on page 576 of the Record, after describing the three illustrative envelopes, was asked and testified:

"Q. 5. How far do you consider that the three envel-

opes produced by you and discussed above are fair, real and actual embodiments and exemplifications of the envelopes shown and described in this English Busch 1896 patent?

“A. All three of the envelopes are fair, real and actual representations of envelopes which would be made by following the directions for making envelopes, found in this Busch patent.

“Q. 6. I notice in the second and third envelopes produced by you that the transparent portion or window of the envelope is somewhat oval in shape. Do you consider that in any way a departure from the description of the Busch patent?

“A. I do not. It is merely a matter of selecting the shape of the transparent portion, and there is nothing in the Busch patent limiting the shape of the transparent portion to any particular form.

“Q. 7. How far does the oval-shaped window in these two Busch envelopes correspond to the shape of the transparent windows of the Brown 1862 patent?

“A. They are substantially the same as the windows of the transparent portions of the envelopes of the Brown 1862 patent.”

The correctness of these illustrative envelopes, as embodying the inventions described in the Busch patent, is, we think, literally admitted by Cohn in his testimony, at page 188, where we asked him about one of the complainant's exhibits marked R, and where he testified as follows:

“X-Q. 161. The specification of the Busch British 1896 patent among other things says that, ‘A portion of the front may be transparent, while the rest of the envelope is opaque.’ This is true of the envelope Exhibit R, is it not?

“A. It is.

“X-Q. 162. This is also true of the envelope Defendant's Exhibit Busch 1896 Envelope No. 1, is it not?

“A. It is.

“X-Q. 163. It is also true of the Defendant's Exhibit Busch 1896 Envelope, No. 2, is it not?

“A. It is.

“X-Q. 164. The specification of the Busch patent says that, ‘The back and a portion of the front may be transparent. This is true of the Defendant’s Exhibit Busch 1896 Envelope No. 3, is it not?’

“A. It is.”

The correctness of the illustrative envelopes, as exemplifications of the envelopes disclosed and described in the Busch patent, being thus established by the testimony of both parties, they may be considered as physical embodiments of the envelopes of the Busch patent and treated accordingly.

The only difference between the envelope of the first Cohn patent and the envelope of the Busch 1896 English patent is, that Cohn makes only a part of his paper transparent, before applying a border around such part, while Busch made his entire blank transparent, or, what is the same thing, took transparent paper for his stock to begin with, and then printed his border over such portion as he did not desire to leave exposed or transparent. He then printed his border of coloring matter so as to give definition to the window, and cover or obscure the remainder of the face of the envelope by extending the border from the edges of the window to the edges of the envelope, as Cohn says *his* border may be extended. This forms precisely the kind of a border that Cohn contemplated and described as falling within the scope and limits of his invention.

The border that Busch printed on is printed or superposed on top of such portion of the envelope as he desired to cover up or obscure, and the Cohn border is printed or superposed on top of such portion of the envelope as *he* desired to cover up or obscure, and is, and necessarily must be, in order to serve its purpose, printed over the outer margin or edge of the transparent window itself, and so thereby covered up and

obscured the portion of the transparent space which he desired to conceal—the outer edge or portion that had the ragged appearance. Both Cohn and Busch, therefore, print or apply the coloring matter over the *transparent* paper—differing only as to the *amount* covered. Whether Busch himself applied the transparency-producing preparation, or some one else applied it before he began his work, is immaterial. Whether Cohn applies the transparency-producing preparation himself, or takes the paper to which it has already been applied, is likewise immaterial. Both use material that has the window or address space somehow or other made transparent, either during its manufacture or afterwards. Busch says that the desired contrast between the window and the balance of the envelope may be produced “by printing with opaque coloring matter applied to a portion of the envelope.” Note that the coloring matter—the border—is applied by “printing,” and that it is applied only to a “portion” of the envelope, just as in the Cohn envelope.

Sixth Division of the Old Art.

Furthermore borders were printed around transparent spaces made in opaque paper by the application of an oily preparation, for various purposes, long prior to the alleged invention of the first Cohn patent, as shown by a number of patents offered in evidence that were not referred to or considered in the prosecution of the Cohn application in the Patent Office. This will be apparent on reference to the patents themselves.

THE TUDOR 1878 PATENT, at page 698, relates to the making of imitation stained glass windows on paper, and consists in printing lines in heavy opaque ink on the paper selected, and then applying the transparency-producing preparation to the spaces or sections included within such heavy lines. These

heavy printed lines represent the "leading" which was used in stained glass windows between the pieces of glass. As a matter of fact, they form a *border* around each transparent section or portion of the paper and give it definition, and *necessarily* serve to cover up and conceal any spreading or bleeding of the oil used in making the sections transparent. In this way they perform the function and do the work of the borders in the Cohn envelope. The Tudor specification, among other things, says:

"The nature of my invention consists in paper having opaque lines printed, painted, or stained thereon, resembling the outlines of leaden sash doors usually employed in the construction of stained glass windows, and transparent coloring applied by printing, staining or painting the spaces between the opaque lines. This paper is easily transported and readily applied to window panes; and when oiled or coated and filled in the pores with resinuous substances, as by varnishing it, it becomes in the colored portions more or less transparent, and presents the pleasing effect of stained glass of usual construction.

"Plain paper, such as lithographic or writing paper, may be used. Paper more transparent is preferable. The opaque lines and coloring may be applied on one or both sides of the paper."

The fact that the Tudor paper contains many transparent portions or sections is immaterial. There is a border around *each* transparent portion, and it is obvious that, when the transparent coloring is applied to render the spaces or figures transparent, particularly when such preparation is applied by *staining*, as the specification says may be the case, the transparency-producing material will flow into and permeate the fibres or tissues of the paper and present ragged and unfinished edges around the spaces, were it not for the opaque border lines printed around each of the spaces, which cannot but serve the purpose of covering up and concealing such ragged appearance and giving definition to the figure or space

enclosed within the lines. We thus have, in the Tudor patent, opaque paper with predetermined spaces rendered transparent by some oily preparation, and with heavy lines around each of the spaces. Any one of the spaces may be considered as corresponding to the transparent space or window in the paper of the Cohn envelope, and its border as corresponding to the border of the Cohn envelope.

In view of this Tudor patent, there was nothing new, therefore, in making paper transparent by the application of an oily preparation in the *desired* space or spaces, and printing *a heavy border around* such space or spaces, and which inherently and in the very nature of things *must* operate to cover up and conceal any ragged or unfinished appearance in the edges of the spaces caused by any flowing, spreading, or bleeding of the oily preparation through the fibres and tissues of the paper.

THE HOLE 1894 BRITISH PATENT is for a coin bag made up of paper or other material provided with holes or perforations, through which the coin may be seen, and with a heavy colored border printed on the paper outside of the holes, so as to distinguish and give definition to the same. The Hole specification, on page 706, after describing coin bags made of paper or other material, says:

“With bags so constructed it will be unnecessary to open them to ascertain the nature of their contents as this can be easily and quickly done by reason of the perforations, aided if necessary by black or other coloured lines on the exterior of the bags which would form a relief to the colour of the coins it contains.”

The drawing of the Hole patent appears at page 708, and a mere glance at it shows that it discloses the use of colored or tinted borders around a desired space to give definition to

the same. Of course, such borders would obliterate, cover up or conceal any imperfections, defects or undesirable appearances in the paper over which they were superposed, the same as the border does in the first Cohn patent.

THE LEIGH 1894 BRITISH PUBLICATION shows what may be termed a fashion display device for setting off the appearance of dress materials. It shows how a given dress material will look when made up and worn. The invention consists in a sheet of any desired material in which the outline of the human figure, either in whole or to the extent desired, is delineated in transparent material, while the surface or face of the sheet outside of the figure is covered by a black or other colored border. The nature of the invention will be readily understood by inspecting the drawings at page 713. The specification of the Leigh publication—for, at page 461, it was proved into the case as a publication rather than as a patent—at page 711 says:

“It has already been explained that my invention requires that portions *c* of the sheet, that is as much of the latter as is within the outline *a* shall be transparent. If celluloid is the material of the sheet, then the necessary transparency is already there. If, on the other hand, the material of the sheet is opaque normally such within portions *c* must be made transparent, or of transparent material, care being taken when the opaque portion and the transparent portions are of distinct materials, that they are evenly and well joined along the said outline *a*.”

The specification on the same page says:

“It—the material—must be naturally transparent or at any rate capable of being made transparent.”

It appears, therefore, from an examination of the Leigh publication that it was old to take a sheet of proper kind and make a desired *portion* transparent, and to print a border

around the transparent portion of black or other colored ink or material to give definition to the transparent space, and such colored border necessarily must have the effect of obliterating, covering up or concealing any defect or unsightly appearance in the sheet beneath the border. The specification, in speaking of the border, says that "Its function is to cover up the material of the cloth undergoing exhibition and inspection, for an area outside the said outline *a* sufficiently extensive in all directions to prevent the cloth outside the outline obtruding itself into the customer's field of view," that is, to cover up and conceal anything which it is desired shall not be seen.

THE SMITH & BROWN 1901 BRITISH PATENT describes a method of making transparent tablets, posters, labels, and similar devices for advertising purposes, and the specification, at page 722, describes the invention as consisting in the making of certain portions of the paper transparent by a suitable material and printing or otherwise applying inks or colors around the same which thus constitutes a border around the transparent portions.

"The printing or application of such black ink or colour, or inks and colours, is for the specific purpose of rendering opaque and dense certain and predetermined parts of the said advertisement or public notice when the said advertisement or public notice is placed before artificial light and also to enable us by means of spirit varnish to make transparent other certain and predetermined parts of the aforesaid advertisement, or public notice, which parts are exposed or left unprotected by the absence of the black ink, or colour or inks and colours, which are not printed or applied on the aforesaid certain and predetermined transparent parts of the reverse or negative surface of the aforesaid paper, to that surface on which the advertisement or public notice is printed and displayed.

"We apply spirit varnish of ordinary commercial manufacture to certain and predetermined parts on the

reverse or negative surface of paper to that surface on which is printed or displayed advertising matter, which certain and predetermined parts we purposely leave bare or unprotected by reason of not printing or applying black ink or colour or inks and colour on the said parts.

“The application of spirit varnish is for the specific purpose of rendering transparent only such parts of the advertising matter as we desire and intend to show and become brilliant when the said paper on which is printed or displayed advertising matter is placed before artificial light.”

The foregoing quotation shows that the Smith & Brown 1901 British patent discloses a sheet of paper with certain and predetermined parts made transparent by the application of varnish which, of course, is an oily preparation, and printing the surface of the paper outside of the spaces so rendered transparent with a black or other colored ink, thus forming a border around the transparent spaces, the printing of such border necessarily and inherently must have the effect of obliterating, covering up or concealing any running or bleeding of the varnish or oily preparation into the tissues of the fibres of the paper, the same as the border around the transparent window of the envelope of the first Cohn patent.

Neither the Tudor, Hole, Leigh, and Smith & Brown patents or publications was before the Examiners in the Patent Office, so far as the proceedings disclose. They show that it was old in various arts to take paper and render certain desired and predetermined parts of it transparent by the application of an oily preparation, thus forming transparent windows or spaces and printing or otherwise applying inks or coloring matter around the transparent windows, thus forming borders which application of inks necessarily had, and must have had, the effect of giving definition to the windows or spaces, and of covering up and

concealing or obliterating any running or bleeding of the oily preparation in the fibres or tissues of the paper. They fully meet the contention of Cohn's attorney in his argument before the Examiners-in-Chief, at page 611, where, in speaking of the Cohn invention, he says:

“The novelty of this invention is in providing a colored or tinted border surrounding a window portion which has been made transparent by some preparation which, because of its oily character, will creep into the surrounding opaque stock and give a ragged and unsightly outline to the transparent window, and I submit that neither of the references cited has any bearing upon such a feature, or offers any suggestion of the same.”

The above argument could not have been presented had the above references been discovered and cited by the Examiner, showing transparent portions, spaces, or windows in opaque paper produced by the application of oily preparations, which inherently and from their nature must have spread and bled and formed rough and ragged edges, with borders of ink or other colors printed around them, which necessarily operated to cover up or conceal the unsightly edges and give definition to the windows, and a finished and ornamental appearance to the work. They show that the very idea and feature, which counsel emphasized in his argument in the Patent Office, was fully disclosed in patents long prior in date to the Cohn application, so that the public was in full possession of every idea that Cohn relies on to support the claim of novelty, utility, and invention in the envelope of his first patent.

Recapitulation of the Various Uses of Borders.

To recapitulate the state of the art, we find that it is established and settled by the evidence that a one-piece transparent window envelope made from opaque paper like those described and claimed in the first Cohn patent, but without a border around the transparent windows, was described and disclosed to the world long prior to the date of the Cohn invention, as shown by the Brown 1862 patent; that it was old to print borders around three-color pictures, lithograph labels, and various kinds of printers' work generally, as shown in the Osborne 1900 art calendar, and testified to by a number of witnesses on the part of the defendant, whose testimony stands unquestioned and undisputed by a word of testimony on the part of the complainant; that it was old to print a border around a one-piece transparent window envelope made of transparent stock with the border covering the face of the envelope outside of the transparent window, as disclosed in the Busch 1896 patent; and that it was old to print borders around various transparent spaces made in opaque paper by the application of an oily preparation to the desired spaces and around holes or perforations in paper to give definition and distinctness to the same, as disclosed in the Tudor 1878 patent, the Hole 1894 British patent, the Leigh 1894 British publication, and the Smith & Browne 1901 British patent.

Contentions Based on the State of the Art.

In view of the fact, established and settled by the testimony of many witnesses on the part of the defendant, and not questioned or disputed by any testimony on the part of the complainant, that borders had, long prior to the invention of the first Cohn patent, been printed around the edges of three-color pictures, of lithograph colored labels, and of different

kinds of printers' work generally to cover up and conceal uneven, ragged or unsightly edges or margins, caused by the running and spreading of the colors or inks, or other causes, and that borders had been printed around the edges of various spaces in opaque paper rendered transparent by the application of an oily preparation for various purposes, which borders necessarily and inherently had the effect of obliterating, covering up or concealing any ragged, irregular and undesirable appearances in the edges of the transparent spaces caused by the running of the oily preparation, as well as to give definition and sharpness of outline to the matter included within the border, and a more ornamental and finished appearance to the work, we contend that no invention was involved in printing such a border on an envelope to cover up the spreading or running of the oil in making the transparent window in the envelope of the first Cohn patent, and to give definition to the enclosed space, and give it a more finished and ornamental appearance. The printing of borders on the envelopes of the first Cohn patent is an operation that falls within the printers' art. The work is done by printers. It is done on printing presses. An ink is used to print the borders. The whole operation is a part of the printers' art. The printing of the border to cover up or conceal the spreading or running of the ink or oil is precisely for the same purpose as the printing done to cover up or conceal the running or spreading of the inks or colors in the various instances of the use of borders established in the evidence. Not only are the uses analogous, but they are the same. A border that would cover up imperfections in the one case will cover up imperfections in the other. The method of applying the border in all these cases is the same and the function which the border performs is the same. The uses, objects, utilities, and advantages are the same.

The complainant Cohn on cross-examination admitted that the purposes, objects and advantages resulting from the printing of borders around pictures and other kinds of work, mentioned by the witnesses on the part of the defendant, were exactly the same as in the printing of the borders around the transparent windows of one-piece envelopes. We asked him a question framed—as to its last portion which we italicize—in the exact words of the witness Olson, in answering question 17, already quoted, as to the object of the border on his patented envelopes, and he stated that the same purposes and advantages existed in the printing of the border on envelopes that defendant's witnesses had assigned for the use of borders on pictures and other kinds of work. At page 183, we asked Cohn and he testified:

“X-Q. 156. In answering Q. 70, you say that you consider, the ring or border as of the utmost importance. The reasons for your opinion are because the presence of the border gives definition to the enclosed transparent space, covers up and conceals any objectionable or unsightly appearance caused by the irregular or ragged outlines resulting from the running or spreading of the transparency-producing preparation, and gives a more finished, or ornamental appearance to the job, or to express the matter more briefly, *the border is primarily to cover defects, and secondarily it enhances the beauty and value in some cases.* Is not this a brief summary of the objects, uses, and purposes of the border mentioned in the claim of the first patent sued on?

“A. It is.”

From the above, it is plain that all of the witnesses on both sides agree that the uses, objects and utilities of the border when surrounding a three-color picture, lithograph labels or printers' work generally, and when surrounding the transparent portion of a one-piece window envelope, are the same in every respect. At the most, therefore, and for the present

disregarding the prior patents, all that Cohn did was to print an old border around a desired piece or portion of a paper to cover up or conceal undesirable or unsightly appearances in its margin or outline, which, of course, would necessarily give definition or definiteness to the portion of the paper included within the border, just as others had been doing for years on many other kinds of work.

But for the present disregarding the use of borders on three-color pictures, lithograph labels, printers' art generally, and the borders shown in the Tudor, Hole, Leigh, and Smith & Browne patents, we think that, in view of the Brown 1862 and the Busch 1896 patents, alone, it is plain that no invention was involved on the part of Cohn. The Brown 1862 patent presented him with an envelope made of opaque material, with a portion or window made transparent. The Busch 1896 patent presented him with an envelope of transparent material, made from stock that was originally opaque, with a border printed around the transparent portion or window. They are both envelopes. The Brown envelope was without a border, and the Busch contained a border. All that Cohn did, and all that he could do, was to transfer the border from the one envelope to the other. It is precisely as though he had a Brown envelope in his hand and stood in the presence of a printer working at his press and printing borders on the Busch envelope. At the proper moment he inserts his Brown envelope into the press and prints the Busch border on it, without changing the press or ink, or method of operation. He now has the envelope of the first patent, without any change, subtraction or addition. It is plain, under the decisions of the courts in similar cases, that he has performed nothing but a mechanical act, and has not drawn upon nor employed the creative and originitive faculties, which are essential to an inventive act. He hardly exercised his rea-

soning faculties. What he did was an act of *imitation*. He printed the border around the window of the Brown 1862 envelope in the *same way* that he saw the printer doing in making the Busch 1896 envelopes. He simply followed the instructions and directions of the Brown and Busch specifications, with which the law conclusively assumes that he was fully acquainted.

The Brown and Busch patents may be regarded as letters directed to Cohn personally, as, indeed, they are open letters directed to everybody in the world interested in the making of envelopes; but we may regard them as letters directed from Brown and Busch to Cohn personally. The Brown letter instructs Cohn as to how to take a piece of opaque paper and make an envelope with a transparent window in it, and the Busch letters instructs him how he can make a border around the window. It tells him in express terms that he can make the border by printing with opaque coloring matter. He makes the envelope as Brown tells him and prints the border as Busch tells him. He has simply followed directions and instructions. As to these matters, we refer particularly to the deposition of the defendant's expert, Mr. Bond, extending from page 579 to page 582. In answering question 16 on page 580, Mr. Bond says that "The envelope of the first Cohn patent would result from taking the envelope of the Brown patent and printing thereon opaque matter as instructed by the Busch patent." In answering question 18 on page 582, he says that "No invention, in my opinion, was required to apply the instructions of the Busch patent as to making the face of the envelope outside of a transparent section opaque, and using such instructions in connection with the envelope of the Brown 1862 patent" We think it is plain that all Cohn did was to follow the instructions of the letter which Brown wrote to him in 1862 and the letter which Busch

wrote to him in 1896. They told him everything that he needed to do and how to do it. *The following of instructions* can never constitute invention. We think that the lack of invention is plain to demonstration.

The law is and for many years has been settled that the mere double use of a machine, device, idea, or invention, cannot be the subject of a patent. It is no invention to apply a well-known thing or idea to a new use. As Judge Story illustrated in an early case, there is no invention in taking a spoon that has been used for eating soup and use it in eating beans. As said by the Supreme Court in *Potts v. Creager*, 155 U. S., 606, it is no invention to take a mill for grinding coffee and use it for grinding spices. In like manner, whoever first employed a border for covering up and concealing ragged and unsightly edges in one kind of work made it free and open for use in all kinds of work where it would subserve the same purpose, so that it could never thereafter be the subject of a patent. The purpose for which Cohn says he uses the border, even if it be on different articles from those on which borders had been used before, would be insufficient to impart patentability to the envelope of the first Cohn patent.

In *Roberts v. Ryer*, 91 U. S., 157, the Supreme Court said:

“It is no new invention to use an old machine for a new purpose. The inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not.”

In *Pennsylvania v. Locomotive Truck Co.*, 110 U. S., 494, the Supreme Court, after reviewing the decisions, said:

“The application of an old process or machine to a similar or analogous subject, with no change in the

manner of application and no results substantially distinct in its nature, will not sustain a patent, even if the new form of result had not before been contemplated."

In *Blake v. San Francisco*, 113 U. S., 682, after quoting from the *Locomotive* case above, the Supreme Court, the italics being ours, said:

"It follows from this principle that where the public has acquired in any way the right to use a machine or device for a particular purpose, it has the right to use it for all the like purposes to which it can be applied, and no one can take out a patent to cover the application of the device to a similar purpose. . . . If the result claimed as new is the same in character as the original result, it will not be deemed a new result for this purpose. For instance, an automatic relief valve, used to relieve the pressure of *steam*, produces no new result in character when used to relieve the pressure of *water*, unless some further effect besides the mere relief of pressure is obtained. This qualification, therefore, will not affect the present case, because no new result in character is accomplished by the supposed invention of the plaintiff. Besides, it appears from the evidence that before Bailey's patent was applied for, relief valves were in common use, both on land and at sea. . . . It is no answer to this to assert that the application of a relief valve to a portable steam *fire-engine* is the invention of a new combination. There was no invention; the combination was already in public use on *steamships*. The application of the valve to a *similar* use on land was not a new combination or a new invention."

In *Lovell Manufacturing Co. v. Cary*, 147 U. S., 634, the Supreme Court, the italics being ours, said:

"The public cannot be deprived of an old process because some one has discovered that it is capable of producing a better result, or has a *wider range* of use than was before known. In *Smith v. Nichols*, 21 Wall., 112, it was held that a mere carrying forward, or new

or more extended application, of the original thought, a change only in form, proportions, or degree, the substitution of equivalents, doing substantially the same thing in the same way, by substantially the same means, with better results, was not such invention as would sustain a patent; and in *Roberts v. Ryer*, 91 U. S., 150, it was held that it was no new invention to use an old machine for a new purpose, and that the inventor of a machine was entitled to the benefit of all the uses to which it could be put, no matter whether he had conceived the idea of the use or not."

Not only was the use of a border on the envelope of the first Cohn patent, to define the window space and to cover up and conceal the spreading or creeping of the oil, merely a *double use* of the border in the same way and for the same purpose that it had been employed by three-color printers, lithograph-printers, and in the printing art generally, but it was a matter that naturally fell *within the line* of knowledge and work that a printer is habitually doing. The moment the necessity or desirability of a border appeared to a printer, he would, from his knowledge and experience, know exactly the remedy to apply. But it is not invention to exercise the skill and knowledge that pertains to one's trade, business, or profession. That is something that is to be expected and is entirely different from the origination of new ideas involved in the inventive act. In reference to the exercise of the knowledge and skill of one's trade or calling, the Supreme and Circuit Courts have repeatedly expressed themselves.

In *Pearce v. Mulford*, 102 U. S., 112, 118, the Supreme Court said:

"All improvement is not invention, and entitled to protection as such. Thus to entitle it, it must be the product of some exercise of the inventive faculties, and it must involve something more than what is obvious to persons skilled in the art to which it relates."

In *Vinton v. Hamilton*, 104 U. S., 492, the Supreme Court, the italics being ours, said:

“Neither a cupola nor a cinder notch is new. The use of a cinder notch for drawing off cinders from a *blast* furnace is as old as blast furnaces themselves. The function which the cinder notch performs in the process covered by Vinton’s invention is precisely the same for which it is used in a blast furnace. In smelting slag in a *cupola* furnace it was found that the molten cinder accumulated and floated on the top of the molten iron. The application to a *cupola* furnace, for the purpose of drawing off cinder, of the cinder notch in the *blast* furnaces to accomplish the same end, would occur to any practical man. When applied to a cupola furnace the same function was performed in the same way by the same means. In making this application there was no invention. *Pearce v. Mulford*, 102 U. S., 112. We are of opinion, therefore, that the application of a cinder notch to a *cupola* furnace for the purpose designated is neither patentable nor new, and that all the other parts of the process and the appliances covered by Vinton’s patent were old and well known long before the date of his alleged invention and the patent therefor.”

In *Atlantic Works v. Brady*, 107 U. S., 200, the Supreme Court said:

“The design of the patent laws is to reward those who make some substantial discovery or invention, which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an indiscriminate creation of exclusive privilege tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the

country, without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to law suits and vexatious accountings for profits made in good faith."

In *Hollister v. Benedict Mfg. Co.*, 113 U. S., 59, 73, the Supreme Court, the italics being ours, said:

"As soon as the mischief became apparent, and the remedy was seriously and systematically studied by those competent to deal with the subject, the present regulation was promptly suggested and adopted, just as a skilled mechanic, witnessing the performance of a machine, inadequate, by reason of some defect, to accomplish the object for which it had been designed, by the application of his common knowledge and experience, perceives the reason of the failure, and supplies what is obviously wanting. It is but the display of the *expected skill of the calling*, and involves only the exercise of the ordinary faculties of *reasoning* upon the materials supplied by a special knowledge, and the facility of manipulation which results from its habitual and intelligent practice, and is in no sense the *creative* work of that inventive faculty which it is the purpose of the constitution and the patent laws to encourage and reward."

In *Thompson v. Boisselier*, 114 U. S., 1, 11, the Supreme Court, the italics being ours, said:

"It is not enough that a thing shall be new, in the sense that in the shape or form in which it is produced it shall not have been before known, and that it shall be useful, but it must, under the constitution and the statute, amount to an invention or discovery."

"To refer only to some more recent cases, adjudged since these suits were decided below, this principle was applied in *Vinton v. Hamilton*, 104 U. S., 485, where a cupola-furnace being old, and a cinder-notch being old, and the use of a cinder-notch to draw off cinders from a blast-furnace being old, and the cinder-notch, in drawing off the cinders from the cupola-furnace, performs

the same function as in the blast-furnace, it was held that the application of the cinder-notch to the cupola-furnace would occur to any practical man, and that there was nothing patentable in such application.

“In *Hall v. Macneale*, 107 U. S., 90, a cored conical bolt, in a safe, with a screw-thread on it, having existed before, and also a solid conical bolt, it was held to be no invention to add the screw-thread to the solid conical bolt.

“In *Atlantic Works v. Brady*, 107 U. S., 192, 200, it was said, that it is not the object of the patent laws to grant a monopoly for every trifling device which would naturally and spontaneously occur to any skilled mechanic or operator, in the ordinary progress of manufactures.”

In *Thatcher Heating Co. v. Burtis*, 121 U. S., 286, 294, the Supreme Court said:

“It is admitted that what Thatcher did, and all that he did, was to transfer this well known fuel magazine from its use in an out-standing base-burning stove to a fire-place heater, equally well known and in common use as to its arrangement, construction, position and mode of operation. When this fuel magazine was thus *transferred from one kind of stove to another*, in its new situation it performed precisely the same function with respect to the fuel and the fire, as it had always been accustomed to perform in its old place, and the fire-place heater into which it was thus newly placed, so far as the generation and transmission of heat and heated air are concerned, operated precisely as it had habitually done before.”

In *Root v. Sontag*, 47 Fed., 311, Judge Hawley, of California, said:

“From this reference to the drawings, specifications, and claims in the patent it appears that on the end of the shuttle body a flat plate was formerly attached by means of a screw or bolt, driven or screwed into the end of the shuttle body; that the constant movement of the shuttle was liable to cause the wood to split, and the plates to become loose. The improvement in this respect

is made by extending the screw through the end of the shuttle, and placing a nut on the end of the bolt of the screw. It must be admitted that this is an improvement upon the former methods in common use, in this; that it holds the plate or tip more securely to the end of the shuttle, and prevents the wood from splitting as frequently as it otherwise would. But does this improvement involve any mechanical skill? Can the improvement, as made, be called invention? The use of a bolt with a nut screwed on the end of it for the purpose of holding or fastening things together is not only well known to mechanics, but is a matter within the general knowledge of the public. When from any cause, it was discovered that the tip on the end of the shuttles would frequently become loose, or the wood split, what would be more natural than to suggest the driving of the bolt through the end of the shuttle, and placing a nut on the end of the bolt, and screw it up tightly? The shuttle, as thus constructed, performs no new function. It operates precisely as it did before the improvement was made. The improvement is superior to the old methods in the mechanical structure of the shuttles, but is not, in my opinion, of such a character as required inventive skill."

In *Haughey v. Lee*, 48 Fed., 384, Judge Butler, of Pennsylvania, said:

"In view of the other devices shown—about whose existence there is no question—it seems clear that the slight change in form which the plaintiff made did not require invention. He simply altered the 'striker' from a horizontal to a perpendicular position. He found it standing out laterally, and loosened it so as to hang. This was all. Surely no invention was required to do it. Any mechanic to whose line the work belonged, or indeed any handy person, though not a mechanic, could do this. The idea or conception that this change might be beneficial, was not patentable. The question is simply, was invention required to make the change? In my judgment it was not. The kicking device exhibited a method of doing it. This device indeed required nothing but shortening the chain to make it correspond in every essential respect with the plaintiff's. Applying this to a horse in

motion, instead of one standing in his stall is not even a new use. If new it would be analogous to the old. Patents are constantly overturned for want of invention, where its absence is not so clear. The later volumes of reports are full of such cases; eight are contained in the last issue—132 U. S. It is sufficient to cite a few of them. *Hollister v. Manufacturing Co.*, 113 U. S., 59, 5 Sup. Ct. Rep., 717; *Thompson v. Boisselier*, 114 U. S. 1, 5 Sup. Ct. Rep. 1042; *Pennsylvania R. Co. v. Locomotive Engine Safety Truck Co.*, 110 U. S. 490, 4 Sup. Ct. Rep. 220; *Bussey v. Manufacturing Co.*, 110 U. S. 131, 4 Sup. Ct. Rep. 38; *Gardner v. Herz*, 118 U. S. 180, 6 Sup. Ct. Rep. 1027; *Weir v. Morden*, 125 U. S. 98, 8 Sup. Ct. Rep. 869; *Holland v. Shipley*, 127 U. S. 396, 8 Sup. Ct. Rep. 1089; *Aron v. Railway Co.*, 132 U. S. 84, 10 Sup. Ct. Rep. 24; *Day v. Railway Co.*, 132 U. S. 98, 10 Sup. Ct. Rep. 11; *Roemer v. Bernheim Co.*, 132 U. S. 161, 10 Sup. Ct. Rep. 45.”

In *Kilbourne v. Bingham Co.*, 50 Fed., 699, Judges Jackson and Swan, in the Circuit Court of Appeals for the Sixth Circuit, said:

“The appreciation and utilization of the efficiency of old methods, means, and material for the manufacture of domestic, mechanical, and agricultural wares ‘does not spring from that intuitive faculty of the mind put forth in the search for new results or new methods creating what had not before existed or bringing to light what lay hidden from vision; but, on the other hand, is the suggestion of that common experience which arose spontaneously, and by a necessity of human reasoning, in the minds of those who had become acquainted with the circumstances with which they had to deal.’ *Hollister v. Manufacturing Co.*, 113 U. S. 72, 5 Sup. Ct. Rep. 717.

“It is not enough that the new manufacture, because of the fitness of the material to the purposes of the article, has obviated innumerable objections inherent in prior manufactures and superseded them in the trade. It must possess an advantage and novelty in form or construction beyond the ability of a mechanic of ordinary skill and intelligence, or be the resultant of means or methods devised by the maker. ‘The law,’ says Judge

Woodruff in *Smith v. Ellicott*, 9 Blatchf. 403, 'gives no monopoly to industry, to wise judgment or to mere mechanical skill in the use of known means, nor to the product of either, if it be not new. These are within the proper field of competition, and open to all. In general, they will in that competition be justly appreciated, and will command their proper remuneration if usefully employed. It is invention of what is new, and not comparative superiority or greater excellence in what was before known, which the law protects, and it is that alone which is secured by patent'."

We have quoted from the above cases simply as samples of the innumerable decisions that fill the reports where the courts have invalidated patents on the ground that they were lacking in the quality or ingredient of invention. To be valid, a patent must be for a device, process, method, or idea, containing three essential and indispensable characteristics; it must be new; it must be useful; and it must involve *invention*, which latter characteristic the Supreme Court, in the *Hollister-Benedict* case, says is the "creative work" of the inventive or originating faculties. The envelope of the first Cohn patent is certainly lacking in the third characteristic or ingredient essential to make it a patentable subject, to say nothing of the others.

When Cohn made the envelope of his first patent, he had, in legal contemplation, a complete and detailed knowledge of everything which had been done by others bearing on the subject. Whether he had actual knowledge or not, we need not stop to inquire, as the fact of actual knowledge is wholly immaterial. The law conclusively and indisputably presumes that he had knowledge, and charges him with the consequences of such knowledge. Not only this, but he is to be considered and judged precisely *as if he had been present in person* when all of the prior pertinent works were being done, had stood by and observed how they were done, and had the re-

sults of their work in his presence and spread out for his visual inspection. We will quote from two or three cases as to this legal presumption.

In *Crompton v. Knowles*, 7 Fed., 203, Judge Lowell, of Massachusetts, in 1881, said:

“It is a presumption of law that all mechanics interested in upholding or defeating a patent were fully acquainted with the state of their art when they took out their patent, or when they built their machine. This presumption is founded upon a policy like that which imputes to all persons charged with crime a knowledge of the law. It is necessary to the safe administration of justice. Each party may then be assumed to have borrowed from the other whatever was actually first invented and used by that other.”

In *Allen v. Steele*, 64 Fed., 796, Judge Buffington, of Pennsylvania, after quoting from Judge Lowell, as above, said:

“We are of decided opinion that the substance of Allen’s device was so anticipated in Shippen’s that to devise and construct the former, with the latter before one’s eyes—which, in contemplation of law, we must assume Mr. Allen had—was the work of an adaptive mechanic, and not the province of an inventor. All the improvements claimed were, as compared with Shippen’s device, within the category of degree.”

In *Mast, Foos & Co. v. Stover Mfg. Co.*, 177 U. S., 493, the Supreme Court said:

“Having all these various devices before him, and whatever the facts may have been, he is chargeable with a knowledge of all pre-existing devices, did it involve an exercise of the inventive faculty to employ this same combination in a wind-mill for the purpose of converting a rotary into a reciprocating motion. . . . In determining the question of invention, we must presume the patentee was fully informed of everything which preceded him, whether such were the actual facts or not.”

To similar purport are *Loom Co. v. Higgins*, 105 U. S., 585; *Bates Refrigerator Co. v. Gillett*, 31 Fed., 816; *National Car Brake Shoe Co. v. Terre Haute Car Co.*, 19 Fed., 520; *Boyden v. Burke*, 14 How., 582, and other cases.

In view of the settled principle of law that one who claims to have made an invention is to be considered and judged as having an actual knowledge of everything which preceded him, including the methods and processes employed in their making, and in making his own invention as working in the actual physical presence of the accumulated devices of the preceding art, and of everything having a bearing on the nature, quality, and character of his act, we must consider Cohn in getting up the envelope of his first patent as being fully acquainted with and familiar with the use of borders by three-color picture printers, lithograph label printers, and printers generally, and the use of borders on one-piece transparent window envelopes, as described in the Busch 1896 British patent, and as having seen them applied, and as having them present before his physical eye. We are thus able to analyze and weigh his act. He puts on an oily preparation to make a portion of his paper or blank transparent. He observes the oily preparation penetrate into and permeate the tissue and fibre of his paper. He sees that the oil spreads or creeps beyond the boundaries of the predetermined space, so as to present a ragged or unsightly or undesirable edge or margin. He looks at the three-color pictures, where one of the colors for some reason overlaps or spreads beyond the others. He sees that to cover up or remedy the unsightly or undesirable edge or margin a border has been printed around and over the edge, and that it thus gives definition to the picture and covers up and conceals the unfinished or undesirable appearance of the edges. He looks at the lithograph labels and he sees that a bor-

der has been printed around and over their margins or edges, and that it thus gives sharpness of outline or definition to the matter contained within the border, and obliterates or covers up any ragged or unsightly appearance in the edges, caused by the spreading or misplacement of the ink. He looks at the examples of printers' work, where a border has been printed around any desired work or matter, and that it thus gives sharpness or definition or outline to the matter contained within and covers up and conceals any spreading or running of the ink. He looks at the envelope described in the Busch 1896 patent, and sees that he prints a border over its face outside of and around the window space, and that it thus covers the non-address space of the envelope and gives definition to the window space. And in legal contemplation he *sees* all these men *at their work* understands *what* they are doing, *how* they do it, and *why* they do it. He sees, as a matter of necessary reasoning—for such must have been the largest extent of the mental operation—that a similar border printed around the transparent portion or window of his envelope blank will serve his purpose, will give definition to the window, will cover up and conceal any bleeding or running of the oil, and will in short, exactly serve his purpose and do the work and give the finished results that he sees are desirable. He therefore, prints a border around the window of *his* envelope. He has originated nothing. He has added nothing to the knowledge of the world. He has contributed nothing to the printing art. No new or original idea has been evolved. He has simply *appropriated* and applied the *old expedient* used for a generation for precisely the same or similar purposes, with no change in the *manner* of application of the border, and no *results* substantially *different* from what had been secured by the use of borders before. We can well say of his act what the Supreme Court said

in the case of *Lovell Mfg. Co. v. Cary*, 147 U. S., 636, where, in discussing the case before them, they said:

“The present case is covered by the cases of *Vinton v. Hamilton*, 104 U. S. 485; *Stow v. Chicago*, 104 U. S. 547; *Locomotive Truck* case, 110 U. S. 490; *Blake v. San Francisco*, 113 U. S. 679; *Thompson v. Boisselier*, 114 U. S. 1; *Miller v. Foree*, 116 U. S. 22; *Dreyfus v. Searle*, 124 U. S. 60; *Brown v. District of Columbia*, 130 U. S. 87; *Aron v. Manhattan Railway*, 132 U. S. 84; *Watson v. Cincinnati, Indianapolis &c. Railway*, 132 U. S. 161; *Marchand v. Emken*, 132 U. S. 195; *Royer v. Roth*, 132 U. S. 201; *Hill v. Wooster*, 132 U. S. 693, 701; *Burt v. Ivory*, 133 U. S. 349; *Howe Machine Co. v. National Needle Co.*, 134 U. S. 388; *Florsheim v. Schilling*, 137 U. S. 64; *Consolidated Roller Mill Co. v. Walker*, 138 U. S. 124; *Ansonia Co. v. Electrical Supply Co.*, 144 U. S. 11; *Ryan v. Hard*, 145 U. S. 241. The principle deducible from those cases is that it is *not a patentable invention to apply old and well known devices and processes to new uses*, in other and analogous arts. The decision in *Ansonia Co. v. Electrical Supply Co.*, *supra*, is very pertinent. In the opinion in that case, the cases were reviewed which established that the application of an old *process* or machine to a similar or analogous subject, with no change in the *manner* of application, and no results substantially *distinct* in its nature, will not sustain a patent, even if the new form of result had not before been contemplated.”

To apply the principle of the above decision to the case in hand, it involved no invention for Cohn to take the border used on three-color pictures, on lithograph labels, on the Busch 1896 envelope, and in the printing art generally, and apply it to his envelopes where it performed the same work—surrounded a desired section or portion of work—secured the same results—gave definition to the work included within the border, and covered up and concealed imperfections around the outer edges or margins—in the same way—by the printing and superposition of an opaque coloring matter over the portion desired to be concealed. Par-

ticularly is this so when Cohn neither originated, created, nor made use of any new idea, but simply bodily *appropriated* an idea and a process that had been used for many years in similar analogous cases. The instant the need became apparent the remedy used for similar cases suggested itself. The combination that resulted was the old combination, so far as the essentials are concerned. Both in Cohn and in the old art, paper furnished the foundation for the work; both in Cohn and in the old art, a predetermined section or portion of the paper had a preparation applied to it, as ink or colors that ran or spread; both in Cohn and in the old three-color and printers' art, the edges or margins of the predetermined portion were ragged, unsightly, or undesirable in appearance, owing to the spreading or overlapping of the material at the edges or margins of the predetermined space; both in Cohn and in the old art, including the old 1896 Busch patented envelope, opaque coloring matter was printed around the predetermined space to give definition to it and, in most of the cases, to cover up and conceal imperfections or defects in the edges or margins, which produced an unsightly or undesirable appearance; and both in Cohn and in the old art, the resulting effect was to give a more finished or ornamental appearance to the work, without adding anything to its essential utility—the performance of its *function* as an envelope, in Cohn's case. We think it is preposterous to impute any inventive quality or character to the work done by Cohn in printing a border around the window of the envelope of his first patent.

The Question of Invention as Viewed by the Patent Office.

We find, by reference to the proceedings in the Patent Office in the procuring of the first Cohn patent, that there was great difficulty in securing its allowance, on the ground that it was lacking in invention. When the application was filed, November 8, 1904, it contained nine (9) claims, quoted at page

590. The first three claims related to the subject-matter of the present claim as it appears in the patent. The first claim, as originally presented, made no reference to the border, but the second and third claims included it as an element. The second claim, as originally presented, may be quoted as an example:

“2nd. An unpunctured envelope of non-transparent stock, to a portion of which a preparation has been applied to render such portion transparent, and a colored or tinted border surrounding said transparent portion.”

When the claims came to be examined, the Examiner rejected the above claim, together with the first and third, as being substantially anticipated in the Busch British patent of 1896. In the letter written by the Examiner December 22, 1904, at page 593, he said:

“Claims 1, 2 and 3 are rejected as being substantially anticipated in British Patent to Busch 11,876, July 4, 1896, in view of the immemorially old practice of country boys in making paper lanterns of greasing the whole or a part of the paper to render the lantern more translucent. The coloring of the ‘border’ may be regarded as of no patentable significance in the claims in view of either of the British patents to Whitty 2,899, Oct. 6, 1869, and Colby, 1,895, January 31, 1900.”

In reply to this action by the Office, Colm amended his case January 6, 1905, page 596, by striking out the original claims and inserting two new claims, of which the second was worded as it now appears in the patent. At the same time a sample envelope was filed, and the statement made that “In Figs. 2 and 4 it is assumed that the entire face of the envelope is colored around the window opening; while in Figs. 1 and 3 there is only a border corresponding to the sample inclosed.” This corresponds to the statement in the patent, to which we have already called attention, to the effect that the border is

not to be understood as *merely* a narrow ring around the window but may cover a border that extends *entirely* over the face of the envelope from the edges of the window to the edges of the envelope—the *kind* of a border that Busch described.

In reply to the amendment made as above, the Examiner, February 13, 1905, at page 598, again rejected the claims as lacking in patentable invention. In the letter of rejection, the Examiner said:

“The claims presented by amendment of January 6, 1905, are rejected upon the state of the art of record. It is a matter of common knowledge to make envelopes of transparent material. It is a matter of common knowledge to make envelopes having a transparent portion and an opaque portion. It is a matter of common knowledge to render paper or envelopes transparent by treating such paper or envelopes with paraffine or grease. Applicant’s so-called border does not differ except in design from the balance of the opaque portion of his envelope. There is believed to be nothing whatever patentable in this application.”

In reply to this rejection on the part of the Office, applicant, on February 20, 1905, wrote a letter in which he stated, at page 599, that he admitted “that it is a matter of common knowledge to make envelopes of transparent material”; and also admitted “that it is a matter of common knowledge, broadly, to make an envelope of a generally opaque body having a transparent window or opening”; and also admitted that it was “not new to render paper transparent by treating it with grease,” but in which he insisted that “This border is new, and the Examiner has shown no reference for it.” Applicant insisted, therefore, that his claims were patentable.

To the above argument the Examiner, on March 28, 1905, replied to applicant, saying, at page 602:

“Notwithstanding applicant’s argument the claim is still deemed to be unpatentable over the references of record and for the reasons stated. The claims are therefore each a second time and finally rejected.”

Thereupon, on February 28, 1906—eleven months after the above rejection—an appeal was taken to the Board of Examiners-in-Chief, and the claims considered by the three Examiners constituting such Board. Before the case, however, was sent up to the Board of Examiners-in-Chief, the Examiner, on March 6, 1906, wrote another letter to the applicant, in which he cited the Cohn English patent No. 14,478, of June 27, 1904, and the Brown 1862 patent, No. 36,393. In reply to this letter, the attorney for Cohn, on March 13, 1906, wrote a reply saying, among other things, that the Cohn British patent was a patent to the applicant and was not for the same invention as the one claimed in this application, and that the Brown patent was not cited in rejection, and, therefore, he refused to treat it as a reference. Thereupon the appeal was proceeded with. In such appeals it is the practice for the Examiner to file a written statement with the Board, giving his reasons for his rejection, and on March 22, 1906, the Examiner filed his statement before the Board. In his statement the Examiner sets out what Cohn described in his specification and what he was claiming.

The Examiner, in considering the Cohn and Shipp British patent—the patent which Cohn claimed was his own patent and invention—among other things, at page 608, said:

“It is noted that the British patent to Cohn & Shipp does not set forth how the transparent portion of the envelope is formed. The patent to Brown states that the transparent portion or window in his envelope may

be made by the same means or substance as is employed for making tracing papers, &c. To print a certain border with colored ink or pigment around the transparent portion of Brown's envelope in the same way that Cohn & Shipp print a border around their transparent portion would not involve invention."

In his statement the Examiner, in discussing the Busch British patent, at page 609, said:

"The British patent to Busch above cited discloses an envelope having a transparent window comprising a portion of the front of the envelope surrounded by an opaque border, such border being formed by 'printing with opaque coloring matter.' Thus it is clear that this patent anticipates every letter of Claim 1. Busch does not set forth that he forms his transparent portion by the application of paraffine or the like. Such procedure is clearly set forth by Brown, however. *To print a colored border with opaque coloring matter around the transparent portion of Brown's envelope would not constitute a new invention.*"

Thereupon the attorney for applicant filed an argument before the Examiners-in-Chief, in reply to the Examiner's statement, in which he insisted that "The novelty of this invention is in providing a colored or tinted border surrounding the window portion which has been made transparent by some preparation which, because of its oily character, will creep into the surrounding opaque stock and give a ragged and unsightly outline to the transparent window." The attorney, in his reply to the Examiner's statement, at page 613, also says:

"The British patent to Cohn & Shipp, 14,478, June 27, 1904, is applicant's own invention; it is identical with applicant's other pending case filed May 9, 1904, Serial No. 207,082. It does not disclose, or even remotely suggest, the present invention, for which reason applicant has not mentioned his British patent in the oath to the present case. . . . The British patent to applicant does not use and does not describe a border surrounding

a window which has been made transparent by a preparation which will 'creep' into the opaque stock. The British patent describes an envelope made of substantially transparent stock, the back of the face of which is rendered opaque by some coloring matter, leaving the window uncolored. As there is used no preparation which will 'creep' into the opaque stock, there is no use for the surrounding border to conceal such creeping and give definition to the window opening."

In reference to the Busch English patent, the attorney for applicant, at page 615, among other things, said:

"The remaining reference, British patent to Busch, 11,876 of 1896, has a portion or the whole of the envelope transparent. The front is transparent while the back is opaque, or a portion only of the front may be transparent. The patentee says, 'The desired contrast or difference may be produced either by choosing two different kinds of paper, or by printing with opaque coloring matter applied to a portion of the envelope.' The 'two different kinds' of paper means pasting one part to the other, and the printing with coloring matter must refer to printing on a normally transparent paper."

The Board of Examiners-in-Chief came to the conclusion that there was no invention in the claims. All three of the Examiners-in-Chief concurred in this conclusion. They filed an opinion April 18, 1906, in which they stated their reasons. Among other things, at page 616, they said:

"The alleged invention relates to the class of envelopes in which the address is not written on the envelope itself but on a paper inside of the envelope and is read through the transparent surface thereof. The appellant starts with an opaque material and by treating a portion thereof makes a transparent window therein at the point where the address is to appear. It is said that the preparation used in treating the material to make the transparent window cannot be applied in such way as to make a clear cut and regular outline for the window but will creep and make an irregular and rough outline.

To hide this rough outline and leave a transparent window of symmetrical and regular shape the appellant applies a colored border to the surface around the window. The supposed invention here resides in placing this border around the window."

The Examiners then quote from the Brown 1862 patent, and, on page 618, say:

"It is obvious that by following the directions first stated an envelope of the same construction as the appellant's is produced. The appellant has merely added a colored border for the purpose of ornamentation."

And this was and is exactly what it was and is for, and nothing else. Ornamentation—to make the envelope look better—"for the purpose of obliterating or concealing the effects of the tendency of the said preparation to creep into the surrounding opaque stock," to use the words of the claim. The border does not *prevent* the creeping but merely *obliterates* or *conceals* the creeping. The border, as the Examiners-in-Chief say, is for the purpose of ornamentation.

The Examiners-in-Chief then proceed to consider the Cohn and Busch British patents, and say:

"In the patent to Cohn *et al.* is described an unpunctured envelope having a transparent window surrounded by a portion to which dark colored ink has been applied. This is also true of Busch. The border in this case seems to extend to the edge of the envelope, but it is nevertheless a contrasting border. Its purpose is, like that in the appellant's case, to have a transparent window regular in outline and of the shape desired. If the transparent material extends to the edge of the envelope it is necessary to extend the ink covered surface to the edge, whereas if the transparent portion does not extend so far it is not necessary to extend the ink so far. It may, however, be applied in the shape of a border sufficiently wide to cover the edges of the transparent portion. The purpose, function and idea of means seems to

be the same in both cases. The rough edges of the transparent portion would be concealed just as well by coating all of the balance of the envelope with dark colored ink, and the only purpose of substituting a narrower border seems to be to get a different artistic effect. There is no mechanical advantage or utility in it. It is a mere matter of design.

“The claims are lacking in patentable novelty in view of the references cited and therefore the decision of the Primary Examiner is affirmed.”

An appeal from the decision of the Board of Examiners-in-Chief was thereupon taken to the Commissioner of Patents, and a decision in favor of applicant obtained, whereupon the case was referred to the Primary Examiner, and on August 6, 1906, it was amended by applicant by canceling the first claim, so as to leave only the claim which now appears in the patent. Thereupon the application was formally allowed and the patent issued.

From the foregoing it appears that four of the five judges in the Patent Office who passed on the matter were of the opinion that there was nothing of patentable invention in the Cohn envelope. These four judges—the Primary Examiner and the three Examiners-in-Chief—are required by the Statute to be men of *mechanical, legal and scientific* attainments, while no such requirement is made as to the Commissioner. The Commissioner’s office is largely *executive*, and the President is free to appoint any one, whether possessing legal, scientific, or mechanical experience and attainments or not, to the position of Commissioner. As to the others, however, the Act of Congress is particular as to their qualifications and attainments. Section 482 of the Revised Statutes, in defining the duties and qualifications of the Examiners-in-Chief, says that “The Examiners-in-Chief shall be persons of *legal* knowledge and *scientific* ability.” The Primary Examiners are appointed by the Secretary of the In-

terior, after they have satisfactorily passed rigid technical, mechanical, and scientific examinations. The Commissioner of Patents, however, may be anybody that the President may see fit to appoint, and there is no requirement that he shall have "competent *legal* knowledge and scientific ability," nor any other kind of knowledge or ability.

When we come, therefore, to consider the *weight* that should be attached to the opinions and decisions of the Examiners and Examiners-in-Chief and the Commissioner, upon questions of invention, novelty and patentability, we think there is no question as to whose opinions should have the greatest consideration and weight. In this case, four men of special knowledge, acquirements and ability, acting as judges, united in saying that the envelope of the first Cohn patent contains nothing of invention or patentability, while the Commissioner alone is of a different opinion. It is to be remembered that these proceedings are *ex parte*. On hearings before the Board of Examiners-in-Chief and the Commissioner, nobody appears to orally explain and present the matter on behalf of the public. Only the written statement of the Primary Examiner is present. On the other side, however, the applicant may be represented by his attorneys to make oral presentation and arguments. They evidently succeeded in this case in persuading the Commissioner to pass the question on to the courts to determine should litigation ever arise under the patent.

We submit and insist that great consideration and weight should be given to the opinion of the Primary Examiner and of the Examiners-in-Chief in their conclusions in this case, and that but little weight or consideration should be given to the conclusion of the Commissioner, who has thrown upon the court the responsibility of deciding as to the validity of the Cohn patent.

The conclusion of the Examiner and of the Examiners-in-Chief is in harmony with the views expressed by the various witnesses for the defendant, reinforced as they are by grounds and reasons that were not presented to the Office on the *ex parte* proceedings leading to the issuance of the first Cohn patent. The Office was not furnished with proofs as to the use of borders by three-color picture printers, or lithograph label printers, or of printers generally, to cover up and conceal unsightly, rough, or undesirable appearances in the edges and margins of work of various kinds, due to the misplacement of the colors or the running or spreading of the inks employed. Nor were they furnished with exhibits or illustrations of such work, showing the use of borders accomplishing the same purpose and object as they do in the case of the envelope of the first Cohn patent. Nor were they supplied with the reasons and decisions that are now placed before the court for showing the lack of invention and patentability in the Cohn envelope.

Yet, in the absence of all of these cogent and convincing reasons for finding that there is nothing of inventive quality or character in what Cohn did, the Examiner and the Examiners-in-Chief came to the conclusion, on the meager showing before them, that there was no invention or patentable novelty in the envelope of the first Cohn patent. Much greater reason is now presented for a similar conclusion on the part of the court.

In vain we search the opinion of the learned judge who decided the case below for any consideration of the question of *invention* over the state of the art which we have explained above. We either failed to make our position clear to the learned judge, or else when he came to decide the case he in some way overlooked the defense of lack of invention in view of what had been done and disclosed by the prior art; at least he failed to specifically refer to and dis-

cuss this defense. His whole opinion, so far as the validity of the first Cohn patent is concerned, appears to have been directed to the defenses of *anticipation* and lack of *novelty*, which we have seen is entirely separate and distinct from the defense of lack of *invention*. We therefore confidently submit to this court our belief and contention that the first Cohn patent exhibits nothing of invention in printing the border around the transparent window of the Brown 1862 patent, in view of the numerous uses of borders around various matters on paper used for different purpose, established by the evidence, including the printing of a border around the window space of an *envelope*, as disclosed and described by Busch in his 1896 British patent.

It may be well, before closing this branch of the case, to refer to one matter which we regard as of no importance or consequence but which counsel in the argument below seemed to regard as worthy of discussion and which he strongly pressed upon the attention of the court. The fact has already been referred to that on December 15, 1903, we wrote a letter to Mr. Regenstein, which is quoted at page 268 of the record. This letter was in relation to a one-piece window envelope in all respects like that claimed in the first Cohn patent, with the exception that it had no border around the window. This envelope was exhibited to us by Mr. Regenstein and Mr. Reese, who was associated with him, and we were asked whether we considered that such envelope would infringe the Callahan patent for a two-piece window envelope, appearing at page 725, which calls for an envelope having "a display opening therein having transparent covering"—an envelope in which a piece of opaque paper is cut out and a separate piece of transparent paper pasted over the opening. In our letter we advised Mr. Regenstein that the envelope shown us did not infringe the Callahan patent, and also that we considered that the envelope was patentable over the envelope claimed in the Callahan patent. Coun-

sel for complainant argued that if we considered the envelope without a border as involving invention and as being patentable, much more should we consider an envelope having a border as containing invention and as being patentable. The conclusion that counsel attempts to draw is in no way justified by the premises.

It will be noted that our letter merely says that "We consider that the envelope which you showed us is patentable over *the* envelope claimed in the *Callahan* patent"—a two-piece transparent window envelope. Undoubtedly, were it not for the state of the art afterwards disclosed when Reese applied for a patent on the *envelope* itself, and by the research of counsel in this case, as disclosed by the evidence, a *one*-piece transparent envelope would be patentable over a *two*-piece window envelope—over the envelope of the *Callahan* patent. In pursuance of our advice, Reese made an application for a patent on the *one*-piece transparent window envelope, which application is printed at page 652 of the record. It developed, however, that a patent for a similar envelope had been issued to Brown in 1862—something that we knew nothing about at the time our letter was written. The Reese application was rightly rejected on the Brown patent, as appears at page 67, and no patent ever issued on the Reese application, because the Reese envelope and the Brown envelope were the same. The Brown patent removed every vestige of invention and patentability from the one-piece window envelope about which our opinion was given, and on which Reese made his application, because it thus appeared that the Reese envelope was old.

We apologize for referring to so trifling a matter,—a matter so irrelevant and easy of explanation—but our justification is in the fact that counsel for complainant laid great stress on it in his printed argument in the court below.

The Preparation Instead of the Border Took Time and Work.—The Border Was Easy.

Both Mr. Cohn and Mr. Regenstein spent a lot of time in getting their envelopes into the market. In both cases, however, this time was principally required in getting a satisfactory oily preparation for producing the transparent spaces or windows. For instance, at almost the end of his deposition, Cohn was asked at page 208 and testified:

“R-D. Q. 195. You have testified to the placing on the market in 1904, some 10,000 envelopes used by the Zellerbach Company and embodying your invention. Can you state the amount of time and the amount of money you expended in bringing your invention to the point of development represented by those commercial envelopes which you have heretofore identified as corresponding to Exhibits L and M?

“A. I can. I worked continuously and persistently for over a year, beginning some time in 1903 and ending with the production of these 10,000 envelopes in 1904, putting in many nights, many Sundays and several holidays. I never at any time desisted from my efforts, but kept on patiently sticking to the object I had in mind, never quitting until I accomplished the object I sought. During this period I expended some \$3,000, which may not appear to be a great sum to some people but meant a vast amount to a man of my means. This money I used for various purposes such as the purchase of different chemicals and oils used in making my preparation; also for ink and paper of numerous natures and consistency. Part of this money was also used in paying for labor which was generally at a high rate on account of the work being done on what is termed as ‘overtime.’ I also paid to chemists various amounts for work done at my request. I frequently found that after spending much time and money on a certain preparation that the same was useless for my purpose and it was necessary for me to start over again. During this period I did a little work on the envelope described in my abandoned application dated May 9, 1904, but the expenditure of time and money on this particular feature was very trivial.”

The witness Tooker, who was foreman of the press-room of F. H. Abbott & Co., and who worked with Mr. Cohn, also lays great stress on the difficulty of getting the desired and requisite material for producing the transparency. In answering question 6, among other things, at page 236, he said:

“All of the mixture for transparency was supplied by Mr. Cohn. There was quite a bit of trouble in getting the printing-press to handle these different preparations, which required a good deal of time and thought. We had a great many difficulties to overcome, *the main one being to get the desired transparency*, which he finally succeeded in getting.”

Again, in answer to question 31, the witness Tooker explained the necessity of thoroughly cleaning the press before applying the oily preparation. Among other things, at page 244, he said:

“In washing up for the preparation it became necessary to go over the press again and again and the rollers more particularly. The least bit of color on the press or rollers had a tendency to discolor the transparency and make it darker or opaque. It became necessary in using this preparation to make the press absolutely, or as near as possible, clean. We found another difficulty in using some of the preparations, and it became necessary in order to make the preparation flow as freely as was necessary to use gas stoves under the press, heating the plate and making the preparation run out smoothly. We finally got these things so that the preparation run perfectly. The transparency that we reached in the early stages was inclined to be more dirty and mottled, not smooth.”

In like manner, Mr. Regenstein spent the great bulk of his time and money during the experimental stages in perfecting the transparency producing materials so that they would not only make a transparent window, but also make it satisfactorily. In answer to question 79, at page 278, he said:

“A. After the border matter was settled in January,

1904, we gave our attention, up to this day, to the perfecting of the transparency of the window.

“Q. 80. Do I understand that the matter of improving and perfecting the transparent portion of the envelopes was a difficult matter?

“A. A very difficult matter.

“Q. 81. Without going into details as to the preparation of the oil or whatever it is that you used, you may state what difficulties you found in that matter, if any.

“A. The difficulties in preparing the windows properly were found on account of atmospheric conditions, non-elastic oils, and various other causes.

“Q. 82. You may state what the fact may be as to losses of envelopes through the sticking of the sides together, where the transparent windows were formed, or matters of that kind.

“A. We have found and experienced in 1906 that the transparent window would stick to the back of the envelope, and have spoiled at least forty to fifty million envelopes in that matter.

“Q. 83. You may state whether your company has much money invested in the business of manufacturing transparent window envelopes, or has spent much money for that purpose, from first to last.

“A. The loss to our company in perfecting envelopes is over \$100,000.

“Q. 84. How far do you consider that your company has brought the manufacture of these transparent envelopes to a condition where they are practical and satisfactory to the public?

“A. Our envelope is now considered the most perfect transparent envelope in existence, and has a sale in this country as well as in foreign countries.”

Both Cohn and Regenstein found the great difficulty was in getting a satisfactory material for producing the transparency—one that while producing the transparency would be inexpensive and unobjectionable in other respects. The application of the *border* was purely a mechanical act. Anyone familiar with the printing art would find that a simple matter. Mr. Regenstein, in answering question 52, at page 271, said:

“As soon as we found out early in January that the

oil was found to bleed some, as old printers, we decided that we had to go back to our old trick and print a border which was intended to cover such bleeding of the oil which could not be prevented.”

Again on page 294 he was asked and testified:

“Q. 138. When you saw that the oil ran or bled into the paper, how long did it take you to know what to do to remove the difficulty?

“A. The time was so short that I cannot state the same, since it was simply a thought.

“Q. 139. Did you do anything more than apply the knowledge you had of the printing art ~~as~~ to the situation?

“A. I did not.”

The witness Sauerman, who was the pressman that helped print the envelopes in January, 1904, was asked, on page 348, and testified:

“Q. 14. What did they do with the paper after you had applied the oil, if you know?

“A. We found that upon applying the oil to the paper it crawled or spread; so we made a ring plate and printed it on the paper.

“Q. 15. What did you print it on the paper for?

“A. To cover up the unevenness of the oil.”

The witness Wien, who also assisted in printing the envelopes in January, 1904, was asked, on page 356, and testified:

“Q. 16. When did you first see, if you did see, a ring or border printed around the transparent portion formed by the oil?

“A. On the same day that the oil was put on the envelope. In January, 1904.

“Q. 22. Did you yourself personally do any work printing or otherwise, on these one-piece transparent window envelopes, or the paper for making them?

“A. I did.

“Q. 23. What was that work?

“A. I printed the oil on the paper, and later in the afternoon I printed the border around the window.”

The witness Olson, an engraver, who made the ring for printing the border around the transparent window in January, 1904, was asked, on page 377, and testified:

“Q. 24. Did you ever make any plate for printing borders for or under the directions of Mr. Regenstein?”

“A. Yes.

“Q. 25. Please tell us what you made borders for Mr. Regenstein for.

“A. We made one especially of a ring to print over and around the window in an envelope.

“Q. 26. Did you yourself make a plate for the ring or border mentioned in your last answer?”

“A. Yes.

“Q. 27. Prior to making the plate for the ring or border for the envelope, had you made plates for rings or borders for or under the direction of Mr. Regenstein for other classes of work?

“A. Yes, sir, as referred to before.

“Q. 28. How common a thing was it to make plates or rings and borders at Mr. Regenstein’s place before you made the one for the envelope?

“A. It was so common that any engraver would make a ring of this kind immediately upon seeing that the pictures showed any ragged edges, without even consulting with the foreman. In fact, everybody in the printing business used that method to cover defects.

“Q. 29. Please tell us about how you came to make the plates for the ring or border for the envelope work that you have referred to.

“A. Mr. Regenstein called me down to the office and instructed me how to make this ring.

“Q. 30. What instructions did he give you?

“A. He told me to make a ring on a plate of zinc to print around a window of an envelope, which he gave me as a size to go by.

“Q. 31. Did he explain what he wanted it for?

“A. Yes.

“Q. 32. Did he show you anything to go by?

“A. Yes, as I have previously answered, he gave me

a sheet of paper showing an oblong spot covered with oil and told me to make a ring to print around the edges.

“Q. 33. Did you make the plate as directed by Mr. Regenstein?

“A. Yes.

“Q. 39. If you know, please state who did the printing on the press with this plate.

“A. Ernest Sauerman.”

“Q. 51. Prior to making the plates for the rings or borders for the envelope paper, as you have explained, had you seen work where the inks ran or spread at the borders?

“A. It does so in most every case where a solid plate is used. I have seen this as far back as I can remember being in business.

“Q. 52. In such cases as you have just mentioned, what was done, if anything, to cover up the running and spreading of the ink at the borders or edges?

“A. In the first place the printer would thicken up his ink or use a different kind of ink to prevent this spreading, or he would run something around the border or edge to hide this defect.

“Q. 53. Did you ever make any plates for the printing of a ring or border around the edges to cover up the running or spreading of the ink, as you have just mentioned?

“A. Yes, just as often as the printer would decide that by printing a border he could eliminate the ragged appearance of the edges of the picture, I would have to make a plate for him.

“Q. 54. How long ago have you made plates for printing a border around work, where the ink ran or spread so as to prevent ragged or unsightly edges or margins?

“A. About 16 or 17 years ago.

“Q. 55. How common a practice was it, to your knowledge, in the printers’ art, to print rings or borders around different kinds of work, where the ink ran or spread, to cover up defects or unsightly appearances in the edges or margins of the work?

“A. It is so common that everybody in the printing establishment would be expected to know it.

“Q. 56. Was it a part of the common knowledge and practice of the printers’ art?

“A. Yes.”

From the above it is plain that the difficulty in making a one-piece transparent window envelope with a border around the edge, to cover up or conceal any running or bleeding of the oil, resided, not in the *printing of a border*, which was the usual and common expedient of printers, but in securing out of the many oily preparations that can be compounded a *preparation for producing* the transparency that would not evaporate or dry out and cause the transparency to disappear; that would not make the window muddy or mottled in appearance; that would not cause the sides of the envelope to stick together; that would flow with the requisite freedom to do the work; that would not change under climatic conditions after the envelope had been made, and matters of that kind.

Both Mr. Cohn and Mr. Regenstein had their troubles with the transparency producing preparation. The border was such a minor matter that Mr. Regenstein saw at a mere glance what was needed to correct or conceal the objectionable appearance in the margin of the transparency. His men all understood the same thing. There was no hesitation, no experimentation, no difficulty about it. The need of the border was apparent to these men familiar with the custom and practice of applying such borders in the printers' art. Hence, the amount of time and money that Mr. Cohn may have expended in getting a *suitable material* to make the *transparency* is immaterial on the question of whether his act of *applying the border* involved invention. The Cohn patent, like the Brown 1862 patent, gives no formula as to the material to be used, but the patentees in both cases left that to the selection of the maker of the envelopes, and it was in the *selection of the material* best adapted for producing the transparency and not in the *printing of the border* around it that the difficulty and the *only* difficulty occurred.

We inquired into the matter of expenditure of Mr. Regenstein, not to show any inventive quality in the application of the border, but to show the merits which are to be attributed to one who, at great expenditure of time and money, has developed a manufacture, made it practical, and supplied it to the world. The application of the border to a one-piece transparent window envelope was simply an application of an old and well-known expedient to an old and well-known purpose in an old and well-known way, involving nothing of the quality or character of invention.

The Nearest Approach to the First Cohn Patent.

After the defendant's expert, Mr. Bond, had considered, both on direct and on cross-examination, the various patents of the prior art, and had pointed out their similarities to and differences from the Cohn patents in suit, and was asked in cross-question 80, at page 536, which one of all the patents he had considered most nearly approached the Cohn patents in suit, he said, as to the first Cohn patent:

"The Brown 1862 patent has the envelope containing the feature of a single-piece transparent-window envelope, corresponding to the envelope of the Cohn patent, without having the opaque border around the transparent window, and which it would be necessary to have in order to make the envelope of the Brown 1862 patent the *fac-simile* of the envelope of the first Cohn patent."

In question 17 of his second deposition, Bond was asked, on page 581, why he selected the Brown 1862 patent instead of the Busch 1896 patent, and replied:

"For the reason that the Brown envelope is made from an opaque stock, as called for by the claim of the first Cohn patent. This opaque stock in Brown has a portion thereof rendered transparent, which is also a requirement of making an envelope under the claim of the first Cohn patent; and, therefore, it seemed proper

for me to select the Brown patent as having the nearest resemblance or being the nearest approach to the envelope of the first Cohn patent, rather than the Busch, in which the stock for the envelope is made entirely transparent instead of being opaque with only a portion transparent."

In giving his opinion as requested above, as to the nearest approach by any single patent to the first Cohn patent, Mr. Bond did not, of course, mean to imply that the other patents of the prior art were not pertinent or were not to be considered in determining whether or not the envelope of the first Cohn patent involved invention. That is a question to be answered after a consideration of the entire prior art presented. What is lacking in one patent on such a consideration may be supplied from the teachings, instructions, and disclosures of other patents. Everything disclosed in *all* of the prior patents in evidence constitutes a factor to be considered in the determination of the question as to the presence of invention and patentability in the envelope of the first Cohn patent.

As said by the Supreme Court in *Loom Co. v. Higgins*, 105 U. S., 586,

"That which is common and well known is as if it were written out in the patent and delineated in the drawings."

In *Imperial Bottle Cap & Machine Co. v. Crown Cork & Seal Co.*, 139 Fed., 324, the United States Court of Appeals for the Fourth Circuit said:

"The general rule is that every patent is to be read as if the whole state of the art is written on its face, and in considering the patents for a combination, it is to be remembered that the alleged infringer has equal rights with the prior patentee to the use of every element known in the art at the time when the first patent was issued."

In selecting the Brown 1862 patent, we simply have a starting point—a disclosure to which all of the disclosures of the other patents, exhibits, and practices in evidence are to be added and the *accumulated* sum of the knowledge thus obtained is to be considered—just, as the Supreme Court says, as if it were written into the Cohn specification and delineated in the Cohn drawings. The Cohn patent must, therefore, be considered the same as if it stated on its face that Cohn took the envelope of the Brown 1862 patent and printed a border around the transparent window, as was done by the three-color printers, and as was done by the lithograph label printers, and as was done in the printing art generally, and as was done in the way described in the Tudor 1878 patent, and in the way described in the Busch 1896 patent, and as described in the various other patents in evidence. In short, the Cohn patent is to be judged precisely as if it said in its specification that it took the Brown 1862 envelope and printed a border around the window, according to the *usual practice* of the printer's art, and according to the *instructions* contained in the other patents in evidence.

If Cohn had come before the Patent Office in his application November 8, 1904, and stated in plain language that what he did was to take the envelope of the Brown 1862 patent and print a border around its window, according to the instructions of the Busch and other patents, and according to *the usual and well known practice* of printers in doing their various kinds of work, can it be supposed for a minute that his application for a patent would have been entertained? Suppose that Cohn in his application had *written* in the state of the art, as the Court of Appeals for the Fourth Circuit in the above case says that it is to be *read* in, and had stated in his specification the *exact facts* as to the prior art, as they are established in this case, his specification—and

we begin *our* rewriting of it at line 63 of the second column of the first page—would in fact and reality have read:

The Cohn Specification as the Law Reads It.

“Since the oily preparation has a tendency to creep or ‘bleed’ beyond the borders of the space imprinted by the stamp or die by which it is applied, and so possibly stain or discolor the rest of the envelope or give a ragged appearance to the window opening, it is preferred, even where the paper might ordinarily be deemed sufficiently opaque, to apply some sort of coloring matter at least around the immediate borders of the transparency. This border is printed around the transparent space or window either in black or other colored inks. The border that I print on my envelopes is the *same kind* of a border as has been used *for many years* by printers of three-color pictures, printers of lithograph labels, and printers generally, to obliterate, cover up, or conceal, any running or spreading of the inks or colors, or any ragged, irregular or other undesirable appearances in the margin or edge of the work enclosed within the border and so as to give definition and sharpness of outline to the work enclosed within the border. The border furthermore may be like the border described in the Busch 1896 British patent, and extend, if preferred, from the transparent window space over the entire face of the envelope; or like the border shown in the Leigh 1894 British publication, which extends from the desired transparent space to the margin or edge of the paper; or like the border shown in the Tudor 1878 patent; or like the border shown in the Hole 1894 British patent. In fact, the border may be of *any of the old and well known kinds* that have been used by printers for many years on various kinds of work, and shown and described in prior patents for various purposes. There is *no novelty* in the use of a border to cover up, obliterate, or conceal the running or spreading of inks and colors and to give definition and sharpness of outline to the work enclosed within the border. The border on my envelopes, furthermore, may be *printed* on the paper the same as has been done *for many years* by printers with the borders used by them to cover up or conceal irregular, ragged, or unsightly outlines in their

work. There is *no novelty* in printing or applying the border to the paper of my envelope.

“In fact, I may say, in describing the invention for which I desire a patent, that the *envelope itself* is old, as shown in the Brown 1862 patent, with the exception of the border which I propose to print around the transparent window. The *border itself* is old, as used by printers for many years for various kinds of work, and as disclosed in various prior patents. The *method* of applying the border, by printing on the paper of my envelope, is old and is *precisely the same* as the method that has been used by printers for many years. In short, all that I do is to take an *old and well known envelope* and an *old and well known border* and apply the one to the other in the *old and well known way*, and for *this* I want a patent.”

The above specification, as we have rewritten it, is precisely the way it *would have been written* and presented to the Patent Office *if it had been written* “as if the whole state of the art is written on its face,” as the Circuit Court of Appeals for the Fourth Circuit in the above case says that it is to be *read and understood*. But if it had been presented in full as we have rewritten it above, the Office would instantly have said, as any court would say, that nothing of invention was disclosed, that Cohn simply applied the old familiar and well known method used by printers and described in patents, for giving definition to his window or transparent portion, and for covering up and concealing any ragged, irregular, or undesirable appearance in the edges or margins of his window, and that all this was matter of common knowledge and practice.

Inasmuch as everything which was common and well known is to be considered as if it were written out in the specification and delineated in the drawings, we see that all of the patents, exhibits, and practices showing what was “common and well known” are to be taken into considera-

tion, and that in selecting the Brown 1862 patent as being in and of itself, without reference to anything else, the nearest approach to the first Cohn patent, we are simply getting an admitted starting point, leaving open merely the question as to whether the other patents, practices, and exhibits *supplemented* its disclosures and taught the art how to *remove* the obvious and admitted difference between such exhibit and the envelope of the first Cohn patent. In this view, it is plain that what was *not* disclosed by Brown in his 1862 patent *was* disclosed in the other patents, exhibits, and practices established by the proofs, so that at the time Cohn entered the field nothing of original, creative, or inventive work was left for him to do in producing his envelope.

It follows, therefore, as already pointed out, that nothing in the nature of *invention* was performed by Cohn when he took the envelope of the Brown 1862 patent and printed onto it the border disclosed in the Busch, Tudor and other patents, and used by three-color picture printers, lithograph label printers, and printers generally, for giving definition to what was inclosed within the border, and for covering up and concealing whatever ragged, uneven, or undesirable appearances there might be in the edges and borders of such work.

The First Cohn Patent Anticipated by the January, 1904, Envelopes.

The first Cohn patent, applied for November 8, 1904, contains but one claim, which reads as follows:

“As a new article of manufacture, an envelope with an unpunctured face of relatively opaque stock, said envelope-face having a portion to which a preparation has been applied to render such portion transparent, and a colored or tinted border surrounding said transparent portion for the purpose of obliterating or concealing the

effects of the tendency of the said preparation to creep into the surrounding opaque stock.”

The above claim describes what has been repeatedly designated in the testimony as a one-piece transparent window envelope. This distinguishes it from those window envelopes which have the window made from a separate piece, pasted in to cover an opening cut in the stock of the envelope itself. The transparent portion is formed by the use of an oily preparation which fills the pores of the paper, and naturally spreads more or less into the texture of the paper itself, so that the edge or border of the opening may present somewhat of an irregular and unfinished appearance. Cohn says that to obviate this and to cover up and conceal the ragged or unfinished appearance around the edge of the window, he prints a border of coloring-matter around the window.

The first Cohn patent is fully met and anticipated by the envelopes made by Mr. Regenstein and Mr. Reese in January, 1904. It appears from the testimony of Mr. Regenstein that he and Mr. Reese visited the office of Banning & Banning in the latter part of 1903 to consult them in reference to a one-piece transparent-window envelope, both as to its patentability and as to whether it would infringe the Callahan 1902 patent, and on which occasion they exhibited an envelope about which they desired such opinion. In pursuance of this visit and on December 16, 1903, Banning & Banning wrote a letter to Mr. Regenstein, which is quoted in defendant's record at page 268. This envelope exhibited to Banning & Banning, however, had no border around the transparent window. It appears, furthermore, that, immediately after this visit and opinion, and beginning early in January, 1904, Mr. Regenstein, who was assisting and financing Mr. Reese, began to make one-piece window envelopes by applying an oily prep-

aration to the desired portions, and as soon as they noticed that the oil they were using spread or ran into the material, they, as old printers familiar with the practice of the printers' art, had a plate made, and printed borders in the form of rings around the windows. This not only gave definition to the windows, but also covered and concealed the running or bleeding of the oil used to make the transparencies. Mr. Regenstein had preserved a number of these first envelopes made in January, 1904, and produced them in evidence. They will be found in the defendant's original record, opposite page 30. The first sample has the border printed with a white ink, which gave a border that did not contrast to the desired extent to the yellowish color assumed by the window on the application of the oily preparation. He, therefore, immediately printed borders by the same plate with a greenish or olive ink, which gave a more finished and desirable effect. In both cases, however, a border or ring was printed around the transparent section or space, and the full and complete invention of the first Cohn patent embodied and realized. These January, 1904, envelopes were made in the printing shop of the American Colortype Company of Chicago, of which Mr. Regenstein was at that time the Western general manager.

That these January, 1904, one-piece window envelopes provided with borders were made in January, 1904, is fully and completely established beyond a reasonable doubt by the testimony of Mr. Regenstein, beginning at page 270; Ernest W. Sauerman, who helped to do the printing, beginning at page 348; Joseph E. Wien, who also helped to do the printing, beginning at page 355; Gustaf Olson, the engraver, who made the plates for printing rings or borders on the January, 1904, envelopes, beginning at page 377; Max Lau, secretary of the American Colortype Company, where the printing was done, who not only saw the envelopes, but also saw Wien

print sheets of paper containing a number of blanks, as described in the Reese 1904 patent, beginning at page 392; Behrens, whose father was one of the proprietors of the American Colortype Company, where the work was done, beginning at page 420; and Adolph G. Voss, who was office manager of the Company at the time the printing was done, beginning at page 407. These seven witnesses saw the envelopes, saw the work being done, most of them assisted in doing the work, and they testified that the envelopes produced and others like them were made in January, February and March, 1904,—some of them in January, and some of them in the next month or two. They all testified that the envelopes were made prior to a strike that occurred about the last days of March, 1904, at the shop of the American Colortype Company, and gave circumstances and incidents which corroborated their statements. This strike was occasioned by the transfer of the witnesses Sauerman and Wien to the press room to work as pressmen, and the strike was inaugurated by the Franklin Union No. 4 of pressmen. It resulted in the filing of a bill in the United States Circuit Court at Chicago, and the granting of an injunction against the union. This injunction or restraining order was entered April 4, 1904, and a copy of it will be found in the defendant's record, at page 343.

It furthermore appears that on January 15, 1904, Reese applied for two patents. One of these, printed at page 651, was for the one-piece transparent-window envelope, and the other for the sheets of paper or stock out of which the envelopes are made. The first of these applications was rejected in the Patent Office, on reference to the old patent for that kind of an envelope granted to Brown, in 1862, already considered, and no patent was granted on it. The other resulted in the Reese patent of August 9, 1904. Neither of these applications showed or described the border

around the transparent window. The rejected application for the envelope appears, from the certified copy in evidence, to have been sworn to January 2, 1904. It was immediately after this application had been sworn to or filed that Regenstein began to make the January, 1904, envelopes, when he immediately observed the ragged or unfinished appearance of the edge or margin of the window and resorted to the expedient of printing a border around the transparent portion, to give it definition and to cover and conceal the undesirable appearance caused by the running of the oil. He made no effort to get a patent on this feature, as he regarded it simply as the old well known expedient employed by himself and other printers from time immemorial for giving a desired finished appearance to a job. In answer to question 136, at page 294, he says that "I did not apply for a patent on a thing or operation which I and others have done and made for years." His knowledge of the printing art and of what had been done for years, and was being done every day in the printing of three-color pictures and other work where borders were printed, made him consider that it would be ridiculous to ask for a patent covering the printing of the old and well-known printers' border around the windows of envelopes—something that had been done for years on many kinds of work. This answers the curiosity of complainant's counsel expressed in his question in the court below as to why Regenstein did not apply for a patent on it if he made envelopes in January, 1904, with a border on them—he did not consider that any invention was involved.

The first Cohn patent was applied for November 8, 1904. The January, 1904, envelopes, in evidence, were made some ten months before the application for the Cohn patent. Under these circumstances they operated to anticipate and invalidate the Cohn patent, unless Cohn could show beyond

a reasonable doubt that the envelope of his first patent was made prior to the January, 1904, envelope. For Cohn to anticipate the January, 1904, envelopes, as some of the cases hold, his evidence must be as strong as that required from the defendant to establish their making—certain beyond a reasonable doubt. Other cases use somewhat different language. They say that the evidence furnished by a complainant to anticipate an anticipation must be exceptionally strong, clear, and convincing. We will quote from two or three cases to show the exact language in which the law as to this matter is laid down by the courts.

In *Thayer v. Hart*, 20 Fed. Rep., 693, Judge Coxe, in 1884, said:

“The complainant’s patent antedating the defendants’, it was incumbent upon them to prove beyond a reasonable doubt that theirs was the prior invention. This they have done by proof so positive that the complainant’s counsel conceded on the argument that the date of their invention was January 15, 1877, eleven months prior to the filing of the complainant’s application. This date being fixed the burden was transferred to the complainant to satisfy the court by proof as convincing as that required of the defendants, that his invention preceded theirs. The rule in such case is very strict. It is so easy to fabricate or color evidence of prior invention and so difficult to contradict it, that proof has been required which does not admit of reasonable doubt.”

In *Westinghouse Electric & Mfg. Co. v. Mutual Life Ins. Co.*, 129 Fed., 216, Judge Hazel, in 1904, said:

“Evidence in support of the claim of earlier conception than the date of the application, disclosure of the invention, and its actual reduction to practice must be received with great caution. Unless such inventions were actually made and perfected before the date of the Ferraris publication, the patents cannot be sustained. The burden is upon the complainant, under the

circumstances to establish by clear, unequivocal, and convincing proof that the anticipation has been anticipated."

In *Clark Thread Co. v. Willimantic Linen Co.*, 140 U. S., 492, the Supreme Court, in 1891, said:

"After Weild's patent was introduced into the case, showing with certainty the date of its publication, and such date anterior to the issue of Conant's patent, it was incumbent on the plaintiffs in rebuttal, to show, if not with equal certainty, yet to the satisfaction of the court, that Conant's invention preceded that date."

But, without quoting from other cases to the same purport, the law is settled that where a complainant's invention has been anticipated by satisfactory and indisputable evidence, the complainant is defeated, unless, on his part, he can establish that he made his invention prior to the date of the anticipating structure. The presumption arising from the patent is that Cohn made the invention of his first patent at the date of his application—November 8, 1904—but this is some ten months too late, unless he has established by evidence outside of the patent that he made the invention at an earlier date and had it completed prior to the making by Mr. Regenstein and others of the January, 1904, envelopes. This brings us to a consideration of the dates claimed on behalf of Cohn.

The complainant Cohn was examined twice as a witness on behalf of himself. His second examination was begun February 23, 1911, after the testimony on the part of the defendant had been taken establishing January, 1904, as the date when the completed invention was embodied in the January, 1904, envelopes. Cohn knew, therefore, what date he must get behind in order to sustain his patent. Hence, every inducement existed for assigning a date for his invention

prior to January, 1904, to magnify everything he did and to confuse what he did on his *transparent* stock envelope with what he did on his *opaque* stock envelopes, and thus piece out the work on the one by the work done on the other.

In his *second* deposition Cohn says that after much thought he struck upon the idea of printing a border around the transparent portion of the envelope, and then, on page 113, said:

“This discovery was made by me some time in the year of 1903, this date being indelibly impressed on my memory from the fact that I severed my connection with the Illinois-Pacific Glass Co. on October 15, 1903 in order to take a position with A. Zellerbach & Sons, now known as the Zellerbach Paper Company.”

In the above Cohn says that the date when he made his alleged discovery was “indelibly impressed upon his memory. If this is the fact, if the date was *indelibly* impressed on his memory, then there should never have been a time after he had made his discovery when he could not have stated when it was made. Facts which are “indelibly” impressed can always be recollected and stated.

Cohn gave his *first* deposition in his own behalf on November 3, 1910. At that time no testimony had been taken on the part of the defendant. Cohn was, therefore, not informed as to what dates would be disclosed by the defendant's proofs. Nevertheless, as the date of his discovering the border was “indelibly” impressed on his mind, there could have been no difficulty of his fixing and stating the same. In cross-examination he was asked more than a dozen times as to when he made or conceived his invention. He invariably declared he could not tell. He professed to have no sufficient recollection. In order that the court may see the number of times in which he declared that he could not

remember when he had made or conceived of his invention, we will quote a number of questions and answers from his cross-examination while giving his *first* deposition in November, 1910, beginning at page 47:

"X-Q. 15. When did you first conceive of this invention, Mr. Cohn?

"A. I can't answer at the present moment.

"X-Q. 16. You don't know, then, when you first conceived of the envelope which you claim to have patented?

"A. Not at the present time."

"X-Q. 20. How long prior to the filing of your application for the patent No. 835,850 was it that you conceived the idea of that patent?

[No answer.]

"X-Q. 21. Do you decline to answer?

"A. My answer is the same as before, that I cannot at this time state the time of conception.

"X-Q. 22. You don't know whether it was two years or six years or twenty years or one month prior to the time of filing your applications. Is that the way you want to be understood as testifying?

"A. It would be necessary for me to go through a great amount of data which I have and consult with some of my witnesses, before being able to answer as to the time of conception.

"X-Q. 23. Well, you were the person who conceived the patent, were you not, Mr. Cohn?

"A. Yes, sir.

"X-Q. 24. And you at this time cannot give us any approximate idea as to how long prior to the time you filed your application in this matter it was that you conceived the idea of this patent?

"A. No, sir.

"X-Q. 25. And your answer would be the same as to the patent No. 824,908. Is that correct?

"A. Yes, sir."

"X-Q. 28. Well, was the first general feature of the patent conceived a non-perforated window?

"A. I can't recollect at this time just what the first conception of the patent was."

"X-Q. 31. So that altogether you have invented these two patents in this matter, and two others, and yet you can't tell us how long prior to the time you filed your

application for the patents in this case you first conceived the idea of the patent, nor are you able to tell us what was the first conception of the patent that you had in this particular case, what feature you first conceived. Is that correct?

"A. Yes, sir."

"X-Q. 45. I ask you then if up to June or July as you stated, 1904, when you and Mr. Shipp applied for a patent in England for an envelope with a visible window, had you up to that time conceived of the idea of placing a border around the edge of that visible window indicating the particular character of business in which the user of the envelope was engaged?

"A. As I stated, it is impossible for me at this time.

"X-Q. 46. Do you answer that in that fashion simply because your counsel at this moment called your attention to the fact that you had so testified previously? Is that your only reason for so testifying now

"A. No, sir; my reason is because it is a fact.

"X-Q. 47. You can't tell us at all, then, whether or not up to June, 1904, you had conceived the idea of a visible window of the envelope for which you applied for a patent in England or in this country?

"A. I can't state at this time."

"X-Q. 50. Now as I understand your testimony, you are not prepared to tell us whether prior to 1904, when you and Mr. Shipp applied for a patent on an envelope in England somewhat similar to the envelope in question, you had conceived the idea of a border around the window of the envelope indicating the character of the business in which the one who used the envelope was engaged, or not indicating the character of his business. That is the way I understand your testimony?

"A. Yes, sir."

Following the deposition of the witness Maynard, Cohn was recalled and further cross-examined. He stated that he conceived the idea of a border around the window prior to January 17, 1905, and was then asked:

"R-X Q. 2. How long prior to January 17, 1905, had you conceived such idea?

"A. I can't state at this time.

“R-X Q. 3. Was it more than a year?

“A. As I stated before, it is impossible for me to tell, at this time, just when the idea was conceived.”

“R-X Q. 9. Was it before or subsequent to the issuance of the British patent that you first conceived the idea of placing around a window of the envelope a border so as to indicate the particular line of business of the user?

“A. As stated before, it is impossible for me at this time to give anything definite in reference to the time of conception.”

In the above testimony Cohn more than a dozen times—fifteen times—declared that it was impossible for him to state when it was that he conceived of the invention involved in this litigation. In view of his statement, when called as a witness the second time, that the date when he conceived of the application of the border to his envelope was “indelibly impressed on his memory, it is hardly necessary to comment on the manifest character of his testimony given in his first deposition and quoted above. We think the plain fact was that he was determined not to disclose any date to which he could be held, and that he determined to leave himself in position to meet any contingency that might arise and so professed inability to state when he had conceived of the invention in question. If this be so, then, manifestly, his subsequent testimony should be accepted with caution, and unusual certainly required as to any definite claim of invention prior to the date established by the defense.

Cohn says that he severed his connection with the Illinois-Pacific Glass Company on October 15, 1903, in order to accept a position with A. Zellerbach & Sons. This may be true, but does not establish any other fact. It merely affords a date prior to which or subsequent to which other events may be referred. We will, therefore, consider what Cohn claims to have done prior to October 15, 1903, and what he claims to have done subsequent to that date.

In answer to question 9, Cohn, beginning at page 114, describes what he claims to have done prior to October 15, 1903. He says:

“My early experiments consisted of taking a sheet of paper and applying various oily preparations with a brush. Later, I applied these preparations with a block of wood and with pieces of rubber. It was then that I found that the oily preparation would spread beyond the size of the block. I remember one instance after applying the oily preparation I took a lead pencil and marked all around the spot made by the preparation and the next day I discovered that the oil had gone over the pencil marks in every direction. After making the discovery mentioned above of printing a border around the transparent portion, I consulted with Mr. Epting, an artist in the employ of the Glass Company, and asked him to make a drawing for me from which a zincograph could be made, and I described to him several designs that I had in mind. Among others, was a design showing an oblong space surrounded by a cloud effect. I have in my possession an envelope which was made from the original zincograph. This envelope shows that the ink is applied solidly around the space, which is understood to be the space reserved for showing the address, which I will call the window space, and is gradually shaded off. As a matter of fact, I bothered the various employees of the label department to such an extent that I incurred the wrath of the manager, Mr. George Walter, who had charge of all the employees in the label department, and had I not been an officer in the corporation, I think he would have kicked me out bodily. After zincographs had been furnished me by Mr. Epting of the label department, I took sheets of paper which I had prepared myself with an oily preparation and had the designs printed around the window space, thus prepared. The first ink that I used did not answer the purpose, and I was obliged to experiment with a great many different kinds of ink before securing one that would answer the purpose.

“Shortly before leaving the Glass Company I was introduced to a gentleman named B. T. Bean, a system man from Chicago. He was at that time installing a system for Dunham, Carrigan & Hayden, a hardware

concern whose place of business adjoined the Glass Company. Realizing that Mr. Bean was a man of a great deal of experience, also a man who was entrusted with all sorts of business secrets, I spoke to him in reference to my invention and showed him specimens that I had prepared in the manner described above. He was very enthusiastic about the envelope and in reply to my inquiry stated that in his entire experience, which carried him to every part of the United States, he had never seen anything like it, and told me that there would be a great market for an envelope of this description. It was about the time that I had the above interview with Mr. Bean that I made the change from the Glass Company to the Zellerbach Company. I remember this because I suggested to the Glass Company that since they were about to change accountants it would be a good time for them to establish a new system and Mr. Bean coming highly recommended, I considered him a good man to engage."

Further along in his answer to question 9, Cohn says that after October 15, 1903, he had all his printing done at the printing office of F. H. Abbott & Company; and in his answer he mentions a Mr. Tooker, the foreman of the Abbott Company, who did the work for him. As this details his work for the second period—the period beginning October 15, 1903, to take his date—we will again quote Cohn's exact language, beginning at page 117:

"After October 15, 1903, all my printing was done at Abbott's office, but I continued to have my drawings and zincographs furnished by the Glass Company, because F. H. Abbott & Company, being commercial printers, had no art department in connection with their business. From the time I began working with the Abbott Company I started to apply the oily preparation by means of a printing press. Up to this time I had used a brush or applied it with a block of wood or a piece of rubber, much in the same manner as rubber stamps are used. I encountered the greatest difficulty in finding a suitable material for making the transparent window and in connection with Mr. Tooker, foreman of the Ab-

bott Company, I worked continuously over a period of a great many months, putting in several evenings, also several holidays and Sundays. I found in some instances where I succeeded in getting a preparation that made an excellent transparency, that it would fade out and become almost useless; said preparations would keep the paper transparent for about a month and then for some reason or other the paper would become opaque again, and in some instances, this would occur within a very few hours after the preparation had been applied. I kept persistently at work from the time of my conception until August or September of 1904, when I brought my invention to a state of perfection. It was at this time that I placed an order for the Zellerbach Company with F. H. Abbott & Company for 10,000 envelope blanks, such as described above, and I still have in my possession a sample, which I here produce."

In the above statements, Cohn mentions three parties—Epting, the artist in the employ of the Glass Company; Bean, a system man from Chicago; and Tooker, the foreman of Abbott & Company. He says Epting made him some zincographs, one of which had a cloud effect border around an oblong space. He says that he has in his possession an envelope which was made from the original zincograph, but he does not say *when* it was made, but Tooker recognized it as one that *he* made. This envelope is the one introduced as "Complainant's Exhibit N." He says that he has a sample of the 10,000 envelopes made in August or September, 1904. This was offered as "Complainant's Exhibit L."

When were any envelopes made by Cohn containing a border around the transparent window or portion made by an oily preparation in *opaque* paper, prior to those made in August or September, 1904? Presumably, the first ones were with the cloud effect, like "Exhibit N," because he says: "I have in my possession an envelope which was made from the original zincograph." But *this* envelope was made by Tooker in the *spring or summer of 1904*, as we shall pres-

ently show. We think there is *internal* evidence in the record that this presumably earliest envelope, as well as all of the other samples of envelopes produced by Cohn, were made *subsequent* to May 9, 1904, and that there is no sufficient evidence that he ever made an envelope of *opaque* stock with a border around the transparent window prior to that date. We will therefore consider this internal evidence.

On May 9, 1904, Cohn filed an application in the Patent Office for an envelope, which application was afterwards abandoned. The envelope that he showed and described in this application was made from *transparent* material or stock as distinguished from *opaque* material or stock. This application was similar to the English patent obtained by Cohn and Shipp and applied for June 27, 1904. In the making of this envelope of the May 9, 1904, application, transparent stock was taken and ink of any desired color was printed over all of the envelope, with the exception of the addressing space or window, which was left transparent, as it was originally. This made a one-piece transparent window envelope with a border covering the entire face of the envelope except the window, as Cohn says in both of his patents the border *may* be made. An envelope embodying the idea of this abandoned application was offered in evidence as "Complainant's Exhibit R." This May 9, 1904, application continued pending in the Patent Office until June 24, 1905, when it was finally rejected and all effort to secure a patent on it abandoned.

This abandoned application, filed May 9, 1904, was the first application that Cohn filed for a patent on an envelope. But nowhere in this first application filed by Cohn, this application filed in May, 1904, do we find any description, statement or suggestion that Cohn had any idea in mind of the *bordered* envelope of his patent. This May 9, 1904, ap-

plication was the same in every respect—drawings and specifications—as the Cohn and Shipp June, 1904, British patent, as will appear at pages 128 and 178 of the Record. By reading the British patent, therefore, we can see exactly what the May 9, 1904, application disclosed. It in no way, shape or form described the envelope in question—a one-piece window envelope made from opaque paper with the window rendered transparent by an oily preparation and a border printed around the window to cover or conceal the spreading of the oil into the paper. Cohn at page 177 says it does not. Why was there no reference to this envelope if it had been conceived of and made in the fall of 1903? No explanation was offered for this omission. But it seems incredible that Cohn would have made an application in May, 1904, for a patent—his first application at that—and have left out all reference to the envelope now in question if he had made such envelope prior to that time, as he now claims. Why did he only describe the envelope made of transparent stock if he had also invented the other? He offers no explanation. We offer one—because he had not, prior to May 9, 1904, made the envelope. This explains the words on all the envelopes Cohn produced and offered in evidence—they were made *after* this May, 1904, application was filed.

When we look at the various envelopes produced by Cohn, we find that they are all marked “Patent Pending” or “Pat. Applied for.” The envelopes “Complainant’s Exhibits L, N, O, P and FF,” are marked “Patent Pending,” and the envelopes “Complainant’s Exhibits Q and R” are marked “Pat. Applied For.” These words speak for themselves. There is no explanation offered by Cohn or any other witness as to their presence. Presumably, at the time the envelopes on which they appear were made, an application *was* pending for a patent. They are either true or not. In the

absence of evidence to the contrary, the legal presumption is that they are true. If they were made after May 9, 1904, they are true. A patent was pending; a patent was applied for; and Cohn could truthfully print these warning words on his envelopes *after* May 9, 1904. To print them *prior* to that time would have been to put forth a false statement—an untruth—and the law never *presumes* that a man is lying.

All of the envelopes produced by Cohn, therefore, bear upon themselves, when taken in connection with the abandoned application of May 9, 1904, presumptive internal evidence that they were made *subsequent* to that date. If they were, as we think they were, then Cohn has not an envelope, a sketch, a plate, a memorandum—nothing physical and tangible—that antedates the January, 1904, Regenstein envelopes.

It is admitted by Cohn that the envelope "Exhibit R" was made *about the time* he filed his abandoned application. He was asked:

"Q. 25. Can you fix the time that this transparent sheet envelope 'Exhibit R' was made by you?

"A. I cannot fix the exact date but feel reasonably certain that it was made at about the time the application was filed for the United States patent.

"Q. 26. Which application?

"A. Application filed May 9, 1904, Serial No. 207,282."

He admits also that the envelope with cloud effect border, "Exhibit N," was made after he left the employ of the Glass Company. In speaking of this he says that before making the 10,000 envelopes which were made in August or September, 1904, "F. H. Abbott & Company printed for me some sample envelope blanks, printed from a zinc which was made by the Illinois-Pacific Glass Company before October 15, 1903," and he produces one of them, which was

offered in evidence as "Complainant's Exhibit N." Although he says the *zinco* was made while he was in the employ of the Glass Company, he does not state the time when the *envelopes* with the cloud effect were printed, but simply that they were printed by Abbott & Company "before making these 10,000 envelopes." The printer, Tooker, who did the printing recognizes the Exhibit N with the cloudy border as one he printed, but in answer to question 25 says that he cannot give the "exact date." It is reasonable, therefore, as they contain the words "Patent Pending," to assume that they were made *after* filing the abandoned application, May 9, 1904, which would still be "*before*" making the 10,000 lot in August or September, 1904. What evidence is there that any were made from opaque stock prior to May 9, 1904?

In answering Question 19, at page 125, Cohn claims that before he had left the Glass Company in October, 1903, he had "made up several envelopes by cutting out the blank with a pair of scissors and pasting it by hand"; and in answering Question 46, at page 138, he says that "I know that I showed them to Mr. Bean." On the next page and as an addition to his answers to Questions 21 and 22 and questions 45 and 46, at page 139, he says that "I am not positive that I retained these samples up to the time of the fire, and there is a possibility that I may have destroyed them before that date." If these samples were like the transparent stock envelope, "Complainant's Exhibit R," then, according to Cohn himself, they did not contain the invention of the two patents sued on. We asked him at page 177:

"X-Q. 142. Do you consider that the envelope Exhibit R, and the envelope described in your British patent and in your May 9, 1904, abandoned application, contains or embodies the invention described and claimed in your two patents sued on?

"A. I do not."

With the above admission and contention on the part of Cohn himself, we are prepared to see what kind of sample envelopes, if any, he had made prior to leaving the Glass Company in October, 1903, and to this end we will have recourse to the witnesses whom he called to show his early operations. We will see what each witness says.

The complainant's witness Selling, who was a salesman for the Glass Company and had been with them for more than twenty-three years, and who claimed that Cohn had talked with him about the matter, was shown the envelopes marked "Complainant's Exhibits L, M, O and R," and in question 10, at page 214, he was asked to "pick out from those an envelope which would correspond to anything you saw or understood from Mr. Cohn's description at that time to be his invention," and after examining the envelopes Selling said:

"This one here marked Exhibit R was shown me by Mr. Cohn and I recall even the printing thereon, at that time, this being the only one I recognize as having been shown me by Mr. Cohn when he was in our employ. The envelope Exhibit L was subsequently shown me by Mr. Cohn some little time after he went into the employ of Zellerbach & Sons [the Exhibit L was one of the 10,000 made in August or September, 1904, so that it was "some little time," indeed!]. The other two I do not recall ever having seen them."

"X-Q. 11. Do you mean that this envelope marked Exhibit R, or one like it, was the one shown you by Mr. Cohn while he was in the employ of the Glass Company?"

"A. One similar to that."

"X-Q. 14. Do you have any letters, writing or other memorandums that enable you to fix the date when Mr. Cohn showed you this Exhibit L envelope?"

"A. No, sir. However, I can recall where he mailed me one of those envelopes with the pickle design thereon, and had written a note therein asking me how I liked it."

"X-Q. 17. You speak of several hand samples that Mr. Cohn showed you. Were they like this envelope Exhibit R?"

"A. Not in colors like that as I recall it.

"X-Q. 18. Were they like it in other respects?

"A. I should say yes."

"R-X Q. 32. When did you first see or Mr. Cohn show you envelopes with the windows or transparent portions in the shape of a pickle or cucumber or cigar?

"A. Short after leaving the employ of the Illinois-Pacific Company.

"R-X Q. 33. Did he show you such envelopes during the year 1904?

"A. Early part of 1904."

The above testimony of the witness Selling, even if given full credence, notwithstanding it depends upon the recollection of the witness only, unsupported by any writing or fixed memoranda, merely goes to the point of showing that Cohn made hand samples of envelopes like the envelope "Complainant's Exhibit R," which Cohn himself *repudiates* as containing or exemplifying the invention of either of the patents in suit, while in the employ of the Glass Company, and that the witness saw one of the pickle envelopes "shortly after leaving the employ of the Illinois Pacific Glass Company." Cohn says this was October 15, 1903, and Selling would have us believe that he saw one of the pickle envelopes "shortly" after that date. Yet Cohn in his long answer to question 9 says that he only conceived of the pickle envelopes "some time in the summer of 1904." The envelope Exhibit R was printed by Tooker *after* Cohn left the employ of the Glass Company, yet Selling recognizes it by "the printing thereon" as one he saw before he left—a palpable absurdity as the hand sample envelopes surely had no *printing* on them. No doubt the "hand samples" mentioned by the witness as like the Exhibit R were the ones Cohn cut out with the scissors before he left the Glass Company. If so, they were made of *transparent* material, and therefore, as Cohn claims, did not contain the invention of his first patent. This testimony is certainly lack-

ing in the certainty required in testimony sufficient to anticipate an anticipation as laid down in the decisions already quoted.

The next witness relied on by the complainant is the systems man from Chicago, B. T. Bean, whose business, in short, was to advise business concerns how to run their business. In question 8, at page 220, Bean was asked whether "during the time you have known Mr. Cohn has he ever claimed to you that he was the inventor of any particular style of an envelope or that he had any patents on the same," and in reply he said:

"A. At that time Mr. Cohn said that he wanted to show me something in confidence and as I was traveling all over the United States and knew more or less about business conditions and business practices, and that he had a new style envelope that he wanted to get my opinion on, and that he would show it to me in confidence, but did not want me to tell anyone about it. He then showed me some rather rough styles of envelopes that were translucent or transparent so that the address would show through the envelope, the writing being hidden by the rest of the paper which was opaque. It was after the style of an Outlook envelope, except that the opening was prepared by some process making it transparent. I remember that I told him that I had never seen anything like it before and that I thought it was a splendid thing, and I further thought that in my judgment there would be a good sale for that sort of an envelope.

"Q. 9. Can you describe with any more particularity the construction and appearance of the envelope Mr. Cohn showed you, and if you can please do so.

"A. As I remember the samples he showed me they were of rather rough construction and looked as if they had been made by hand. Some of the samples were flat, just blanks, treated with this preparation. The transparent part was surrounded by a sort of a border or cloud effect. I don't remember much about the samples in detail."

On cross-examination, at page 224, Bean was asked:

"X-Q. 20. Did you see Mr. Cohn after he left the employ of the Glass Company and during the year 1904?"

"A. I think I did."

"X-Q. 22. Did Mr. Cohn show you any of his envelopes during the year 1904?"

"A. I don't remember the exact times at which he showed me these envelopes during the years 1904, 1905 and 1906, but possibly two or three times during those years he spoke to me about the envelopes and showed me some I remember with advertising matter around the border."

In reference to the rough envelopes or blanks that Bean had mentioned in his answer to question 8, and which in his answer to question 12, at page 222, he thought were more like the envelopes "Exhibits N and O" with the cloud effect around the transparent portion, he was asked:

"X-Q. 26. Can you say as to whether or not they had any clouds in blue or in silver around the transparent portion?"

"A. I could not."

"X-Q. 27. Can you say positively that they had any border whatever around the transparent portion?"

"A. My memory is very vague as to the actual envelopes and papers submitted. I did not pay very much attention to the samples after the idea was given me."

"X-Q. 36. How did the paper of the blanks and envelopes which Mr. Cohn showed you correspond with the paper out of which this envelope R was made?"

"A. I don't remember."

From the above testimony it is plain that the witness Bean had no clear or definite idea as to what Cohn did show or disclose to him in the fall of 1903. He says that his memory is "very vague." He says that he "did not pay very much attention to the samples." He says that he cannot say whether they had "any clouds in blue or silver around the transparent portion." He says that he does not remember

whether the blanks and envelopes which he claims that Cohn showed him corresponded "with the paper out of which the envelope R was made"—the envelope made from transparent stock. He admits that Cohn showed him envelopes "during the years 1904, 1905 and 1906," and that possibly two or three times during these years "he spoke to me about the envelopes."

In view of the uncertain and vague character of his statements, the testimony of Bean certainly fails to establish the making of one-piece transparent window envelopes of *opaque* stock with borders around the transparent portions at the time of his talk with Cohn in the fall of 1903. In fact, Bean does not remember but that the blanks and envelopes which Cohn showed him were made out of transparent paper, *like* the envelope "R," which Cohn insists does not embody or realize the invention of either of his patents in suit.

The witness Vanderzweip, who was bookkeeper for the Zellerbach Paper Company, simply testifies, at page 232, to the use of the 10,000 envelopes made in August or September, 1904, and had nothing to say bearing on the question under consideration.

The witness Tooker, who was foreman for F. H. Abbott & Co., at which place Cohn says that "after October 15, 1903, all my printing was done," testifies that Cohn came to him and that he worked for and with him during holidays, Sundays and overtime on the envelopes. In answering question 6, at page 235, he says: "I was working on this process around the Holidays"—the Christmas Holidays of 1903—and he fixes upon this time because he says that "some of the money paid to me for my labor I used in buying presents." He says that, "We experimented in this matter for nearly a

year." He details the work and experiments that they did and made. He says that, "We had a great many difficulties to overcome, the main one being to get the desired transparency, which he finally succeeded in getting." He says that, "We finally got to the place where we could turn out these envelopes with the preparation covering the desired space and not spreading too far. He then gave an order for 10,000 of these envelopes to be printed, which I printed about September, 1904." He recognizes the envelopes "Exhibits L and M" as being a part of the 10,000 lot printed about September, 1904. Yet Selling in his endeavor to help Cohn carry the dates back says that Cohn showed him this Exhibit L "some little time" after Cohn entered the employ of Zellerbach & Sons—which was in October, 1903. In answer to question 23, at page 242, he recognizes the "Cremo Cigar" envelope "Exhibit FF" as a part of his work. It was made *after* he had adopted a piece of pulp board glued on the cylinder, and which he adopted, as stated in his answer to question 6, *after* they had "finally tried felt." He says, in answer to question 23, that this "Cremo Cigar" envelope "was one of the *first lots I printed* for Mr. Cohn, the exact date I cannot give, because we were simply working out this preparation of transparency"—and that required months. The "Cremo Cigar" envelope was therefore evidently made some time in the summer of 1904, and it "was one of the first lots."

Cohn first thought of making the window in the shape of a cigar or other article of manufacture, and utilizing the border for permanent advertising matter in the summer of 1904. In his long answer to Q. 9, he says:

"While working on various styles of envelope blanks I discovered that a good use could be made of the necessary border for the purpose of advertising, and I made a good many specimens of envelope blanks with borders carrying out this conception. I conceived this idea some time in the summer of 1904. To be more specific, I will

state that this border took on the general outline of a cigar, a pickle or cucumber, a cascade, and other well known articles."

If, therefore, the Cremo cigar "was one of the first lots" which Tooker printed for Mr. Cohn, then it must have been printed in the summer of 1904, because, according to Cohn's own statements, it was *not thought of* until "some time in the summer of 1904." The words "Patent Pending" on it, therefore, were printed after May 9, 1904, when Cohn filed his first application for a patent, and such words spoke the truth.

In answering question 25, at page 242, Tooker recognized the envelopes "Exhibits N and O" with the blue and silver cloud effects, as envelopes that he had printed. He says that, "The exact date I could not give" when he printed these two envelopes; but as the "Crema Cigar" envelope "was one of the *first* lots," these cloud effect envelopes "N and O" must have been printed *after* that one, and some time in the spring or summer of 1904. In answer to a very leading question, notwithstanding he had stated, in answer to question 23, that the "Crema Cigar" envelope "was one of the first lots," he fixes the Holidays of 1903 as the date when he first printed envelopes with a border. We will quote this question and answer:

"Q. 27. Do you know whether or not you had actually applied to an opaque sheet an oily preparation for making transparency for Mr. Cohn and used a border around this transparent space, for the purpose of an envelope, in 1903?

"Question objected to as leading.

"A. Yes, I would say that in those impressions that I made around the Holidays I used a preparation given me by Mr. Cohn, which made opaque paper transparent, but I don't say that it was the one printed like the cut the 10,000 was printed from, but that we had the transparency figured out at that time I am sure."

In answering question 31, at page 244, Tooker explains some of the difficulties that they had in making the oily preparation flow as freely as it should, and says: "It was necessary to use gas stoves under the press, heating the plate and making the preparation run out smoothly." He further says that, "The transparency that we reached in the earlier stages was inclined to be more dirty and mottled, not smooth. I am sure that around the Holidays of 1903 was the time when we first used the stoves, it being the winter time, and the preparation not having inclination at that time to flow freely."

We showed Tooker the envelope "Exhibit R" made from transparent stock and, at page 246, asked him:

"X-Q. 34. Do you recognize the printing on that envelope as some of your work?"

"A. I done some printing on paper of this kind for Mr. Cohn, but I cannot say that I printed that particular envelope."

In view of the above, it may very well have been that the printing which Tooker did for Cohn on or about the Christmas Holidays of 1903—if their experimental work had progressed to the printing stage—was on envelopes like "Exhibit R," which Cohn insists did not contain the invention of either of his patents in suit. Tooker says that he "done some printing on paper of this kind" and *nobody else* is shown to have done any.

The witness Epting, who was the artist for the Glass Company, says that he made some designs for Cohn before he left the employ of the Glass Company. In answer to question 8, at page 248, he says that he made quite a number of different designs, "some with shading around the edges and some with all the solid color in the back, and quite a number

of different ones, I don't remember all the different ones I did get up." In cross-question 16, at page 249, he was shown the envelope "Exhibit R" made of transparent stock and in answer to the next question he says that he never saw any envelopes like the envelope "R" before seeing that one just shown him. In answer to cross-question 21, he says that he did some work for Cohn *after* he left the Glass Company. In answer to question 12, at page 249, he says that zincos were cut from the drawings with the cloud effect, like envelope "Exhibit N," but he does not say when he first saw an envelope made from the zincos.

The witness Dolge was simply called by the complainant to testify that he entered the employ of the Glass Company about October 15, 1903, and that he succeeded Cohn with that company. He gives no testimony whatever as to seeing envelopes or knowing about them.

The above gives the testimony of all the witnesses as to the earliest work done by Mr. Cohn in making envelopes. We think it plain that the first envelopes made by Cohn were made from transparent stock, like the envelope "Exhibit R." This is the envelope which he showed and described in his first application for a patent—his abandoned application filed May 9, 1904. All of the other envelopes appear to have been made at a later date, in all probability not until after the filing of his May 9, 1904, application. They all contain the words "Patent Pending" or "Pat. Applied For," which would be true if they were made after the filing of the abandoned application, in view of its broad and comprehensive claims, already quoted, but not true if made before that date. Some of them are identified by the witness Tooker, whose earliest work he claims was "around the Holidays"—the Christmas Holidays of 1903. As, however, he also worked in the making of envelopes from transparent stock, like the

envelope "Exhibit R," it is easy for him to have got the work on one confused with the work on the other. The probabilities are, as we insist, that no one-piece transparent envelopes, having the transparency formed by an oily preparation, and provided with a border around the transparency, were made until some time in the spring or summer of 1904—*after* May 9, 1904.

In view of the fact that the complainant has produced nothing whatever in the way of writings, memoranda and exhibits, or other matters that show that he made any one-piece envelopes having a transparent portion formed by an oily preparation with a border surrounding the same prior to January, 1904; in view of the fact that he was working on his transparent stock envelopes, like the envelope "Exhibit R," during the same time he claims to have been working on the envelopes of the patents sued on; in view of the fact that the witness Tooker, foreman of the Abbott Printing Company, identifies various of the envelope exhibits as having been printed by him *after* he began working for Cohn about the Christmas Holidays of 1903; in view of the fact, as he testifies, that he and Cohn were working on the matter for months to get the oily preparation so that it would make satisfactory transparent spaces; in view of the fact that all of the exhibit envelopes offered in evidence contain the words "Patent Pending" or "Pat. Applied For," and thus on their face raise the presumption that they were not produced until after the filing of the abandoned application, May 9, 1904; in view of the fact that although, as Cohn said in his last deposition, the time when he made the invention was "indelibly" impressed on his mind, yet in his first deposition he testified more than a dozen times that he could not give the date of the conception at the time his deposition was given; and in view of the liability of witnesses who have seen or worked on the

different kinds of envelopes—those made from transparent stock and those like the patents in suit—to confuse the one kind with the other, particularly when, as the witness Bean testifies, his recollection is “very vague,” and that he paid little attention to the details, we submit and insist that the testimony on behalf of the complainant is insufficient to anticipate the clear anticipation afforded by the January, 1904, envelopes established by the proofs on behalf of the defendant.

As said by Judge Coxe in *Thayer v. Hart*, 20 Fed., 693: “The rule in such cases is very strict. It is so easy to fabricate or color evidence of prior invention and so difficult to contradict it, that proof has been required which does not admit of reasonable doubt,” or as said by Judge Hazel, in *Westinghouse Electric & Mfg. Co. v. Mutual Life Ins. Co.*, 129 Fed., 216: “The burden is upon the complainant, under the circumstances to establish by clear, unequivocal, and convincing proof, that the anticipation has been anticipated;” or as said by Judge Putnam, in the *Eastern Paper Bag Co. v. Continental Paper Bag Co.*, 142 Fed., 501: “The proofs offered by the respondent in regard to the defense brought in by the amendment are not supported by a *scrap* of anything relating to the substance of the events *contemporaneous* with them. None of the witnesses had had occasion to consider the occurrences during a period of more than *seven* years;” or as said by the Circuit Court of Appeals for the First Circuit, Judges Colt, Putnam and Webb, in *Brooks v. Sacks*, 81 Fed., 405, in holding the complainant’s testimony insufficient to anticipate an anticipation: “The whole case, in this respect, depends on the *unsupported recollections* of witnesses as to facts and dates fully six years prior to giving testimony, and facts, moreover, of a *kindred character* to other facts occurring at or near the same time, with which they might be confused. Not only is this important as bearing on the weight

of their testimony, but, under the circumstances of this case, the fact that the testimony is thus unsupported is an affirmative one against the complainant below of very great importance;" or as said by the Supreme Court in *The Barbed Wire Patent Case*, 143 U. S., 284, in considering oral testimony to establish an anticipation: "In view of the unsatisfactory character of such testimony, arising from the forgetfulness of witnesses, their liability to mistakes, their proneness to recollect things as the party calling them would have them recollect them, aside from the temptation to actual perjury, courts have not only imposed upon the defendants the burden of proving such devices, but have required that the proof shall be clear, satisfactory and beyond a reasonable doubt."

In view of all the foregoing, we submit that the complainant has not anticipated the anticipation established by the January, 1904, envelopes, produced on behalf of the defendant, and that, aside from any other defense, the first Cohn patent should be held to be invalid because of anticipation.

The Second Cohn Patent.

The second Cohn patent was applied for January 17, 1905, as a division of the original application filed November 8, 1904, on which the first Cohn patent was issued. The drawings of the second Cohn patent are simply a reproduction of Figures 3 and 4 of the first patent. The specification is in many respects the same as in the first patent. The difference between the two patents consists in the *shape of the window* in the second patent, and the printing of certain permanent advertising matter *on the face* of the envelope, in juxtaposition to the window and co-operating with its outline to indicate a particular brand of goods. In the specification of his second patent, at page 691, Cohn says:

"In carrying out my invention I take a blank sheet of

paper or an envelope-blank of suitable strength and texture which is, say, semi-transparent and apply to a portion of one side of the blank, generally on the inside, a preparation which has the property of rendering transparent the portion to which it is applied. The remaining portion of the blank which forms the face of the unfinished envelope *a* is then imprinted with a suitable opaque coloring matter.”

In his second patent, as in his first, Cohn says that

“This coloring matter may be applied *solid over the face* of the envelope, or it may take the form of graduated tints or of being shaded, or the representation of a surrounding border, or cloud effect.”

In the second Cohn patent, therefore, as in the first, the “border” mentioned in the claims may cover either a narrow ring around the window, or it may include the *entire surface* of the face of the envelope outside of the transparent portion or window. We call particular attention to his, as we did in considering the first Cohn patent, as borders are shown in some of the prior patents which cover the envelope or paper to which they are applied from the edges of the transparent window to the edges of the envelope or paper.

The idea described and illustrated in the second Cohn patent is to make the *window*—the transparent portion of the envelope—in the *shape* of a trade-mark, design, or other article of trade. The specification says that:

“The number of shapes this transparency may take is almost limitless. Different people might use an envelope with a window in the shape of an oyster, a fish, a cake of soap, and other toilet articles, a cascade, a dress-shield, a biscuit, an article of hardware, and other articles of manufacture, and so on indefinitely, having due regard for the necessary size of the transparency, so as not in any way to interfere with the clear showing up of the addressee’s name inside. The essential feature

in this connection is a window which in general outline is characteristic of a symbol of trade. By 'symbol of trade' is meant any design such as mentioned above or trade-mark characteristic of certain goods or the product of a certain manufactory."

It is to be noted that it is the *window* or transparency which is to resemble the trade-mark or article of trade. He says that "The number of *shapes* this *transparency* may take is almost limitless"; and again he says that "The essential feature in this connection is a *window* which in general *outline* is characteristic of a symbol of trade." Indeed, it *must* be the window—the transparency itself—which resembles the trade-mark or article of manufacture, as *otherwise* when the coloring matter is "applied *solid over the face* of the envelope," as he says it may be, there would be *nothing else* to indicate the trade-mark or article of manufacture—the trade-mark or article of manufacture would *wholly disappear and leave nothing to indicate it*.

To supplement and accentuate the trade-mark or article of manufacture represented by the outline of the window, Cohn proposes to have some permanent advertising matter, and in his claims he says that this permanent advertising matter "appears on said tinted border," and that it "relates to and is in juxtaposition with the outline of said window." He describes the permanent advertising matter as located *on* the border—not *in* the transparent window—but *on the face* of the envelope—on the *border*—in juxtaposition with the outline of the transparent portion or window.

The two claims of the second Cohn patent are expressly limited to a *window* which is in the *form or outline* of some trade-mark, or article of manufacture, and which has the advertising matter permanently located on the *border* or face

of the envelop surrounding the window. The claims, at page 692, read:

“1. An advertising device comprising an envelope having a window through which the addressee's name on an inclosure may show through, said window being in outline characteristic of some symbol of trade, a tinted or colored border surrounding and giving definition to said window and permanent advertising matter forming no part of the address, appearing on said tinted border, and related to and in juxtaposition with the outline of said window.”

“2. As an advertising device, an envelope having a generally opaque face except for a transparent window portion through which an addressee's name on an inclosure may show through, said window being in general outline characteristic of a symbol of trade, and permanent printed matter on the face of the envelope related to and in juxtaposition with the outline of the window and co-operating with said outline to indicate a particular brand of goods.”

It will be noted that both of the claims require the *window* itself—the *transparent* portion—to be in outline characteristic of some symbol of trade, and that there shall be permanent advertising matter appearing *on* the tinted border—not *within* the transparent window—but “on said tinted border,” to use the language of the first claim. This gauge is plain, explicit, and not to be misunderstood. It is not the *border*, which is to be in outline characteristic of some symbol of trade, but the window itself, as otherwise the symbol of trade would *be covered up and disappear* if the border covered the entire face of the envelope. As already pointed out, it would not be possible, unless the *window itself* were in outline characteristic of some symbol of trade, to extend the border of coloring matter entirely from the window to the edges of the envelope, or to apply it “solid over the face of the envelope” and have anything left in the form of a symbol of trade, or of an article of manufacture. Hence,

Cohn, in the claims of his second patent, meant, and intended to mean, that it was the window itself—the transparent portion—that was to have the *form* of an article of manufacture, or to be “in outline characteristic of some symbol of trade.”

No Invention in the Second Cohn Patent Over the First and Over the State of the Art.

In his first patent, Cohn has shown, described and claimed, a one-piece transparent-window envelope. His second patent merely modifies the form or shape of the window, so as to make it correspond to some article of manufacture, and has used in connection with it permanent advertising matter. He takes the *envelope* of his first patent and *changes* the *form* of the window, and prints some advertising matter on the face of the envelope. It was old to make the transparent windows of envelopes of *various* forms, and it was old to print permanent *advertising* matter on the face of the envelope. Cohn simply took the envelope of his first patent and did these two old and well known things to it—made the window in the form of some symbol of trade, and printed advertising matter on the border or face of the envelope.

It is true that the second Cohn patent was issued on an application divided out from the application for the first patent, so that technically neither patent is to be considered as a part of the prior art with respect to the other. This, however, is aside from the point we make in comparing the second patent with the first, which is that as the first patent covers, and was intended to cover, a certain kind of envelope, it is proper to consider the matter claimed in it and in the second patent to determine whether there is *patentable difference or invention* between the subject-matter of the second patent and that of the first. In other words, did the change or improvement made in the envelope of the second

patent constitute invention over the envelope claimed in the first patent? Manifestly, if the claims of the two patents were literally and *verbatim* the same, no invention would be involved in the claim of the second patent over the claim of the first patent. As they are not literally and *verbatim* the same, it is competent for the court to consider whether the *differences* in the claims of the second patent over the claim of the first patent constituted patentable invention. If there be no *invention* or patentable difference between the claims of the second patent over the claim of the first patent, then, manifestly, the claims of the second patent are invalid, as much as if they had been a literal repetition of the claim of the first patent.

The Proceedings in the Patent Office.

When Cohn, on January 17, 1905, filed his application on which his second patent issued, he presented two claims to the Patent Office, as printed at page 624. On March 20, 1905, the Examiner wrote him a letter rejecting his claims on the Watts 1895 British patent No. 7,955, and on the Busch 1896 British patent No. 11,876, and among other things, at page 627, said:

“The first shows that it is old to make the transparent openings in envelopes of various configurations and designs; while the Busch reference discloses applicant’s specific construction so far as defined by the claims.”

Thereupon, and on May 5, 1905, Cohn amended his claims by calling for “permanent” advertising matter and the words requiring the advertising matter to be “in juxtaposition” with the outline of the window, and presented an argument in favor of the patentability of the claims, among other things, at page 628, saying:

“We are not claiming an envelope with a transparent

opening, but we are claiming an opening of a particular kind which serves not only the function of the window of Busch but is also descriptive of some known article of trade. Thus we convert Busch's address window into a valuable advertising feature while preserving all that Busch can possibly claim for his window. We thus obtain a new result since we obtain a valuable advertising advantage without detracting from the view of the addressee's name. But this alone is not sufficient and is not only what our claims call for. The point that must be kept in mind all the time is the COMBINATION of the PECULIARLY SHAPED window and the correlative permanent printed matter on the envelope explanatory of and in juxtaposition with the said opening. For instance, a cigar shaped window has no especial significance but when the word 'Primo' or 'Blanco' or some other suitable trade name is printed on the face of the envelope in juxtaposition with the window opening, the entire design has a special significance, for the arrangement considered as a whole presents a novel and useful way of expressing some well known name or trade-mark."

It will be noted that in the above argument, intended to bring out the peculiar and identifying characteristics of the envelope of the second Cohn patent, Cohn states that he is claiming "an opening of a particular kind," which *opening* not only serves the function of the *window* of the Busch envelope, but "is also *descriptive* of some known article of trade." He says that he converts "Busch's address window into a valuable advertising feature." He says that in this way he obtains a new result, since he secures "a valuable advertising advantage without detracting from the view of the addressee's name." He says that the point must be kept in mind all the time that it is the combination "of the PECULIARLY SHAPED window"—and to give emphasis to this he uses capital letters—and the permanent printed matter on the envelope in juxtaposition to the opening. These statements clearly show that it was Cohn's window—the *transparent portion* itself—that he intended to have in the form of some

symbol of trade or article of manufacture, and not the surrounding border.

Afterwards, and on May 25, 1905, the Office again rejected the claims and, on page 630, cited the Cohn 1904 British patent No. 14,478. In answer to this rejection Cohn, after waiting some nine months, on February 21, 1906, again wrote to the Office and, on page 630, asked for a reconsideration and final action, with a view to an appeal. Thereupon, and on March 2, 1906, the Examiner wrote Cohn again, page 631, citing the Brown 1862, and the Callahan 1902 patent, and on March 13, 1906, Cohn wrote a letter to the Patent Office, page 632, expressing surprise that the Examiner should have cited the Cohn 1904 British patent, and among other things, the italics being ours, said:

“We really wonder that the Examiner will cite such a patent for claims which are for such matter as ‘said *window* being in *outline* characteristic of some symbol of trade, a tinted or colored border surrounding and giving definition to said *window* and permanent advertising matter forming no part of the address, appearing *on* said tinted border, and in juxtaposition with and related to the outline of said *window*.’ Not one of these features appears in applicant’s British patent cited, and we wonder that said patent is seriously considered as a reference for our claims.”

In the meantime, however, and on February 28, 1906, an appeal had been taken to the Board of Examiners-in-Chief, page 637, and on March 22, 1906, the Examiner filed his written reasons for rejection before the Board, and among other things, on page 639, the italics being ours, said:

“The mechanical structure of applicant’s envelope may be stated briefly to be an envelope having a transparent portion or window in its front surrounded by an opaque border formed by the application of coloring matter. This structure is clearly disclosed by the British patent to Cohn and Shipp. The limitations in the claims

to the *shape or contour* of the *transparent portion or window*, and to the advertising or printed matter placed upon the colored border cannot add any patentability to the claim. After an envelope has been provided with a transparent window surrounded with an opaque colored border, it is within the province of any mechanic or artisan to change the *shape or contour* of the *transparent window* to suit his own taste, without invention. The patent to Cohn and Shipp shows a variety of shapes for the windows. The printed matter upon the envelope likewise can add no patentability to the structure. This doctrine is well settled in the following decisions: *Ex parte Lee*, 18 O. G., 624, and *ex parte Mosler*, 118 O. G., 590.

“The British patent to Busch discloses an envelope having in its front portion a transparent window surrounded by an opaque border preferably made by printing with opaque coloring matter. This is applicant’s exact structure aside from the particular *shape or design* of the *window* and the advertising or printed matter on the envelope. As above stated, this particular design or the printed or advertising matter cannot add patentability to a structure otherwise old.”

It will be noted that the Examiner speaks of “the limitations in the claims to the shape or contour of the transparent portion or window.” Again he says that “it is within the province of any mechanic or artisan to change the shape or contour of the transparent window to suit his own taste.” Again he says that the Busch patent shows Cohn’s exact structure, “aside from the particular shape or design of the window,” and the advertising or printed matter on the envelope. These statements show that it was the *understanding* of the Office that the *window* itself was to be in *outline* characteristic of some symbol of trade or article of manufacture.

In reply to the Examiner’s statement Cohn filed a brief or argument before the Board of Examiners-in-Chief. After referring to his other appeal that was then pending before

the Board, Cohn, among other things, at page 643, the italics being ours, said:

“Applicant has conceived the very useful idea of giving to the *transparent window* an *outline* characteristic of a symbol of trade, and he associates with this *specific symbol* permanent advertising matter which forms no part of the address but is so related to and in juxtaposition with the *specific form* of window as to instantly convey to the public a particular brand of goods, thus adapting the envelope as a novel and valuable advertising medium, in addition to its function as an inclosure for a letter.

“To give the *window* any *old shape* and without any regard to the character of the permanent printed matter, or to employ printed matter which is not related to or fails to explain the *form* of the *window* would serve no useful purpose, and therefore the invention is in the combination in the envelope of a window which by itself means substantially nothing of value as an advertising feature but which when viewed in connection with permanent printed matter, related to and in juxtaposition with the window, explains the symbol of trade which the *window* is designed to describe. As a good example of this, take a window in the form of an elongated oval. Such a window would have little, if any, meaning to the public; but print adjacent to such a window the word ‘Perfecto’ or ‘Cremo’ or ‘LaGato’ or the name of some other well known brand of cigars, and how soon a smoker of such brand would associate in his mind the otherwise meaningless symbol and otherwise more or less meaningless word.

“Thus the novelty of this case lies in the addition to the novel features of the companion case, of the ‘*window* in *outline* characteristic of some symbol of trade’ and ‘permanent printed matter on the *face of the envelope* related to and in juxtaposition with the *outline* of the *window* and co-operating with said outline to indicate a particular brand of goods.’ These qualities in this structure make the new and useful ‘advertising device’ claimed.

“It must be remembered that the permanent printed matter does not obscure or interfere with the window and the address to show therethrough, nor will it inter-

fere or necessarily be related to a name card on the envelope.

“Neither of the references cited, namely, applicant’s British patent or the British patent to Busch, shows (1) an advertising *symbol* of any character, which enables the *window* to have a *double* function, or (2) any printed matter ‘related to and in juxtaposition with’ the *window outline* ‘to indicate (therewith) a particular brand of goods’ and for this reason we submit that there is an invention involved, and that the Examiner is in error in refusing the claims as not patentable over the art cited.”

The Board of Examiners-in-Chief, on April 13, 1906, filed their written opinion, in which they concluded that the claims were allowable because of the peculiar *form or contour* of the window or transparency itself, showing or illustrating an article of manufacture or symbol of trade which was not shown in the Cohn and Shipp and Busch British patents, which merely showed a variety of different forms in which the window could be made, as rectangular, oval, diamond-shaped, etc. In their opinion, among other things, the italics being ours, after citing the two British patents, at page 646, they selected the Cohn and Shipp patent as the preferable reference, saying:

“Of these two patents, British No. 14,478 is the more pertinent. That patent describes an envelope having a window through which the addressee’s name on an inclosure may show, said window being ‘oval, rectangular, diamond-shaped, or fancifully bordered’ in outline and having a tinted or colored border surrounding and giving distinction to said window, or, as the specification of the patent puts it (p. 2, lines 10, 11) ‘the finished envelope gives the effect of a transparent, light colored area on an opaque, dark colored background.’ The patent also suggests having transparent letters as in Figure 5 and lettering ‘Boots and Shoes’ thus referring to the business of the sender.

“The applicant in this case before us has carried the idea of this patent a little further by making the *fanciful shaped opening* in the shape of a pickle, cigar, or other

symbol of trade, and instead of merely referring to the business has used some other advertising matter associated with the article *whose form has been given to the window or opening*. This idea appears to us to be inventive in character and the claims may accordingly be allowed."

After the decision of the Board of Examiners-in-Chief, the Examiner again, and on April 27, 1906, wrote to Cohn, page 634, requiring that Figure 1 of the drawings "be eliminated as not being covered by the claims, such figure not showing a *window* having a general *outline* of a symbol of trade."

Figure 1 referred to by the Examiner above was substantially—indeed practically precisely—the same as Figure 1 appearing in the first Cohn patent.

Thereupon, and on May 2, 1906, Cohn wrote the Office canceling Figure 1 of the drawings, but declining to cancel Figure 2, which the Examiner had also suggested should be canceled, as well as Figure 1, saying, at page 635, in declining to cancel Figure 2:

"In original Figure 2 the pickle shaped window—and the Examiner seems to readily recognize the shape—is representative of an article of trade."

Thereupon, and on May 11, 1906, the application was passed to issue, and on July 3, 1906, the patent came out.

It will be noted that in the above, the last communication to the Office in reference to the matter, Cohn speaks of the "pickle-shaped window"—the window or transparency itself—as representative of an article of trade.

In view of all the foregoing, we submit that it is plain that throughout the entire proceedings in the Patent Office, Cohn

on the one hand, and the Office, representing the public, on the other, understood and considered that it was the *window* itself, and not the border, which was to be in the form of an article of manufacture, or trade-mark, or symbol of trade. Both parties to the contract understood and accepted it as being limited to an envelope in which the transparent portion or window, and not something else on the envelope, was to be in outline characteristic of some symbol of trade.

In the investigation into the state of the art in this case, the defendant discovered an English patent issued in 1897 that showed *the very thing that was lacking*, and on the *lack* of which Cohn urged the patentability of his envelope, and on the *lack* of which the Board of Examiners-in-Chief concluded that he was entitled to his patent. This was the Boldt 1897 English patent No. 29,956, page 718, which was brought into the matter for the first time by the defendant in this case, and which removes every vestige of novelty in the window on which the patent was granted. The Boldt 1897 English patent shows and describes an inclosing case or receptacle—"packet, wrapper, envelope, or whatever it may be termed"—to use the words of the patent—for containing small articles, such as hooks and eyes, pins, and similar things, in which the drawings represent six or seven different shaped, transparent window openings. The specification, at page 718, says, among other things:

"More than one of these *openings* protected by transparent material may be used and they may be of any *desired shape or size or pattern*. For example, they may be made to represent the initials of the firm selling them or may otherwise be utilized *for advertisement purposes, trade-marks, or the like.*"

Again, in describing the drawings, the specification says:

"In Figure 8 the opening B is shown cut to the shape of the letter N which might represent that the package

contained needles. Or the letter might be chosen to indicate the name of the maker or the full name might be so set forth. The same purpose may be effected by painting or embossing or otherwise delineating a trade-mark or a name or other symbol or device upon the transparent covering as indicated in Figure 9.

“Any design or symbol for the purpose of identification or advertisement or other purpose may be conveniently set forth on the transparent covering C.”

It will be seen from the above quotation that Boldt contemplated two ways of displaying his trade-mark or symbol of trade. The first of these ways was by making the *window itself* of a shape or contour to represent the article of manufacture, or by imprinting or otherwise displaying the trade-mark or symbol *upon* the transparency itself. The third and fourth claims of the Boldt patent claimed both of these ways of displaying the trade-mark or symbol of trade. They read:

“3. A windowed envelope or wrapper having one or more openings such as B closed by transparent material representing one or more letters, trade-marks or devices.

“4. A windowed envelope or wrapper having one or more letters, trade-marks or devices delineated on the window.”

The Boldt 1897 English patent shows it was old to make packets or envelopes containing transparent portions or windows in the shape, figure, contour, or outline of an article of manufacture or symbol of trade. This was done, so the specification tells us, for *advertising* purposes. If this Boldt 1897 English patent had been discovered by the Examiner and had been before the Board of Examiners-in-Chief, it is plain that they would never have recommended the issuance of the second Cohn patent. The only thing, and everything, that can possibly be said to be left in the Cohn claims after the Boldt English patent was discovered, was the printing of permanent advertising matter on the face of the envelope

outside of the window or opening, and the printing of permanent advertising matter on envelopes has been used generally, as the evidence shows, for forty years or more. No doubt such permanent advertising matter has been used on envelopes practically ever since they were introduced into use. The advertising matter printed on envelopes is always located or placed so as not to interfere with displaying or showing the name of the addressee to whom the letter is being sent. Samples of such envelopes were shown as illustrations at page 316 of the typewritten Record.

Indeed, if the claims of the Cohn patent be stretched to cover such an envelope as those used by the defendant and charged to infringe—an envelope in which the alleged permanent advertising matter appears *through* the transparent opening or window itself, as does the word “Heinz”—then the Boldt 1897 English patent describes and discloses the advertising matter, as well as the window or transparent opening in the form or outline of an article of manufacture or symbol of trade.

The Boldt patent says that the purpose or object may be effected by painting, or embossing, or otherwise “delineating a trade-mark or a name or other symbol or device upon the transparent covering as indicated in Figure 9,” and the fourth claim says that there may be “one or more letters, trade-marks or devices delineated on the window.” In the envelopes used by the defendant, the word “Heinz” is printed on the inside back of the envelope, so that it appears through the transparent window when the receiver removes the letter. In effect, it is “delineated” on the transparent window.

The defendant’s expert, Mr. Bond, in answering questions 62 and 63, at page 503, says that the defendant’s envelopes more nearly resemble the Boldt patent than they do the Cohn

patent by "delineating the trade-mark or device so as to appear on the transparent material." It follows, therefore, that if the Cohn claims be stretched to cover the defendant's envelope they likewise cover the envelope of the prior Boldt 1897 patent, so as to be invalidated by it. This grows out of the familiar principle announced in many cases, as, for instance, by the Supreme Court in the case of *Miller v. Eagle Mfg. Company*, 151 U. S., 203, where they say: "That which infringes if later anticipates if earlier." Hence, the claims of the Cohn patent are fully anticipated and invalidated by the disclosure of the Boldt 1897 English patent, if they be construed to cover envelopes in which the permanent advertising matter is made to appear *upon or through* the transparent window, instead of being restricted to a location *on the border or face* of the envelope itself, as the claims call for.

No Infringement of the Second Cohn Patent.

We have already pointed out at length and in detail the limitations and requirements of the two claims of the second Cohn patent, to determine exactly what it was that Cohn desired to claim and what the Office understood he was being given by his patent; and have found that the claims are limited to an envelope in which the *window or transparent portion* itself is made in the shape, contour, or outline of an article of manufacture, or some symbol of trade, with permanent advertising matter placed or printed *on the border or face* of the envelope itself, to assist and supplement the shape of the article represented by the form and contour of the window. We insist that the claims are to be understood as suggested above, and that they must be so understood in order to ascertain and give effect to the *intention* of the parties to the instrument, which is the thing which is always to be ascertained and effectuated in the construction of patents, as well as other contracts, if possible. As said by the Circuit Court

of Appeals for the Eighth Circuit, Judges Sanborn, Van Devanter and Hook, in the case of the *Jewell Filter Company v. Jackson*, 140 Fed., 343:

“The rules for the construction of contracts apply with equal force to the interpretation of patents. The great desideratum here, as there, is to ascertain and give effect to the *intention* of the parties to the contract when they made it.”

The court also said that,

“When the terms of a patent are plain and the *intention* of the parties is manifest, the latter must prevail, and there is no room for construction.”

In view of the above considerations and of the settled principles of law that must be applied, we think it is plain that the defendant's envelopes do not respond to the requirements of the claims and that there is no infringement.

The defendant's envelopes are made by the manufacturer with the *window* or opening of the *exact size and shape* that they are made in the regular or stock envelopes made and sold generally, of which one was introduced at typewritten page 5 of the Defendant's Record. The same plate is used for applying the oily preparation for making the window in the Heinz envelope as in the stock envelopes. The *window* or transparent portion in the defendant's envelopes is not *in the shape* or configuration of *any* article of manufacture or symbol of trade. The *border* surrounding the window is in the form of a cucumber or pickle, but it is not the form of the *border* which, by the express terms of the claims of the second Cohn patent, is *required* to be in the *form* of a symbol of trade. The public is at liberty to make the *border* in the form of an article of manufacture or symbol of trade, or of any shape desired, so far as the *claims* of the second Cohn patent are concerned. Indeed, as we have already pointed

out, the *border*, according to the statements of the patent, may be extended from the *edges of the window to the edges* of the envelope, and still leave the *window* in the form or contour of the shape of an article of manufacture or symbol of trade, but if the border in the *defendant's* envelopes were extended from the edges of the window to the edges of the envelope, as the second Cohn patent provides that they may be, there would be *nothing whatever left* on the defendant's envelopes in *outline characteristic* of some symbol of trade. There would only be left the *regular* window or transparent portion of the stock or regular envelopes. To be the envelope of the patent, the defendant's envelopes must be capable of the same peculiarities of construction and use.

Furthermore, in the case of defendant's envelopes, a change in the shape of the window, or even the entire elimination of the transparent window portion, would not in any way change or alter the character of the border outline, which, in any event, would present the configuration of a cucumber. As a matter of fact, the presence of defendant's transparent *window* of conventional shape, formed within a border having the outline of a pickle, *detracts from* rather than *adds to* the suggestive character of the trade symbol. It introduces a foreign element or factor into the very *body* of what would *otherwise* constitute a perfect representation of a pickle. This simply indicates beyond question that defendant's *window* itself has nothing whatever to do with the *indication* of a symbol of trade. Cohn chose to impose an *additional* and *peculiar* function *on the window*, and thereupon, and for that reason, and for that reason alone, he obtained his patent, but defendant's *window* does not even *assist* in the performance of that function.

It is equally plain that the defendant's envelopes do not contain any permanent advertising matter printed either *on*

the tinted border or *on the face* of the envelope, as required by the claims of the second Cohn patent. 'The only thing that is printed on the face of the envelopes is the ordinary and usual return request, which is not the advertising matter contemplated and required by the Cohn patent. The only other place where the word "Heinz" appears is through the transparent window opening. It is printed on the inside of the back of the envelope, so that when the letter is removed it appears through and in the center of the transparent window. The word "Heinz" was placed in that position, as explained by Mr. Regenstein, in answering cross-question 159, at page 299, because the Heinz Company always uses the word "Heinz" printed or placed *on* the body of their pickles. As said by Mr. Regenstein, "The trade-mark of the Heinz Company represents a pickle which shows the word 'Heinz' *on the pickle;*" and as further said by him, "The only way Heinz would accept the envelope was to show the word 'Heinz' the same as it appears *on* the trade-mark." But printing the word "Heinz" on the *back of the envelope* is not printing it where Cohn in his patent and in his claims located and required the permanent advertising matter to be placed. It is not on the *tinted border*, and it is not on *the face* of the envelope, nor is it placed "in juxtaposition with the outline of said window," as required by the claims of the Cohn patent. Hence, it is not the arrangement which Cohn *segregated and selected from all other arrangements*, and in which he asked the protection of his patent.

Furthermore, in using the word "Heinz" where it appears *through* or in effect on the transparent portion or window itself, the defendant's envelopes substantially follow and employ one of the ways for using the word or name described and disclosed by the Boldt 1897 English patent, where he says that the same purpose may be effected by painting or otherwise "delineating a trade-mark or name or other symbol or

device upon the transparent covering"; and, again, in the fourth claim, he calls for "A windowed envelope or wrapper having one or more letters, trade-marks or devices delineated on the window." The defendant's envelopes substantially follow and employ the second method *described and disclosed* in the Boldt 1897 English patent, instead of the method described and disclosed and claimed in the second Cohn patent. As already suggested, that which would *infringe* will operate to *anticipate* if prior in date to the patent sued on. It follows, therefore, that, in attempting to hold the defendant's envelope as an infringement of the second Cohn patent, the *prior* similar arrangement disclosed in the Boldt 1897 patent must operate as an anticipation. The Cohn claims cannot cover or interfere with forms and arrangements which were disclosed to and in the possession of the public for years prior to the application for the Cohn patent.

For the reason, therefore, that the defendant's envelopes do not have the transparent portion or *window itself* in the form or configuration of an article of manufacture, and "in outline characteristic of some symbol of trade," and for the reason that they do not have permanent advertising matter either on the *border* surrounding the window or envelope, or on the *face* of the envelope itself, all of which are required by the claims of the Cohn patent, the defendant's envelopes do not contain, embody, or employ the particular arrangement of devices which Cohn claimed as his own, and for which he sought protection through his second patent.

If it be contended, on behalf of the complainant, that the defendant's envelopes are an infringement of the claims of the second Cohn patent, on the ground that as an advertising device they accomplish the same purpose and secure the same result, then we reply that equivalency in result is not determinative of the question of infringement. This has been

established by the decisions of the Supreme Court for half a century or more.

In *Burr v. Duryea*, 1 Wall., 572, the Supreme Court said:

“That two machines produce the same effect, will not justify the assertion that they are substantially the same, or that the devices used by one are, therefore, mere equivalents for those of the other.”

Again, on page 373 of the report, the Supreme Court said:

“The argument to show infringement assumes that every combination of devices in a machine which is used to produce the same effect, is necessarily an equivalent for any other combination used for the same purpose. This is a flagrant abuse of the term equivalent.”

Again, on the same page, the Supreme Court said:

“It has been argued, that though not a colorable invasion of the patentee’s claim it is an evasion of its patent, which is equally injurious. If so, it is *damnum absque injuria*. Every man has a right to make an improvement in a machine, and evade a previous patent, provided he does not invade the rights of the patentee.”

In order to infringe a patent, three things are to be taken into consideration—the means, the mode, and the result. As said by Judge Morrow, of California, in *American Can Co. v. Hickmett Asparagus Co.*, 137 Fed., 90:

“To sustain a claim of infringement three things must be found: First, identity of result; second, identity of means; third, identity of operation.”

Or, as said by Judge Reed in *American Steel & Wire Co. v. Denning Wire & Fence Co.*, 176 Fed., 565:

“To sustain the charge of infringement of a patented machine the infringing machine must be substantially identical with the one alleged to be infringed in (1) the

result attained; (2) the means of obtaining that result; and (3) the manner in which its different mechanisms operate and co-operate to produce that result. If the machines are substantially different in either of these respects, the charge of infringement is not sustained."

To constitute an infringement of the claims of the second Cohn patent, it is necessary to show that the patented envelopes and the defendant's envelopes, as advertising devices, are substantially identical in their means, their mode of operation, and their results. The *windows* must be substantially alike—they must both be, in form or contour, in *outline characteristic* of a symbol of trade, irrespective of the form or contour of the border. The permanent advertising matter must be located in both envelopes substantially alike—on the *tinted border* or *on the face* of the envelope. The result attained must be the same in both envelopes—the *shape* or contour of the *window* must *indicate* the article of manufacture, *even though* the border extend from *the edges of the window* to the *edges of the envelope*, which result cannot be attained in the defendant's envelope if the border were so extended. The patented envelope and the defendant's envelope are not alike, therefore, either in the window, the printed advertising matter, or the results which they are capable of attaining.

Furthermore, it must be borne in mind that the proofs as to infringement must be so strong and sufficient as to overcome the legal presumption of innocence, beyond a reasonable doubt. The infringement of a patent is a trespass or tort and the law presumes no wrong. If on the whole case the court has doubts on the question of *infringement*, such doubts must be resolved in favor of the defendant. Courts do not take a defendant's money or property and give it to a complainant, or interfere with his business, if they have any reasonable *doubt* on the question of infringement. This is

ancient law established in the beginning of patent suits. As said by Justice McLean before any of us were born, in considering the question of infringement, in *Brooks v. Bicknell*, 3 McLean, 432:

“The proof here devolves on the plaintiffs. They allege that the defendants have infringed their rights, and to obtain your verdict they must show it. Doubts under this head will incline you favorably to the defendants, as they are not to be deprived of a right which is common to every citizen, unless it shall clearly appear that their machine is substantially like the one claimed by Woodworth.”

If, therefore, upon weighing the various considerations urged in favor of infringement and against infringement, the court have doubt on the subject, it must resolve such doubt in favor of the defendant and hold that no infringement is established.

The Unauthorized Admission as to Infringement.

It is contended, however, on the part of the complainant, that during the taking of the *prima facie* testimony, on November 3, 1910, defendant's counsel, who was in attendance, admitted and conceded that the defendant's envelope contained the subject-matter of the first claim of the second Cohn patent. It is true that during the complainant's *prima facie* testimony, Mr. Sullivan, the local solicitor that we got to represent the defendant in San Francisco, made a concession that appears to justify such contention, so far as the first claim is concerned. This concession, however, was made inadvertently and *contrary to the express instructions and directions* given to Mr. Sullivan in a letter from ourselves, dated October 11, 1910, and quoted in the Defendant's Record at page 480. In that letter, after requesting Mr. Sullivan to attend on the part of the defendant, we said:

“We presume that all Mr. Townsend will do in making his *prima facie* will be to offer the patents in evidence, samples of the envelopes, and examine an expert to testify to the similarities between the envelopes and the patents.

“Do not admit infringement, as we think there is no infringement—particularly of the *second* Cohn patent. Simply admit the fact of use, but make no admission that such use *infringes* the Cohn patents.”

Immediately upon receipt of a copy of the testimony taken on *prima facie*, we wrote Mr. Sullivan calling attention to the error into which he had fallen, and he immediately, and on November 23, 1910, served a notice on complainant's counsel, which was quoted into the Defendant's Record, at page 483, in which he withdrew the admission made during the taking of the *prima facie* testimony. In this *Retraxit* we offered to permit complainant to proceed further with the examination of the witness on the stand at the time the admission was made, offered to waive all objections to the further examination of the witness growing out of the fact that the time for taking the *prima facie* testimony had expired, and further, offered “to pay any and all costs necessary and incident to the further examination of the said witness.” This was done so as to place the complainant in a position where he could not possibly claim that he had been prejudiced or injured in any way by the inadvertent admission made by Mr. Sullivan. At that time no testimony whatever had been taken on the part of the defendant, and, as the court can see, in view of the prompt withdrawal of the admission, and notice and offer on the part of the defendant, no injury or prejudice whatever had or has accrued to the complainant by reason of the admission.

Furthermore, the admission related to a matter that is before the court and open for the inspection and consideration of the court; and in such cases courts always exercise

their own judgment as to the truth of the admission, unless the complainant has been so prejudiced by relying upon the admission that greater injustice would be done by disregarding than by accepting the admission. The question that is always presented in such cases is as to whether the party has been put into such a position by the admission that injury and prejudice would result from its withdrawal or from disregarding it. In this case, however, as no prejudice has resulted, or can result, by giving full effect to the *Retraxit*, the court will consider the question of infringement presented on its merits, without reference to an admission made inadvertently and contrary to express instructions.

Even in the case of an admission in an answer under oath a Court of Equity will not hesitate to look at the facts, although giving effect to the admission, but to the *minimum* extent required. This is fully illustrated by the action of the Supreme Court in the case of *Jones v. Morehead*, 1 Wall., 164, where the defendant had filed an answer under oath admitting infringement. After considering the construction and limitations that were to be put upon the patent in suit, and comparing the defendant's locks with them, the court, the italics being ours, said:

“It therefore appears that, in point of fact, the defendants have not infringed the Sherwood patent, and if we were unembarrassed by the pleadings, we should dismiss the bill with costs. But the defendants have admitted in their answer that they did make locks as described in Sherwood's patent. . . .

“The fact that the defendants did manufacture and sell locks of the character of those patented by Sherwood, must be accepted as established in this case by the pleadings. The admission, however, *need go no further than its terms necessarily imply*. The language of the admission is satisfied, by assuming that the smallest number of *locks* were made, consistent with the use of that word in the plural.”

In the case at bar the admission was not made in the answer and under oath, but during the examination of the complainant's expert witness Maynard, and it was confined to *one* envelope—Exhibit C—and if given effect at all, should, under the principle of the above decision, be limited to the specific envelope. The admission was made inadvertently and against express instructions, and was promptly withdrawn. The reply testimony of the complainant shows that the witness Maynard was alive, available, and even with his office in the same suite of rooms occupied by the complainant's counsel, and that he was present during the taking of complainant's reply testimony. This is brought out in R-X Qs. 185-187 asked of the complainant, and his answers thereto, at page 199.

Furthermore, the admission becomes unimportant and immaterial, in view of the plain invalidity of the second Cohn patent, in view of the Boldt 1897 English patent, taken in connection with the state of the art as exhibited by the other prior patents in evidence. And in this connection, the envelope covered by the first Cohn patent, which discloses everything except the particular shape or contour of the window or transparent portion and the advertising matter, must be taken into consideration.

The Equities of the Parties.

In equity suits, the respective merits and equities of the parties are to be taken into consideration. The evidence shows that Cohn has never manufactured the envelopes of his patents, after making the first lot of 10,000 in the fall of 1904. He has never conferred on the public generally the benefit and advantages which result from furnishing them with envelopes containing his inventions. His patents are what the courts have frequently called "mere paper patents." We call attention to this, not for the purpose of denying the

right of Cohn to hold his patents in non-use and still seek equitable relief under them, but for the purpose of saying that these non-used patents do not *especially appeal to a court of equity for any liberal consideration*, either on the question of *validity* or on the question of *infringement*.

On the other hand, the Transo Paper Company, manufacturer of the defendant's envelopes, stands in a very meritorious position. Mr. Regenstein, in answering question 79, on page 278, says that, "After the border matter was settled in January, 1904, we gave our attention, up to this day, to the perfecting of the transparency of the window." In answering the next question, he says that this was "a very difficult matter." He then says that, "The difficulties in preparing the windows properly were found on account of atmospheric conditions, non-elastic oils, and various other causes." In answering question 82, on page 278, he says that, "We have found and experienced in 1906 that the transparent window would stick to the back of the envelope, and have spoilt at least forty to fifty million envelopes in that manner." In answering the next question, he says that, "The loss to our company in perfecting envelopes, is over \$100,000." In answering question 84, on page 279, he says that, "Our envelope is now considered the most perfect transparent envelope in existence, and has a sale in this country as well as in foreign countries." In answering question 88, he says that, "To my knowledge, I am the only manufacturer, and have never seen any one-piece transparent envelopes made by any one else in this country." In answering redirect question 344, on page 341, Mr. Regenstein says that his company is engaged exclusively in the manufacture and sale of these one-piece window-envelopes. He says that they have about 120 hands employed in the work, and that they have in their plant machinery, etc., for carrying on the business, and an investment of "about \$150,000."

It may be said that these equities concern the Transo Paper Company rather than the particular defendant sued in this case. As a matter of fact, and of common sense, we all know that the *manufacturer* of a machine, device, or article of commerce, is the party who is most affected by the result of a suit against a user, as in this case, and so we submit that it is proper to consider the equities as between Cohn on the one side and the manufacturer, whose business will be affected, on the other.

Not only has Cohn never manufactured more than a few envelopes—for 10,000 is a mere bagatelle when we consider that millions of envelopes are used every day—and put the public in the possession and enjoyment of the envelopes of his patents, but he has apparently attempted to make improper capital out of the pendency of this suit. He has sent broadcast to the customers of the Transo Paper Company, the manufacturer of the defendant's envelopes, a "WARNING" made to resemble to a layman a subpœna or writ issued from the court, referred to at page 334; and that it has had the effect of creating that impression is shown by Palm Bros.' letter in evidence, quoted in the Defendant's Record, at page 338, in which they say that they are in receipt of a notice from San Francisco, signed by Max M. Cohn, "which purports to be a notice from the United States Circuit Court in and for the Northern District of California." Palm Bros. further state in their letter, as showing the effect of the "WARNING" which purported to be "a notice from the United States Circuit Court," that they had been using the envelopes, "but in view of having received this notice we have discontinued their use." Of course, the complainant was within his rights in notifying the public of his patents and of the commencement of the suit, when doing so in a proper way, but when framing his notice in such a way as to create the impression that it emanated from the United States Circuit

Court, he was, as we think, transcending the limits of proper notification. This is particularly so when the effect of his "WARNING" was to deter the public from using an article which he was not manufacturing and not in position to supply. It caused a direct injury to the public that might not have been occasioned if he himself had been manufacturing envelopes and ready to supply them to the public.

It is the party or manufacturer who actually gives an article of manufacture to the public that benefits the public, and not the man who merely procures a patent and fails to introduce his invention into public use.

No doubt it will be claimed that Mr. Regenstein, the president of the company manufacturing the defendant's envelopes, prior to their manufacture, had seen the second Cohn patent and some specimens of his kind of envelope, in view of cross-question and answer 176, on page 302. We regard this as a matter of no importance, in view of the fact that it is proper and right in every way for a party to consider and study a patent in order to devise other ways of effecting the same result; or, as said by the Supreme Court in *Burr v. Duryea*, 1 Wall., 574:

"Every man has a right to make an improvement in a machine, and evade a previous patent, provided he does not invade the rights of the patentee."

In *American Steel & Wire Co. v. Denning Wire & Fence Co.*, 194 Fed., 177, 122, the United States Circuit Court of Appeals for the Eighth Circuit, through Judges Adams, Smith and Amidon, in a case where there had been former litigations between the same parties under the same patent, said:

"Appellant complains because after the decision in the former case respondent deliberately set about devising, with the aid of patent experts, a machine which would

produce the Bates fence, without infringing the Bates patent. It is sufficient to answer that complaint in the language of Mr. Justice Grier in *Burr v. Duryee*, 1 Wall. 531, 574, 17 L. Ed. 650: 'Every man has a right to evade a patent, provided he does not invade the rights of the patentee.' "

Indeed, it is for the purpose of informing the public as to just what a patented invention consists of that the law requires specifications and drawings to be filed in the Patent Office and made accessible to the public. The simple question, and the only question, is as to whether the defendant's envelopes, whether made with knowledge or without knowledge of the second Cohn patent, contain the invention which such patent describes and claims. If there be infringement, *ignorance* of the Cohn patents would not make it non-infringement; and, if there be *non-infringement*, knowledge of the Cohn patent would not make it infringement. The whole question of knowledge or lack of knowledge of the Cohn patents on the part of the makers of the defendant's envelope becomes, therefore, wholly irrelevant and immaterial.

An Apology and Explanation.

We feel like apologizing for the length of this brief. Its justification, however, is found in the length of complainant's brief below, which contained 287 printed pages. It seems to us that the case has been exaggerated out of all proportions to the real character of the supposed invention. It is a pyramid built on its apex. The patent rivals one we had to defend against years ago, which was for tying two strings together to make one long one, though the claim was couched in sonorous terms about tying the outside end of one ball of twine to the inside end of the next to cause them to unwind in succession, and so forth. In this case the first Cohn patent

is essentially for nothing more than a grease spot on paper with a ring around it. The paper was old; the grease spot was old; the ring or border was old; the spreading effects of grease and inks were known; the concealing effects of a ring or border around the grease or inks were known; they had been used together for many years in the printers' art; old printers considered that the use of borders was so well known that it was ridiculous to ask for a patent on a border around a grease spot on paper intended for an envelope; yet here it is, and the people who devised the method of printing a multiple of envelope blanks on a sheet at one operation with each revolution of the cylinder in the press, with the grease spots properly positioned, and thus made the production of one-piece transparent-window envelopes economical, practical, and commercial, are harassed by litigation by a man who, in his ignorance of the use of borders in the printers' art generally, teased the Commissioner of Patents, who was likewise ignorant of such use, as far as the record shows, into giving him a patent under which he has put the really meritorious parties to thousands of dollars of expense; and all this under a patent which, however its claim is worded, is practically for nothing more than a ring around a grease spot on a piece of paper used in making an envelope.

Well did the Supreme Court, in *Atlantic Works v. Brady*, 107 U. S., 200, describe the effect of granting such patents, when it said: "It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts." The Supreme Court says that such a course on the part of the Patent Office "embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to law

suits and vexatious accountings for profits made in good faith."

The Gist of the Matter.

To get down to the decisive facts and considerations of the case, they are very few, settled and indisputable, and may be thus formulated:

As to the first Coln patent, envelopes of *opaque* paper with *transparent* windows produced by some oily substance, but without any border around them, had been disclosed to the world in the Brown 1862 patent; envelopes of *transparent* paper with *borders* around a desired transparent portion constituting the *window* and covering the remainder of the face of the envelope had been disclosed to the world in the Busch 1896 British patent; opaque paper with *desired portions* rendered transparent by an oily preparation, with a *border* printed around the transparent portions, had been disclosed to the world in the Tudor 1878 patent and others; and *borders* had been printed for many years around *various kinds of work* in the different branches of the printers' art, to *define* the work and *cover* and *conceal* ragged, irregular and unsightly edges produced by the running or spreading of the inks or colors, imperfect registration, and other causes.

With these facts established, it follows that to print the *borders* of the Busch or Tudor patents, to mention no others, around the *transparent window* of the Brown 1862 envelope, or the border used by printers for the same purpose, that of concealing, defining and beautifying, was merely a double use of the old border—not as much as that, considering that Busch used the border on *envelopes* to define his window—merely an old and common printers' *expedient*, merely the applying of the *familiar* knowledge and *usual skill* of the

printers' craft, merely a *mechanical* act that required nothing of *invention* in its application.

As to the second Cohn patent, its envelope merely differed from that of the first patent in the shape or contour of the window—the *transparent portion* pure and simple—irrespective of the *border*, and the use of advertising matter on the border or face of the envelope; the border may extend *from* the window to the *edges* of the envelope, “solid over the face of the envelope,” to use the words of the patent, which would, of course, annihilate and *remove* the invention *unless* the word “window,” which he says is “in outline characteristic of some symbol of trade,” means the *window* and *not* the border; envelopes having transparent windows in the form of trade-marks or symbols, or “in outline characteristic of some symbol of trade,” to use the words of the Cohn claims, or having “a trade-mark or a name or other symbol or device upon the transparent covering,”—the window—to use the words of the Boldt patent, had been disclosed to the world in the Boldt British 1897 patent.

With transparent *windows* in the form of *trade-marks*, or in other words “in outline characteristic of some symbol of trade,” as disclosed in the Boldt 1897 patent, it follows that no *invention* was involved or could be involved in merely *changing* the form of the transparent window of the first Cohn patent into a similar shape or outline. It further follows that, as the transparent *window* in the defendant's envelope is *not* “in outline characteristic of some symbol of trade,” but is in the form and size of the regular stock windows made by the manufacturer of the defendant's envelopes and printed from the same blocks, so that, if the border were printed solid from the window to the edges of the envelope, as the Cohn patent says the border may be printed, every

possible *suggestion* of any particular article of manufacture would be *annihilated* and removed, which is not the case where the *window* is "in outline characteristic of some symbol of trade," as claimed by Cohn, the defendant's envelopes, irrespective of the fact that they do not have any "permanent" printed matter, in the sense of the second Cohn patent, printed on the *border* or on the *face* of the envelope, do not contain the subject-matter of the claims of the second Cohn patent and are not an infringement of the same.

In view of all the foregoing, we insist that both of the Cohn patents are invalid, in view of the state of the art, for want of invention, as already explained, and that the defendant's envelopes do not infringe the claims of the second Cohn patent.

Respectfully submitted,

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